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Sup. Ct.

TRANSCRIPT OF RECORD

Supreme Court of the United States

OCTOBER TERM, 1944

No. 486

THE HOOVER COMPANY, PETITIONER,

vs.

CONWAY P. COE, COMMISSIONER OF PATENTS

**ON WRIT OF CERTIORARI TO THE UNITED STATES COURT OF
APPEALS FOR THE DISTRICT OF COLUMBIA**

PETITION FOR CERTIORARI FILED SEPTEMBER 20, 1944.

CERTIORARI GRANTED NOVEMBER 6, 1944.

13
IN THE

UNITED STATES CIRCUIT COURT OF APPEALS

FOR THE DISTRICT OF COLUMBIA.

— 9 —
Appeal No. 8602.

THE HOOVER COMPANY,
Plaintiff-Appellant.

vs.

CONWAY P. COE, Commissioner of Patents,
Defendant-Appellee.

APPEAL FROM THE DISTRICT COURT OF THE UNITED STATES
FOR THE DISTRICT OF COLUMBIA. HON. DANIEL W. O'DON-
OGHUE, JUDGE.

APPENDIX TO BRIEF FOR APPELLANTS.

IN THE UNITED STATES COURT OF APPEALS

FOR THE DISTRICT OF COLUMBIA.

THE HOOVER COMPANY,

Appellant,

vs.

Civil Action

CONWAY P. COE,

Commissioner of Patents,

Defendant.

No. 15,028

**STATEMENT OF CONTENTS OF
APPENDIX OF APPELLANT'S BRIEF.**

Pursuant to the provisions of Rule 17(d) of the United States Court of Appeals for the District of Columbia, appellant herewith sets forth the subject matter which he proposes to place in the appendix of his brief.

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IN THE UNITED STATES DISTRICT COURT,

For the District of Columbia.

The Hoover Company,
Plaintiff,

v.

Conway P. Coe, Commissioner
of Patents,
Defendant.

In Equity No.

COMPLAINT.

*To the Honorable Judges of the United States District
Court for the District of Columbia:*

1. The jurisdiction of this court is based upon the patent laws of the United States and in particular Revised Statutes Sec. 4915.

2. Plaintiff, The Hoover Company, is an Ohio corporation, a resident of North Canton, County of Stark, State of Ohio, and is the assignee of the entire right, title and interest in and to application for United States Letters Patent, Serial No. 373,970, filed by Curtis C. Coons on January 10, 1941 for a new and useful Improvement in Continuous Absorption Refrigerating Systems and hereby makes profert of that application.

3. Defendant, Conway P. Coe, is the Commissioner of Patents of the United States, a legal resident of the District of Columbia, and is sued herein as Commissioner of Patents of the United States.

4. Application Serial No. 373,970 was duly filed in the United States Patent Office in accordance with the laws of the United States and the rules of the Patent Office on January 10, 1941 as a reissue application of United States

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Letters Patent No. 2,178,870, granted November 7, 1939 to The Hoover Company as assignee of the entire right, title and interest of the inventor, Curtis C. Coons, on an application Serial No. 94,934, filed August 8, 1936, and entitled Improvements in Continuous Absorption Refrigerating Systems.

5. The inventor, Curtis C. Coons, assigned his entire right, title and interest in and to the invention and his application Serial No. 94,934 by a properly executed assignment dated June 30, 1936, which assignment was recorded in the United States Patent Office, on August 8, 1936 at Liber S 167, page 462.

6. The reissue application, Serial No. 373,970 was duly prosecuted in the United States Patent Office in accordance with the laws of the United States and the rules of the Patent Office.

7. The reissue application was passed upon by the Primary Examiner who allowed sixteen claims but refused to allow the following claims:

15. An absorption refrigerating system having a circuit for absorption liquid including a generator, an absorber, and a triple heat exchanger, said exchanger being connected to conduct vapors and liquid from the generator and liquid flowing to the generator in heat transfer relation out of physical contact with each other, said exchanger also being located at a level below the surface levels of liquid in both said generator and said absorber, and means for creating a third surface level of liquid in said circuit below said exchanger to permit drainage of condensate from the vapor portion of said heat exchanger into said liquid circuit.

16. An absorption refrigerating system having a circuit for absorption liquid including a generator-vapor lift assembly, an absorber, and a heat exchanger, said exchanger being connected to conduct vapors and

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liquid from the generator and liquid flowing to the generator in heat transfer relation out of physical contact with each other, said exchanger also being located at a level below the surface level of liquids in both said generator-vapor lift assembly and said absorber, and means for creating a third surface level of liquid in said circuit below a portion of said heat exchanger to permit drainage of condensate from the vapor portion of said heat exchanger into said liquid circuit.

38. An absorption refrigerating system having a circuit for absorption liquid including a generator, an absorber, and a three-part heat exchanger, said exchanger being connected to conduct vapors and liquid from the generator and liquid flowing to the generator in heat transfer relation out of physical contact with each other, said exchanger also being located at a level below the surface levels of liquid in both said generator and said absorber, and means for creating a third surface level of liquid in said circuit below said exchanger to permit drainage of condensate from the vapor portion of said heat exchanger into said liquid circuit.

39. An absorption refrigerating system having a circuit for absorption liquid including a generator-vapor lift assembly, an absorber, and heat exchange means, said exchange means being connected to conduct vapors and liquid from the generator and liquid flowing to the generator in heat transfer relation out of physical contact with each other, said exchange means also being located at a level below the surface level of liquids in both said generator-vapor lift assembly and said absorber, and means for creating a third surface level of liquid in said circuit below a vapor portion of said heat exchange means to permit drainage of condensate from the vapor portion of said heat exchange means into said liquid circuit.

8. Claim 15 *supra* is Claim 7 of the United States Letters Patent to Bergholm 2,201,362, and Claims 16, 38 and 39 *supra* are based upon Claim 7 of the Bergholm patent.

9. The Bergholm patent No. 2,201,362 was granted May 24, 1940 to Servel, Inc. of New York, N. Y., a corporation of Delaware, as the assignee of Harry K. Bergholm, the inventor on an application for United States Letters Patent, Serial No. 175,632 filed November 20, 1937, entitled Improvements in Refrigeration.

10. The relationship of Claims 15, 16, 38 and 39 to the Bergholm patent was pointed out to the Examiner and an interference was requested.

11. The Examiner rejected Claims 15, 16, 38 and 39 on the ground that they were not supported by the disclosure of the reissue application and refused to set up an interference between the reissue application and the Bergholm patent.

12. An appeal was taken from the final rejection of the Primary Examiner to the Board of Appeals which affirmed the rejection of the Primary Examiner as to all of the appealed claims, on October 6, 1941, holding that said Claims 15, 16, 38 and 39 were not readable upon the disclosure of the reissue application, Serial No. 373,970.

13. No appeal to the Court of Customs and Patent Appeals has been taken from the decision of the Board of Appeals.

14. Plaintiff avers that Claims 15, 16, 38 and 39 are readable upon the disclosure of the reissue application in the same manner in which they are readable upon the Bergholm patent 2,201,362.

15. Plaintiff hereby avers, and it was so alleged in application Serial No. 373,970 as filed, that the invention therein disclosed and claimed is new and useful and was not known or used by others in this country before Coons' invention thereof, and was not patented or described in any printed publication in this or any foreign country

before Coons' invention thereof or more than two years prior to the filing date of the original application, Serial No. 94,934 and that the invention was not in public use or on sale in this country for more than two years prior to said original application, and was not patented in any foreign country by Coons or his legal representatives or assigns on an application filed more than twelve months prior to the said original application for United States Letters Patent and that the invention was never abandoned.

16. Wherefore the plaintiff prays that the Honorable Court decree that the Commissioner of Patents be directed to find that Claims 15, 16, 38 and 39 are readable upon the disclosure of plaintiff's application and allowable to him.

R. R. FITZSIMMONS,

W. D. SELLERS,

Attorneys for Plaintiff.

State of Illinois,)
County of Cook,) ss:

H. Earl Hoover, being first duly sworn deposes and says that he is the Vice President of The Hoover Company, a corporation, and the plaintiff named in the Complaint herein; that he has read the above and foregoing Complaint, and that the facts asserted therein are true.

H. EARL HOOVER,

Vice President.

Subscribed and sworn to before me this 2nd day of March, A. D. 1942.

MILDRED B. ELSNER,

Notary Public.

Attorney's Address:

8 South Michigan Avenue,
Chicago, Illinois.

Local Solicitor:

Elmer Stewart,
National Press Building,
Washington, D. C.

The Hoover Company,

Plaintiff.

Conway P. Coe, Commissioner
of Patents.

Defendant.

Civil Action,

No. 15,028.

W. W. Cochran, Solicitor,
United States Patent Office,
Attorney for Defendant.

ANSWER TO THE COMPLAINT.

*To the Honorable the Justices of the District Court of the
United States for the District of Columbia:*

1, 2. Defendant admits the allegations of paragraphs 1 and 2.

3. He admits the allegation of his official position and that he is sued in his official capacity. He denies that he is a legal resident of the District of Columbia, his legal residence being in the State of Maryland. He states that his official residence is in the District of Columbia.

4, 5, 6. He admits the allegations of paragraphs 4, 5 and 6.

7. He admits the allegations of paragraph 7.

8. He admits that claim 15 of the application of Curtis C. Coons, No. 373,970, for reissue of patent No. 2,178,870, which application was filed in the Patent Office on January 10, 1941, and entitled "Continuous Absorption Refrigerating System", is substantially like claim 7 of the U. S. patent to Bergholm, No. 2,201,362. He states that claim 15, as set out in paragraph 7, differs from claim 7 of the Bergholm patent in that the word "heat", which occurs in line 11 of claim 7 of the Bergholm patent, is omitted

from plaintiff's claim 15. He admits that claims 16, 38 and 39 of plaintiff's application, which claims are as set out in paragraph 7, bear some similarity to claim 7 of the Bergholm patent.

9, 10, 11, 12, 13. He admits the allegations of paragraphs 9 to 13, inclusive.

14. He denies that claims 15, 16, 38 and 39 of plaintiff's application are readable upon the disclosure of said application and therefore denies that plaintiff is lawfully entitled to receive a reissue patent containing any of said claims, as will more fully appear from the statement of the examiner in answer to the appeal and the decision of the Board of Appeals, copies of which will be furnished at the trial.

15. He admits that in said reissue application the applicant Curtis C. Coons made averments corresponding to the allegations of paragraph 15, but denies, for reasons aforesaid, that such allegations would justify the granting of a reissue patent containing any of claims 15, 16, 38 and 39 of said application.

16. Paragraph 16 is a prayer to the Court which defendant is not required to answer.

W. W. COCHRAN,
Solicitor, U. S. Patent Office,
Attorney for Defendant.

April 24, 1942.

I hereby certify that a copy of this Answer to the Complaint was mailed today, April 24, 1942, to the attorney for plaintiff, Elmer Stewart, National Press Building, Washington, D. C.

W. W. COCHRAN,
Solicitor.

IN THE DISTRICT COURT OF THE UNITED STATES
FOR THE DISTRICT OF COLUMBIA.

The Hooyer Company,

Plaintiff,

Civil Action

Conway P. Coe, Commissioner
of Patents,

Defendant.

No. 15,928.

FINDINGS OF FACT.

1. This is a suit brought under the provisions of Section 4915 R. S. (U. S. C. Title 35, Section 63) in which the plaintiff, The Hooyer Company, seeks to have this Court adjudge that it is entitled to receive a reissue patent on the application of its assignor, Curtis C. Coons, No. 373,970, containing claims 15, 16, 38 and 39.

2. Claim 15 is a copy of claim 7 of the patent to Bergholm, No. 2,201,362, and claims 16, 38 and 39 are modified forms of certain claims of the Bergholm patent. These claims were presented for the purpose of having an interference instituted between the application of Coons and the patent to Bergholm.

3. The patent to Bergholm, No. 2,201,362, discloses a refrigerating system of the absorption type, in Figure 1 of which is shown a generator 10, wherein a mixture of ammonia and water is heated in coil 30, the ammonia vapor with slugs of water passing to the upper portion of the generator, where they are separated. The ammonia vapor flows through conduit 31, vessel 28, conduit 27, the outside passage 25 of a concentric arrangement of three pipes and conduit 26 to the condenser, where the ammonia vapor is condensed into a liquid. This liquid flows into the upper end of the evaporator 16 where the vapor is evaporated and diffused into hydrogen gas, producing a refrigerating

effect. The mixture of the ammonia vapor and the hydrogen gas flows from the upper end of the evaporator through the inner passage of a heat exchanger 21 to the lower end of the absorber. The weakened absorbent liquid flows from the lower part of the generator through conduit 34, the inner passage 23 of the three-pipe arrangement, and conduit 35, and the lower part of the absorber 13, into vessel 14. From vessel 14 the enriched absorption solution flows through the conduit 32, the middle passage 24 of the three-pipe arrangement, conduit 33 and the lower part of conduit 31 in reservoir 28. From the latter the enriched absorption solution flows back to the heating coil 30 and where again the ammonia is boiled off. The patentee, in his patent designated the arrangement of the concentric pipes as "a triple heat exchanger". In it, the refrigerant vapor passing from the generator to the condenser is in heat exchange relation with the enriched absorption solution passing from the absorber to the generator, and the latter is simultaneously in heat exchange relation with the weak absorbent solution passing from the generator to the absorber. The "triple exchanger" is located below the surface level of the liquids in both the generator and the absorber.

4. The reissue application of Coons discloses a refrigerating system of the absorption type, in Figure 1 of which there is disclosed a generator which includes boiler B, to which heat is supplied which drives the refrigerant out of a solution of ammonia and water. The ammonia vapor boils off and carries through the pipe H slugs of the solution into a separating chamber S, from which chamber the ammonia vapor passes through conduits to a rectifier R and condenser C, where it is condensed to a liquid. This liquid passes to an evaporator where the liquid is evaporated by diffusing through an inert gas, producing the desired refrigeration. The mixture of ammonia and the

gas passes into the lower end of the absorber A. The weakened solution passes from the gas separator into the upper end of the absorber. The weakened absorption solution, in passing through the absorber absorbs the ammonia from the mixture of ammonia and inert gas. From the absorber the liquid flows through a conduit 23, rectifier R and a conduit 25, to a reservoir 24 and from that reservoir through a conduit 26 into the boiler B, where the ammonia vapor is again boiled off. The strong absorption solution, in passing from the absorber to the boiler, is in heat exchange relation with the weak solution in two places: one, where the conduits 23 and 22 are in heat exchange relation and, two, where conduits 26 and 22 are in heat exchange relation. The strong solution also passes in heat exchange relation with ammonia vapor in rectifier R. The application, therefore, discloses three heat exchangers. There are two liquid levels in the generator, one in the boiler and one in the separator.

5. The Coons reissue application, No. 373,970, does not disclose "a triple heat exchanger" as called for in claim 15, nor does it disclose "a three-part heat exchanger" as called for in claim 38. It describes specifically three separate heat exchangers.

6. The Coons reissue application does not disclose an arrangement in which "a heat exchanger", as called for in claims 15, 16 and 38, or "heat exchange means" as called for in claim 39, is located below the surface level of liquid in both the generator and the absorber, since it discloses three separate heat exchangers and these heat exchangers are above, and not below, the surface level of liquid in the boiler B of the generator of the Coons application.

7. The applicant Coons has no right to make, in his application, any of the claims 15, 16, 38 and 39, since they are not readable on the disclosure of his application.

CONCLUSIONS OF LAW.

1. In determining whether an applicant has a right to make a claim of a patent, or a modified form of the claim of a patent, copied for interference purposes, his right to make those claims is not established by the mere fact that certain of the elements of the applicant's device are equivalents, within the meaning of that term as used in infringement proceedings, to certain elements of the device of the patent. The applicant has no right to make such claims unless they are directly readable upon his disclosure.

2. The plaintiff, The Hoover Company, is not entitled to a patent on the reissue application of Curtis C. Coons, containing claims 15, 16, 38 and 39, or any of them.

3. The complaint should be dismissed with costs against the plaintiff.

.....
Justice.

IN THE DISTRICT COURT OF THE UNITED STATES
FOR THE DISTRICT OF COLUMBIA.

The Hoover Company,
Plaintiff,

Conway P. Coe, Commissioner
of Patents,
Defendant.

No. 15028.

Civil Action

JUDGMENT.

This action came on to be heard at this term and thereupon, upon consideration thereof, it is this 21 day of June, 1943

Adjudged that the complaint in this case be, and the same hereby is dismissed with costs against the plaintiff.

DANIEL W. O'DONOGHUE,

Justice.

Approved as to form:

.....
Attorney for Plaintiff.

IN THE DISTRICT COURT OF THE UNITED STATES
FOR THE DISTRICT OF COLUMBIA.

The Hoover Company,
Plaintiff,

v.

Conway P. Coe, Commissioner
of Patents,

Defendant.

Civil Action

No. 15,028.

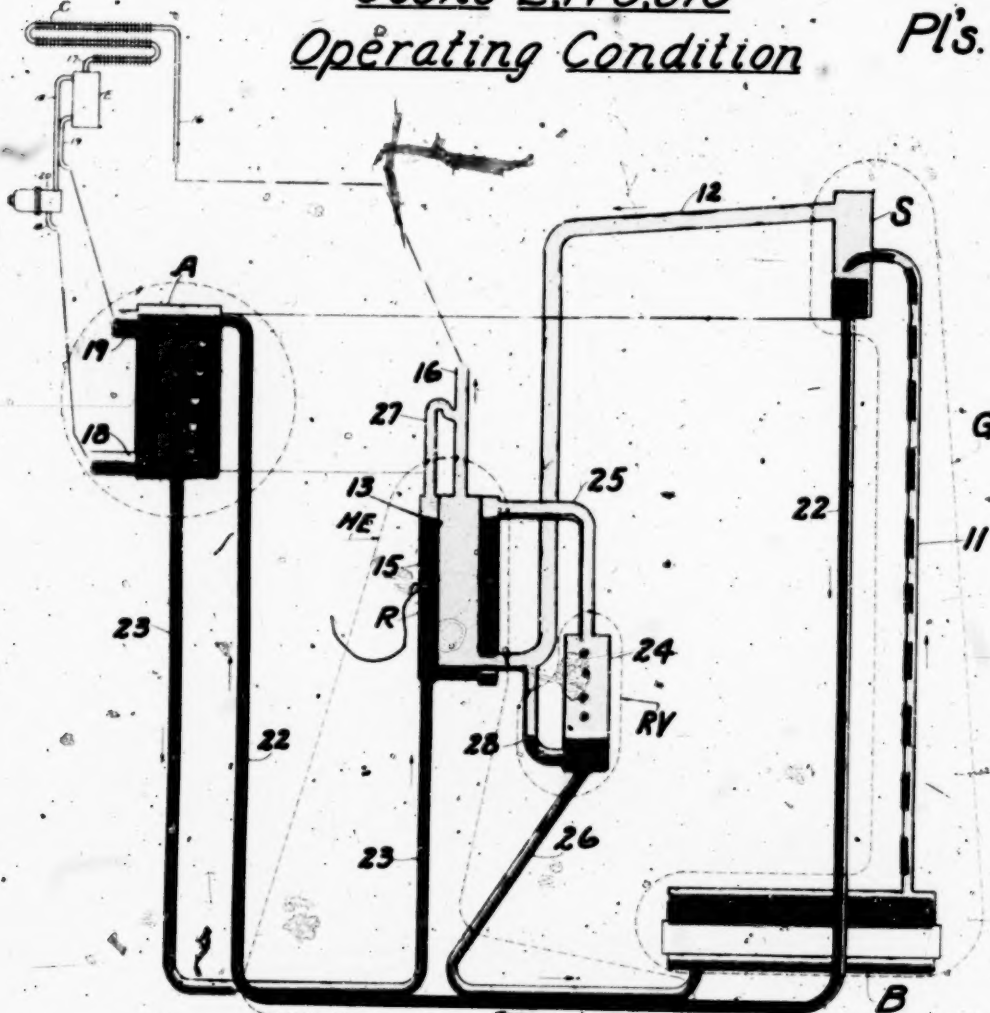
NOTICE OF APPEAL.

Notice is hereby given this 7th day of July, 1943, that The Hoover Company, Plaintiff, hereby appeals to the United States Court of Appeals for the District of Columbia from the judgment of this Court entered on the 21st day of June, 1943, in favor of the Defendant against said Plaintiff, The Hoover Company.

Signed W. D. SELLERS,
Attorney for
The Hoover Company.

Coons 2,178,870
Operating Condition

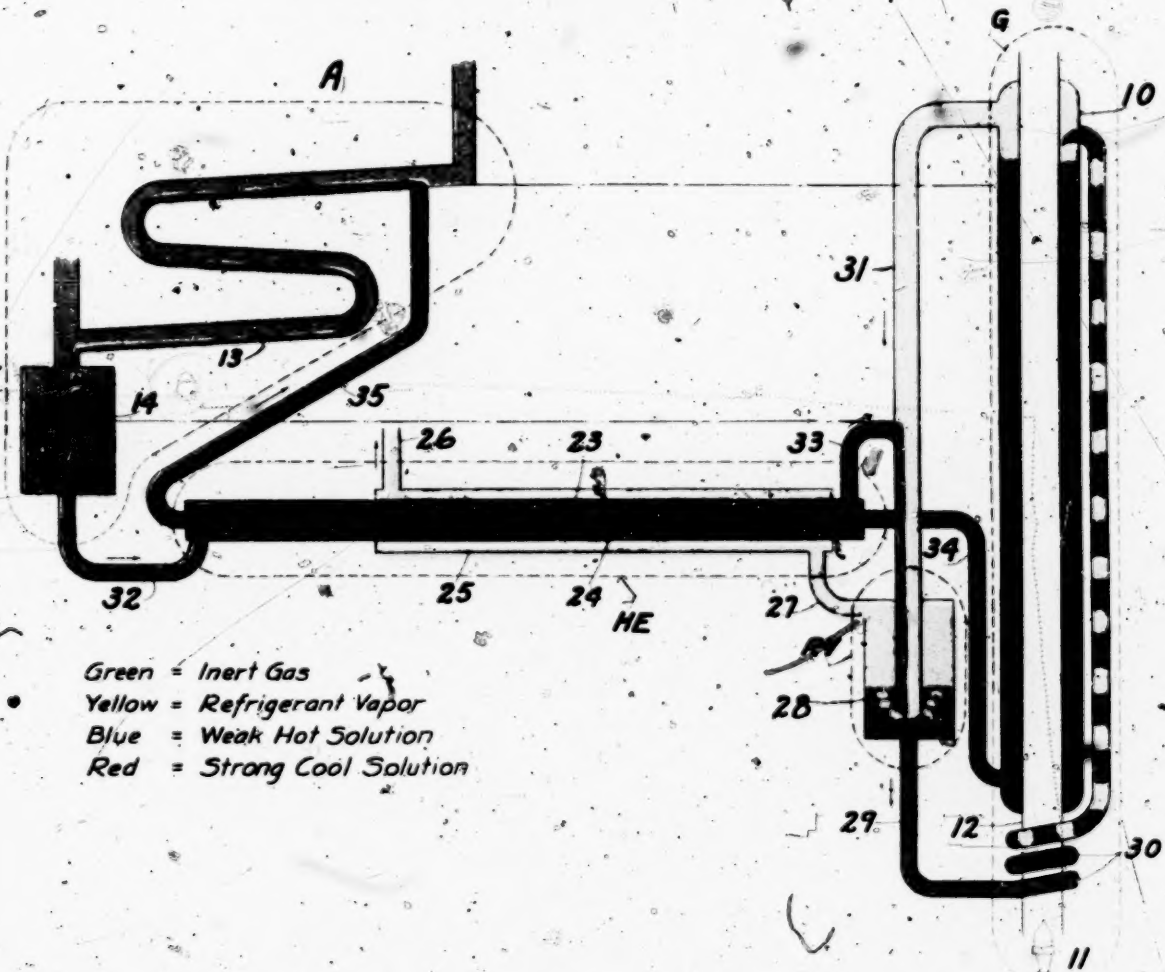
Pl's. Exh. No. 1



Green - Inert Gas
 Yellow - Refrigerant Vapor
 Blue - Weak Hot Solution
 Red - Strong Cool Solution

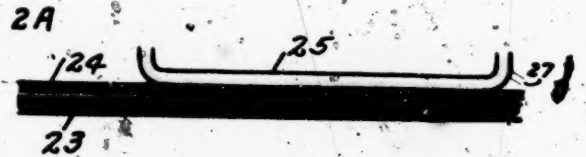
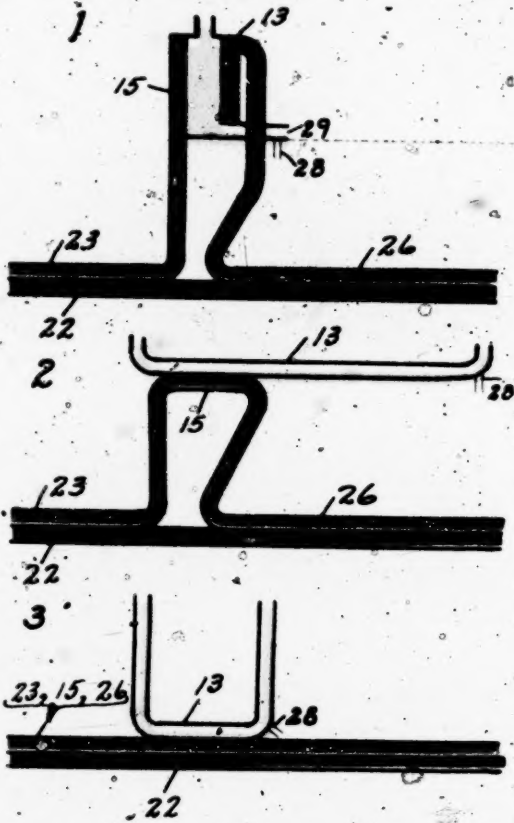
Bergholm 2,201,362
Operating Condition

Pl's. Exh. No. 2



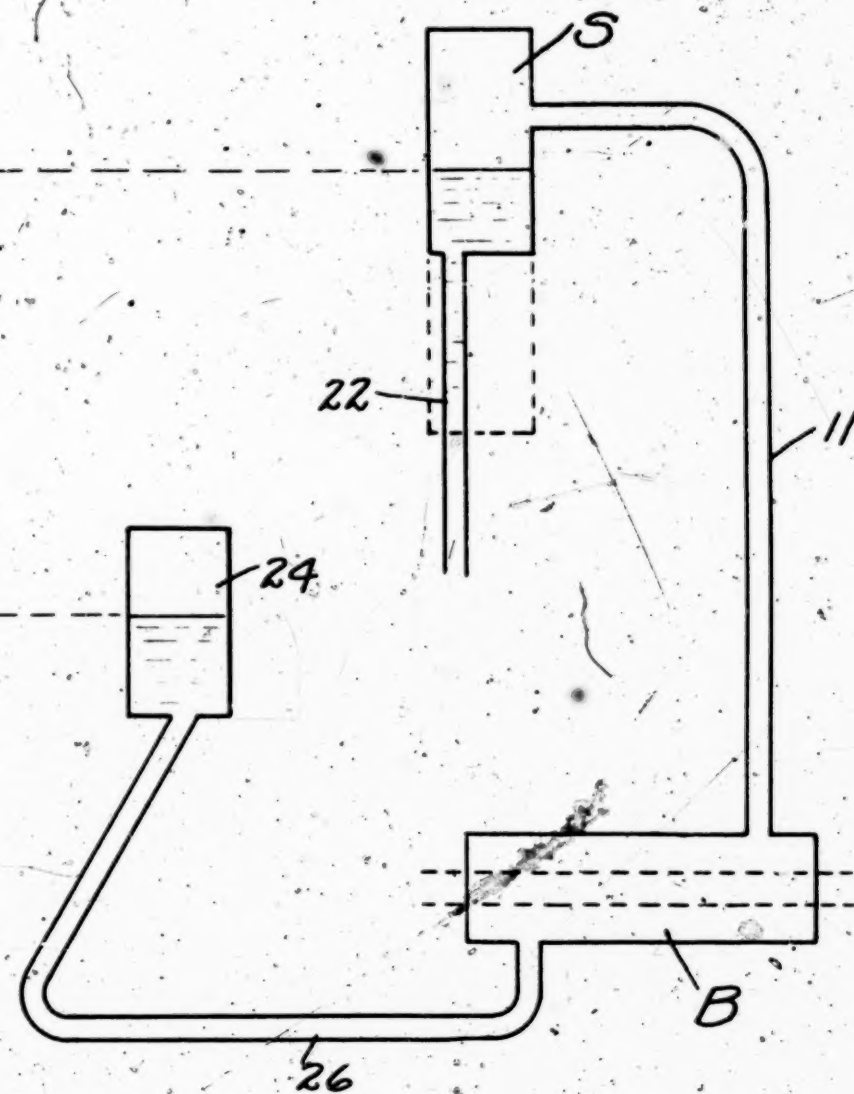
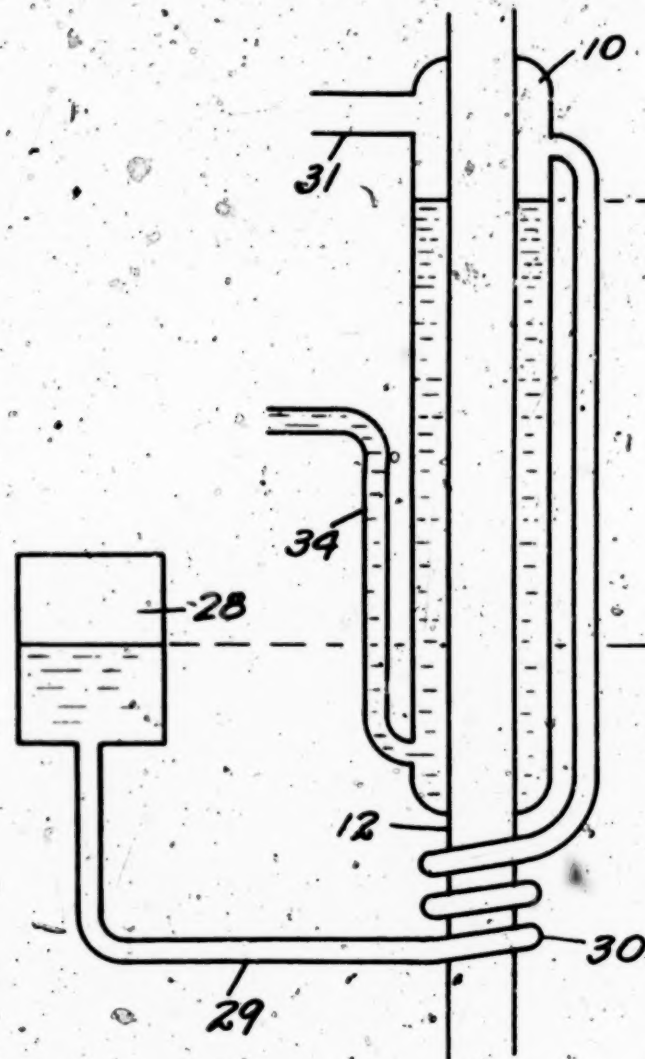
Coons. Heat Exchanger

Pl's. Exh. No 3
Bergholm.



Bergholm's Generating Assembly.

Coon's Generating Assembly.



1 IN THE DISTRICT COURT OF THE
UNITED STATES
FOR THE DISTRICT OF COLUMBIA.

The Hoover Company,
North Canton, Ohio,
Plaintiff,

v.

Conway P. Coe, Com-
missioner of Patents,
Washington, D. C.,
Defendant.

Civil Action 15028.

Thursday, May 20, 1943,
Washington, D. C.

The above-entitled cause came on for trial before As-
sociate Justice Daniel W. O'Donoghue, in Civil Division
No. 5, at 10 o'clock a.m.

Appearances:

On behalf of the Plaintiff:

W. D. Sellers, Esq.,

R. R. Fitzsimmons, Esq. and

W. S. Hodges, Esq.

On behalf of the Defendant:

R. F. Whitehead, Esq.

2 **PROCEEDINGS.**

The Court: You may proceed.

Opening Statement on Behalf of the Plaintiff:

By Mr. Fitzsimmons:

Mr. Fitzsimmons: Your Honor, this is a civil action
against the Commissioner of Patents under the provisions
of Revised Statute 4915.

The application involved is an application by Curtis C. Coons, Serial No. 373,970 filed January 10, 1941.

The application is a re-issue application of the Coons patent 2,178,870 granted November 7, 1939, on an application filed August 8, 1936.

The Coons patent and application is assigned to The Hoover Company, the plaintiff in this action.

The Patent Office refused to allow Claims 15, 16, 38 and 39. No appeal has been taken to the Court of Customs and Patent Appeals. The sole ground of rejection was that the claims do not read upon the disclosure of the application and patent.

Claim 15 was copied from the patent to Bergholm 2,201,362, dated May 21, 1940, granted on an application filed November 20, 1937, and is Claim 7 of that patent.

Claims 16, 38 and 39 are based on Claim 7 of the Bergholm patent and all of the claims in issue were made for the purpose of interference with the Bergholm patent to determine the issue of priority.

We will show that there is no doubt that Claim 39 reads on the Coons disclosure.

We also believe and will show that Claim 15 when given its normal meaning also reads on the Coons disclosure.

If it is held that Claim 15 reads on the Coons disclosure there is no doubt as to the readability of Claims 16 and 38.

We will also show that a common invention exists in fact in the Coons application and in the Bergholm patent and that an interference should be declared between them.

We are asking this court to hold that Claims 15, 16, 38 and 39, or any of them, are in fact, readable on the Coons disclosure.

Now, if the Court please, I would like to refer to this drawing to explain briefly the principles of the invention.

The common invention here relates to absorption refrigerating systems, commonly known as the gas-fired refrigerator. In such systems heat is applied in boiler B to a strong solution of ammonia in water. This drives off the ammonia vapor which mingles with the solution to raise the weakened solution up into a gas separation chamber where the vapor separates from the liquid.

4 In such systems some water vapor also is driven off, and if this water vapor should reach the condenser and be condensed and flow to the evaporator, it will interfere with the operation of the system.

In prior machines it was the usual practice to run this conduit 12 directly up to the condenser with fins on it so that the water vapor, which condenses at a higher temperature than the ammonia, would flow backward through the tube into the fluid circuit.

Now, in such machines this the weakened solution flows by gravity through a conduit over to the absorber where this solution meets the refrigerant vapor generated in the evaporator and absorbs that vapor. The strong solution then flows backward directly to the boiler in heat exchange relation with the weak solution going to the absorber.

The purpose of that is that the strongest solution coming back from the absorber should be as hot as possible, and the weak solution going to the absorber should be as cold as possible, so that it can more readily absorb the refrigerant vapor. This is done by exchanging heat between these two liquids, the one flowing to the absorber, and the other flowing to the boiler.

In the prior machines, it was the usual practice to air cool the pipes leaving the gas separation chamber.
5° The specific heat of that gas and the heat of condensation of the water vapor was totally lost in so far as refrigeration is concerned.

Now, both Coons and Bergholm conceived the idea of partially cooling this vapor by the cold solution flowing backward into the generator so that this cold solution would cool this vapor and condense the water vapor. That keeps the heat, both the specific heat of the vapor, and the heat of the condensation of the water in the system and further heats the strong solution as it flows back to the boiler.

Both Coons and Bergholm lowered what is called the rectifier where they cooled the vapor, downward to a position so that the water vapor condensate could flow by

gravity down into the solution circuit so as to return to the solution circuit and not be trapped in a part of the system where it is of no value.

In order to prevent the ammonia vapor from being cooled to too great an extent the cool solution flowing backward to the rectifier is partially heated by heat exchange with the hot strong solution, so that it isn't too cold, but just the right temperature to condensate the water vapor. That is present in both the Coons and Bergholm.

6 We will show that Coons and Bergholm produced identical results with substantially the same structure.

We will show that the only liquid level of any functional importance existing in the generator or generator vapor lift assembly, as disclosed in the Coons application and patent, is the level in the gas separation chamber and any other liquid level which may exist at times is merely incidental and of no functional significance. The Patent Office Tribunals held that Claim 39 did not read on the Coons disclosure on the sole ground that that disclosure disclosed two liquid levels in the generator and therefore, the claim was meaningless as applied to Coons.

We will show that Coons has a generator in the same sense as Bergholm.

We will also show that Coons has a triple heat exchanger in the same sense that Bergholm has.

We will also show that this heat exchanger of Coons brings vapors and liquids from the generator and liquid flowing to the generator into heat exchange relationship out of physical contact with each other.

We will also show that the heat exchanger of Coons is below the liquid levels in both the absorber and the generator.

7 We will also show that Coons creates a third surface level of liquid in the solution circuit below the exchanger to permit drainage of condensate from the vapor portion of the exchanger into the liquid circuit in exactly the same sense as Bergholm.

That is all, your Honor.

8 **Opening Statement on Behalf of the Defendant.**

By Mr. Whitehead:

Mr. Whitehead: I have a folder, if the Court please, which I will later introduce in evidence which contains the following:

- (a)—Bergholm patent.
- (b)—Prints of drawing;
- (c)—Examiner's Statement;
- (d)—Supplemental examiner's statement.
- (e)—Decision of the Board of Appeals;
- (f)—Decision of the Board of Appeals on Petition for Reconsideration.

I would like to say just one thing, your Honor. These claims are copied from this Bergholm Patent for the purpose of interference with the Bergholm Patent.

I wish to call your Honor's attention to the decisions of the Court of Appeals of the District of Columbia and the Court of Customs and Patent Appeals which show that the doctrine of equivalents is not applicable in cases where claims are copied from a patent and that the claims must be literally readable upon the applicant's disclosure.

The Court: I don't quite get your point there, Mr. Whitehead.

Mr. Whitehead: What I mean is this: Sometimes a machine will do a thing in a certain way which is different from another machine. Now that doctrine does not

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apply to this case.
That is all I wish to say at this time.

10 **Evidence on Behalf of the Plaintiff.**

Mr. Sellers: Your Honor, we would like to call as our first witness Dr. Coons.

Thereupon

Charles Curtis Coons, called as a witness for and on behalf of the Plaintiff, having been first duly sworn, testified as follows:

The Clerk: State your full name.

The Witness: Charles Curtis Coons.

Mr. Sellers: At this time, your Honor, I should like to offer into evidence, Plaintiff's Exhibit No. 7, a stipulation between counsel for the respective parties as follows:

(1) That photostatic copies, blue prints and carbon copies can be received in evidence with full force and effect of the originals subject, however, to verification and correction should error be found therein.

(2) That the printed copies of United States and foreign patents may be used and received in evidence with full force and effect of certified copies.

The Court: It may be received.

(Plaintiff's Exhibit No. 7 received in evidence.)

Mr. Sellers: And I also offer in evidence as Plaintiff's Exhibit No. 8 a stipulated condensation of the file wrapper and contents of the application of Coons which is here at bar.

11 The Court: It may be received.

(Plaintiff's Exhibit No. 8 received in evidence.)

Direct Examination

By Mr. Sellers:

Q. 1. Mr. Coons, will you please state your name, address and occupation?

A. My name is Charles Curtis Coons.

I live at North Canton, Ohio. I am in charge of the refrigeration and air conditioning laboratory of The Hoover Company, also located in North Canton, Ohio.

Q. 2. What is your educational background, Dr. Coons?

A. I received all of my university training at the University of Illinois, specializing in mechanical engineering and physical chemistry. In 1928 I received my Ph.D. in Physical Chemistry.

Q. 3. And what is your experience, please?

A. After leaving the university I was employed by the Leeds & Northrup Company for about four years, in electro-chemistry, and in 1933 I was employed by The Hoover Company, in the refrigeration laboratory.

In 1936 I was made head of that laboratory and have remained as such ever since.

Q. 4. Dr. Coons, will you please address the court?

A. Yes.

Q. 5. And your present title, Dr. Coons.

12 A. At present, I am in full charge of this laboratory, having complete direction of the research work.

Q. 6. For the benefit of the court, will you please describe briefly the compression refrigerator as we ordinarily know it and an absorption refrigerator system of the type of the Coons' invention here before the Court, with special reference to Exhibit 11 which is now placed upon the easel?

A. May I go over to the board?

Q. 7. Yes, if you wish to stand there and point to it, you may.

A. In the ordinary compression refrigerator, a motor and pump compress a refrigerant gas—the motor and pump are the element 30—and the compressed gas flows into a condenser—6, which converts that refrigerant gas into a liquid. The liquid flows through an expansion valve into an evaporator, 3, which, in this case is a coil structure.

Since the pump draws a partial vacuum on the evaporator the refrigerant liquid boils and absorbs heat from the surroundings in the ordinary sense produces refrigeration. That cycle is continued as long as refrigeration is desired.

Q. 8. Will you please describe for the Court, with special reference to Plaintiff's Exhibit 1, the absorption refrigeration, of which the Coons Patent 2,178,870 and the application here at bar are examples?

13 A. Along about 1921 a refrigerator, different from the existing compressor type was developed for commercial use.

This refrigerator is operated entirely by heat. That is, by the mere application of heat to the boiler B, refrigeration is produced in the evaporator marked E.

This small diagram up here is merely diagrammatic and should be increased in size to correspond to the vessels below.

The heat which is applied to the boiler B drives ammonia from a strong absorption solution which is nothing more than ammonia dissolved in water. The ammonia vapor intermingles with slugs of liquid just as in the ordinary coffee percolator, and raises the mixture into the vessel S where the vapor separates from the liquid. This vapor flows into the condenser C wherein it is liquified and then into the evaporator E where it evaporates to produce refrigeration just as in the compression refrigerator.

Now, to get the ammonia vapor back into the absorption solution a vessel marked A called the absorber is utilized. The ammonia vapor flows into the vessel A and is absorbed into the weak solution which has been generated in the Boiler B by the application of heat.

The absorption of the ammonia vapor in the weak solution, of course, increases the strength of the weak solution and makes it a strong solution and it is that strong
 14 solution which flows into the Boiler B and is heated.

That is a simple explanation of the operation of the ordinary ammonia 3 fluid absorption refrigerator.

Q. 9. How would you characterize the chief difference between the absorption refrigerator, and the compression refrigerator which you first described?

A. Well, in the compression refrigerator the pressure throughout the system is variable. That is, on the high side of the compressor the gas is under many pounds compression while on the low side the pressure is, of course, much less. It may be even less than atmospheric pressure. In this machine, which is operated by heat, the pressure throughout the entire system is substantially equal. That is, there is no substantial difference in pressure.

Q. 10. And a further distinction, possibly, relative to the presence of moving parts, what could you say in that connection?

A. Yes. In fact, the two are so decidedly opposite that you could name any number of differences.

In the compression machine, as I have just stated, the motor and pump, of course, operate. The pump is either a piston or a vane type which continuously operates to compress gas. In the heat-operated absorption machine

there is no moving mechanical part necessary to produce the refrigeration.

Q. 11. Referring now, particularly to Plaintiff's exhibit No. 1 which comprises a reproduction of figure 1 of the Coons Patent application, with certain parts colored and other parts reduced in size, will you please point out what problem is solved in the invention of Coons?

A. In the old style heat operated absorption machine the ammonia vapor is led directly from the vessel S into the condenser.

Now, since water is used as the absorbent, it is unavoidable when heating the strong solution, not to have the ammonia vapor contaminated with water vapor. If that water vapor is not removed, it will condensate along with the ammonia and form essentially a strong ammonia water solution, which has a deleterious effect on the operation of the machine.

In other words, you would not be able to produce as much refrigeration with water in the ammonia as you could produce refrigeration without the water.

So, in the old style machine the tube connecting vessel S with the condenser C was finned to permit air-cooling of that pipe and by the air-cooling of the pipe the water was condensed out of the ammonia water vapor mixture and flowed back into the vessel S.

Now, since this pipe was air cooled, all the heat which comes from the latent heat of the water plus the specific heat of the gas, you have to cool the gas from some high temperature down to the condensing temperature.

16 that specific heat plus the heat of evaporation of water was lost to the air, and that meant that more heat had to be put into the boiler to produce a given refrigerating effect or capacity.

Now, if that heat could be saved, that would mean a more efficient refrigerator, so this device included in the dotted line marked HE was used to save that heat, and that is done by bringing the hot ammonia water vapor mixture from the vessel S into heat exchange with the cold strong solution, which is slightly pre-heated, flowing from

the absorber to the generator, the heat exchange taking place between the pipes 13 and 15.

In other words, the specific heat and the latent heat of the mixture is transferred into the strong solution which flows into the boiler or vessel B, and thus permits the reduction in the heat which normally is applied to the vessel B for the production of that particular refrigerating effect.

Q. 12. In the old units, did I understand you to say that the heat of the refrigerant gas flowing from the separating chamber to the condenser was lost to the air?

A. That is right.

Q. 13. And do I understand you to say that in the present invention the heat of condensation of the water vapor plus the specific heat of the gas is usefully employed to heat the strong liquid which is returning to the boiler B?

A. That is correct.

17 Q. 14. Is that problem, and is that solution of the problem, common to both your invention and your application here at bar and to the Bergholm Patent, to which certain claims relate?

A. Yes, it is.

Q. 15. The identical problem is present in both cases?

A. Yes, exactly the same.

Q. 16. And the solution of the problem?

A. It was accomplished in exactly the same way.

Q. 17. You may resume the stand, Doctor.

Have you built an operating model?

A. Yes, we constructed the invention into one of the machines we had at The Hoover Company.

Q. 18. And did it operate satisfactorily?

A. Yes, it did.

Mr. Sellers: Your Honor, we have, in one of the rooms in this building, an operating model of the Coons invention, which is, as I understand, in working condition and operating, and we would appreciate very much if your Honor would view that machine.

The Court: Very well.

Mr. Sellers: You have no objection, have you, Mr. Whitehead?

Mr. Whitehead: No. Glad to have the court see it.

(Whereupon, Court and counsel retired from the
18 Court room to view the model, at which time and
place the trial was resumed as follows:)

Mr. Sellers: Dr. Coons, will you please explain your working model to his Honor, which is identified as Plaintiff's Exhibit No. 5, with specific reference to the diagram which you have in your hand, and which is a small size reproduction of Plaintiff's Exhibit No. 1?

The Witness: Your Honor, this contraption to the right of the machine is merely an auxiliary cooling unit which we had to make because there isn't any cold water in the room.

Normally, these machines are now air-cooled and require no gadgets like that, but this was an old machine that we revised to include the invention and it was water-cooled and I did not hear until a late date, that we did not have water, so we built that. All it does is circulate water through the system to cool the water and the condenser.

It has nothing to do with the operation of the machine other than that.

Now this, in general, comprises the normal old-style absorption refrigerator with the invention itself, which is this device enclosed within the dotted circle marked HE here. The boiler is the vessel B which is there (indicating); and the gas separating chamber is a vessel in here (indicating) to which the pump is connected.

19 That is the line 11—or pipe 11.

The hot ammonia vapor flows downward into the pipe 13, which is enclosed in this insulation. The strong ammonia liquid from the absorber flows down through pipe 23 and is partially cooled prior to its passage through the pipe 15. The heat of condensation of the water as well as the specific heat of the gas is transferred into that strong liquid which then flows into the reservoir marked RV on that chart, and from the reservoir the strong liquid then flows back into the generator.

The water which is condensed in the pipe 13 flows downward through the pipe 28 also into the reservoir marked RV. Now, the reservoir is this large vessel to the right of the pipes 13 and 15, and the complete unit, of course,

must be insulated, otherwise the system would operate very poorly.

It is essential in all of these absorption machines to insulate the parts which are heated and from which heat must not be discharged to the air. The ammonia which is purified from the water in the pipe 13 flows upward through the pipe—it is the pipe connected with the top of pipe 13—into the coil condenser, where it is liquefied, and the liquid flows down through this exhaust tube and upward into the evaporator, and that liquid evaporates and produces refrigeration, and the gas which comes from the evaporation flows to the absorber, where it contacts the weak solution flowing from the vessel S, down through pipe 22, and upward into the top of the absorber, and by that contact of the ammonia gas with the weak liquid, the strong liquor is formed, merely by solution, and the strong liquor, as I have explained, flows back through the heat exchanger, which consists of pipes 23, 15, 13, 26 and 22.

By Mr. Sellers:

Q. 19. You might identify the weak and strong liquors by colors, if you will, Doctor?

A. Yes. The strong liquor is colored red. The weak liquor is colored blue. The ammonia vapor is colored yellow.

Q. 20. Will you please point out to the Court, Dr. Coons, the height of the liquid level in the boiler which is identified as B.

A. The gauge glass which we have here is connected to the top and bottom of the Boiler B, and you will note that the top of the boiler can be seen here and is merely a horizontal tube through which a heating tube is formed as shown on the sketch right here.

The vapor pump is this tube connected to the top of the boiler.

Now, the gauge, as I stated, is connected by pipe to the top of the boiler tube and also to the bottom of the boiler tube, and you can see that the gauge glass is completely filled with liquid.

Q. 21. What is that liquid? What color is it?

A. It is yellow because it has chromate dissolved in it to prevent corrosion within the system, and that is a common means of preventing corrosion in these machines.

Q. 22. Is that gauge filled with liquid up to the top of the boiler level?

A. Yes.

Q. 23. Why is it we cannot see the connections of the gauge to the boiler in a clear manner?

A. We insulated it to get better operation. You can see the bottom tube which runs upward to the bottom of the boiler tube.

The top of the gauge is not connected exactly to the top of the boiler but runs up to the top of the system. In other words, all that it is necessary to do in these gauges is to connect the gauge from the bottom of the point where you want to take the level to some upper point and that does not make any difference as far as the level is concerned in the gauge.

Q. 24. In other words, if there is a liquid level in the boiler, you have a U-tube?

A. The gauge forms the line of the U-tube.

Q. 25. And the water takes the common level in the U-tube?

22 A. Yes.

Q. 26. And, as an expert you state that the liquid level in the gauge accurately indicates the liquid level in the boiler?

A. If there were a liquid level in the boiler, but the gauge is completely filled, and there is no level in the boiler, the boiler is completely filled with liquid.

Q. 27. Now, turning to the gas separating chamber, which is a part of the generator indicated by the dotted line and colorings showing the separating chamber system, will you please refer to the gauge which shows the liquid level in the separating chamber?

A. Again the gauge is connected to some point lower than the vessel S, about in there (indicating) and the upper part of the gauge is connected to an upper part of the system, some gas part, so that the gauge again forms a

part of the U-tube, and as all liquid that stands in a U-tube will seek its own level, they are both indications of the U-tube, and the level is seen here at the upper part of the gauge and stands higher, somewhere up here (indicating) in the vessel S.

It fluctuates because the gas bubbles up from the boiler, — a boiling action just as a coffee percolator. The level fluctuates in that vessel S.

Q. 28. What is the liquid level in the generating system?

23 A. The only liquid level in the generating system, which comprises the boiler B and the pipe H and the vessel S is the level which is shown in the gauge connected to the vessel S.

There is no other liquid level in that generating system.

Q. 29. Now I see another gauge at the left of the exhibit? Will you please tell the Court what that discloses?

A. The gauge to the left of the exhibit is connected to the bottom of the absorber A and to a point higher than the absorber. No, it is connected to the gas pipe leading into the bottom of the absorber to show the liquid level in the absorber, and again the lower part of the gauge is connected so as to form a U-tube, and the gauge is, in this case, the left part of the U-tube, and the level of liquid in the absorber, of course, is shown on the gauge which is shown near the bottom of the absorber. You can see the yellow absorption liquid.

Q. 30. The little pipe right in the center?

A. It is a glass pipe.

Q. 31. And where does that pipe lead, to the bottom of the absorber?

A. It is right at the bottom, I judge about a half an inch above the bottom of the cylindrical absorber.

Q. 32. So that the gauge shows you do have a liquid level in this absorber?

24 A. That is right.

Q. 33. Now, referring to the evaporator, will you please describe its character to the Court as there illustrated?

A. The evaporator, which is to the rear of the unit, is a cylindrical vessel. It looks exactly like the evaporator

shown in the patent 2,178,870 figure 1. The evaporator is the vessel EE, which is a cylindrical vertical tube with heads welded at the top and the bottom. The internal structure of the evaporator is a series of horizontal baffle plates with holes through the center.

Q. 34. You don't need to go into that in detail. It is not essential here.

A. I guess that concludes with the evaporator then.

Q. 35. Do you have a reading upon the thermometer, Doctor, on this evaporator?

A. Yes, which is—there is a thermometer which is in heat-exchange with the outer wall of the evaporator and it now reads one degree above zero.

That is just one degree Fahrenheit.

Q. 36. How does that compare with the ordinary operating temperature of your usual household refrigerator?

A. The temperature at the bottom of the ordinary household-refrigerator usually runs about 20° Fahrenheit.

Q. 37. So that the temperature you have there is 19° colder than in the ordinary refrigerator?

A. That is correct.

25 Q. 38. Referring to the gauge at the rear of the machine, Doctor, please describe to the court what that shows?

A. The gauge to which you refer is connected to show the level in the reservoir marked RV, and again the gauge is connected to the bottom part and to some part of the gas system above the reservoir and the gauge forms a part of the U-tube with the reservoir.

In other words, the gauge comes up like that (indicating) to the right.

Q. 39. And what does that gauge show?

A. That gauge shows the level of the solution in the reservoir. The level is about in the center. If you hold a match there you can see it, your Honor.

The Court: I will take your word for it.

The Witness: The level is about at the center of the reservoir.

It is a yellow solution but it is rather difficult to see.

By Mr. Sellers:

Q. 40. Does this comprise an operating unit, Doctor?

A. It does.

Mr. Sellers: Do you care to ask any questions, Mr. Whitehead?

Mr. Whitehead: Just one question.

Cross-examination.

By Mr. Whitehead:

26 X-Q. 1. Did I understand you to say that the boiler is always full of water and there never can be said to be any level of water in it?

A. That is exactly right.

X-Q. 2. Is that true actually?

A. In all machines of this type there is no level in the boiler.

X-Q. 3. Take the machine as described in the patent you have in your hand. Is there anything in that description to show that fact, to show that that is so constructed that there would be no level in the boiler?

Mr. Sellers: I object to that question. The patent speaks for itself and you know there is a statement in there to that effect.

The Court: Objection overruled.

He may answer.

The Witness: Well, I have been working with machines of this type for ten years and, regardless of what the patent says, I state that there is no liquid level in the boiler. It is just like a coffee percolator. When heat is applied to the boiler ammonia is driven out of the strong solution and a mixture of vapor and slugs form a column enclosed in the pipe H and, as a result of the decrease in total

27 density by this intermingling of vapor and liquid, the force of the liquid maintained in the reservoir

RV will force that mixture upward into the vessel S.

Mr. Whitehead: That is all.

Mr. Sellers: That is all, your Honor. We can adjourn to the courtroom.

(Whereupon the following proceedings were had in the courtroom.)

Mr. Sellers: I wish to thank your Honor for stepping down to view the exhibit.

Redirect examination.

By Mr. Sellers:

R-D. Q. 1. Mr. Coons, Mr. Whitehead mentioned whether or not patent 2,178,879, of which the present application is a reissue, did not contain in its description some reference to a level in the boiler and for the Court's benefit I should like to point out to you the part of the specification to which I think Mr. Whitehead refers. I ask you to read, on page 3 of the specification, Column 2, beginning at line 53.

A. Starting at line 53, I read:

28 "From the above description it will be clear that we have different types of rectifiers adapted to be cooled by strong aqua in accordance with the present invention has been illustrated and described. In all of these arrangements, the rectifier is shown situated above the normal solution level in the boiler so that the rectifier can be drained by gravity flow into the boiler."

R-D. Q. 2. I also ask you to read from page 2, Column 1, beginning at line 61.

A. Starting at line 61 I read:

"It will be apparent from the above description that in the arrangement illustrated in Figure 1, the rectifier is located below the bottom of the absorber but above the normal level of the solution in the boiler B and in the reservoir 24."

R-D. Q. 3. That is enough. Thank you.

Is there actually a liquid level in the boiler B of your construction?

A. No there is not.

R-D. Q. 4. Is that boiler B actually full of liquid?

A. It is.

R-D. Q. 5. Were there a liquid level there, would it have any functional significance in the operation of your unit?

A. No, it would not, because there can't be a liquid level there and still have the machine operate.

29 R-D. Q. 6. What is the level in the generating unit, of which the boiler is a part, which is significant?

A. It is the level shown in the vessel S marked in blue. That is the level in the generating system enclosed in the dotted line G which is of prime importance to the operation of the refrigerator.

R-D. Q. 7. Why is this level important; why is the level in the vessel S important?

A. That level must be above the top of the pipe 22 which joins the absorber A so that the absorption solution can flow by gravity down through pipe 22 and upward into the absorber A.

R-D. Q. 8. Now, were there a level in the boiler B, could the liquid flow from the boiler B in that level through the pipe 22 up into the absorber A as you describe?

A. Not in that construction. It would be impossible.

R-D. Q. 9. So that even though there were a liquid level down here would you say that it had any significance whatsoever?

A. It could not have any.

R-D. Q. 10. Actually is it not a fact that the wording used is a misleading choice of words by the attorney who prepared the case?

30 A. Yes, it is. I have read over that patent, since it belongs to me, and there are other structures shown in the patent which, if it is studied, it can be seen how that particular wording was confused with this particular figure.

R-D. Q. 11. Will you please place upon the easel, Plaintiff's Exhibit No. 2, which comprises a colored showing of the relevant parts of the figure 1 of the Bergholm patent 2,201,362 from which certain of the claims here at bar are derived, and will you please describe that construction for the benefit of the Court.

A. In Exhibit No. 2 we have the same structure as in Exhibit No. 1 except that the tubes which form the structure have a slightly different configuration. The operation of the structure both in Exhibit No. 1 and Exhibit No. 2 are identical.

In Exhibit No. 2 the boiler is the pipe 30 coiled around a heating tube. The gas flame 11 can be seen just below the boiler and is for the purpose of heating the boiler. The heat causes the ammonia to be driven from the strong solution and again a mixture of vapor and liquid results and the intermingled slugs of liquid and vapor rise through the tube connecting the boiler 30 with the vessel 10.

In the vessel 10 the liquid and vapor separate by gravity. The weak solution, which is colored in blue, then flows downward through the vessel 10 upward through pipe 34 and 35, into the absorber A, which is enclosed in part—I beg your pardon, that absorber is 13— which is enclosed in part within the dotted line A.

In this case the absorber 13 is a tube and is inclined downward continuously so that the liquid can flow by gravity into the reservoir 14.

Now, in the absorber 13 the weak solution intermingles with the ammonia vapor and absorbs it, forming the strong solution which is shown in red color, and that strong solution flows from the vessel 14, which is called the reservoir, through pipe 32, 24 and 33, downward into the vessel marked RV and from that vessel it flows downward through pipe 29 into the boiler 30.

The ammonia vapor, which has separated in the top part of the vessel 10, goes downward through pipe 31, through the vessel RV, through the pipe 25 and 26, and from there it goes into a condenser, which is not shown on this exhibit 2.

Again your Honor will note that the strong liquid, which is marked in red, and flowing through the pipe 24, is brought into heat exchange with the hot ammonia vapors flowing from the vessel 10, and by means of that heat transfer the specific heat of the ammonia vapor, plus the latent heat of condensation of the water, are transferred into the strong liquor and heats it before it enters the boiler, thereby saving heat.

The water which is condensed from the ammonia water vapor mixture flows by gravity through pipe 27 into the vessel RV and mixed with the strong solution which is flowing to the boiler 30.

You will also note that prior to the heat exchange of the strong aqua solution and hot vapors, the strong solution is pre-heated by the hot, weak solution flowing through the center pipe 23.

The reason, of course, for pre-heating the strong solution is to avoid the condensation of ammonia in the pipe 25.

R-D. Q. 12. Is the boiler 30 of Bergholm the functional equivalent of the boiler B of Coons?

A. Yes, it is.

R-D. Q. 13. Is there any liquid level in the boiler B of Bergholm?

A. No more liquid level there than there is in Exhibit 1.

R-D. Q. 14. Does the container 10, which has a liquid level near its top in Bergholm correspond to the vessel S, which has a liquid level in Coons?

A. It does.

R-D. Q. 15. Does the heat exchanger contained within the dotted lines and marked HE in Bergholm correspond to heat exchanger which is enclosed in dotted lines and marked HE in Coons?

A. It is the functional equivalent.

R-D. Q. 16. And is there a pre-heating of the strong solution coming back from the absorber to contact with the gas in Coons just as there is a pre-heating in Bergholm?

A. Yes.

R-D. Q. 17. And is the reason for that pre-heating identical in each case?

A. It is.

R-D. Q. 18. What is the generating assembly in an absorption refrigerator? Briefly, what are the units?

A. The generating system is the assembly consisting of the boiler B, pipe 11, and vessel S shown in Exhibit 1 enclosed within the dotted line marked G.

R-D. Q. 19. Referring now to Exhibit 2, do we find a generating unit comprising the same parts?

A. Yes, it is identical.

It contains the boiler 30 and the vessel 10, which is equivalent S in exhibit 1, and a connecting pipe, all enclosed within the dotted line marked G also in exhibit 2.

R-D. Q. 20. Are the two generating units of the Bergholm and Coons devices functionally identical?

A. They are absolutely identical.

R-D. Q. 21. I have placed upon the easel Plaintiff's Exhibit No. 4 which comprises a diagrammatic showing of the two generating assemblies of the Coons and the Bergholm constructions.

Will you point out for the benefit of the court, the identity of those constructions?

A. In Exhibit No. 4 the Bergholm structure is shown to the left and the Coons structure to the right.

In each structure there is a reservoir, 28 in Bergholm and 24 in Coons. In each reservoir there is maintained a solution level. Each diagram contains a boiler. In Bergholm it is a pipe coiled around a heating tube. In Coons the boiler is a concentric horizontal tube with an internal tube for heating the liquid. Each boiler is connected to a gas separating chamber by a pipe. The pipe in Bergholm is shown as being connected between the boiler 30 and the top of the vessel marked 10.

In Coons the pipe is marked No. 11. Each diagram shows a gas separating chamber for the purpose of separating the hot ammonia vapors from the weak liquid.

In Bergholm it is marked 10 and in Coons it is marked S.

R-D. Q. 22. Doctor, are the vessels 28 and 24 of Bergholm and Coons respectively actually a part of the generating assembly?

A. They are not generally considered a part of the generating assembly; no, sir.

R-D. Q. 23. What is the function of the liquid level in those two vessels?

A. In order that liquid be pumped from the level in 28 to some upward level, a level above that in 28 which is shown in the vessel 10 of Bergholm and vessel S of Coons, it is necessary to use the old coffee percolator principle in which a head of liquid is maintained on a heated element which is below the head of liquid maintained on that heated element, and by heating a portion or all of the liquid say in boiler 30 Bergholm, or boiler B in Coons, part of the liquid is changed to gas,—in this case it would be ammonia,

--which is driven from the solution the ammonia gas, intermingles with the liquid, and forms a column of bubbles and liquid in the pipe 11 of Coons and the pipe which joins boiler B to the vessel 10 of Bergholm; and the reason that that mixture of vapor and liquid rises is because the average density of that column is less than the average density of the liquid column maintained on the boiler as a result of the level in the reservoirs 28 and 24 of Bergholm and Coons respectively.

R-D. Q. 24. As a matter of fact, Doctor, the weight of the liquid in Bergholm between the level in vessel 28 and the bottom of pipe 29 must be greater than the total weight of liquid in the boiler 30 plus that in the rising pipe into the vessel 10, in order that the weight of liquid in the vessel 28 will force the liquid in the boiler 30 and the pipe into the vessel 10?

A. Yes, that is correct.

R-D. Q. 25. And isn't the function the same, of this level in this boiler and this pipe, isn't that identical in the two structures?

A. That is right. It is like the old mine pump in which compressed air is forced into a pipe containing water and a series of bubbles have formed, but due to the fact that there is a level of water above the point where the air enters the column of water that liquid head will force the mixture of air and water upward to some higher level.

R-D. Q. 26. As a matter of fact, you have solid liquid in your boiler in each case and liquid and gas above that in each case?

A. That is correct.

R-D. Q. 27. Is it important where the solid liquid leaves off and the gas and liquid begins as long as the total weight is less than the counterbalancing weight on the other side of the U?

A. That is correct.

The exact line where the bubbles begin is intangible. For example, in heating the boiler 30 undoubtedly there are no bubbles in the bottom of the pipe coil but as the coils rise upward, at some point within that boiler line bubbles begin to form and at the top part, we have

a mixture of bubbles and liquid and an upward rising column of vapor and liquid.

Mr. Sellers: Thank you, Doctor. Please resume the stand.

I hand the court a copy of the patent Hahnel 1,877,857 which has been marked as Plaintiff's Exhibit No. 9.

By Mr. Sellers:

R-D. Q. 28. I ask the witness if he is familiar with this construction (indicating)?

A. Yes, I am familiar with this structure.

R-D. Q. 29. Describe it, please, to the Court, briefly.

A. In Figure 1 of Hahnel there is shown a boiler marked 1, a pipe marked 3 and a vessel marked 4, and an electric heating unit is shown as No. 2.

R-D. Q. 30. And what is the unit shown in Hahnel figure 1 known as?

A. That figure, comprising the vessels 1 and 4, with the pipe 3, is referred to as a generating assembly.

R-D. Q. 31. Is that the same generating assembly we have in Bergholm and in Coons, as illustrated in Exhibit 4, for example?

A. It is. It is exactly the same.

Mr. Sellers: I call the Court's attention to the fact that the Hahnel patent bears the date September 20, 1932, and I direct attention that the descriptive matter of this patent bears out the contention that this is a well-known feature in refrigerators comprising a generating unit.

By Mr. Sellers:

R-D. Q. 32. Referring again to Plaintiff's Exhibit No. 1, which I have placed upon the easel, will you please identify the heat exchange means in Coons, in detail?

A. The heat exchange means in exhibit No. 1 referred to is the assembly enclosed within the dotted line marked H and comprises the tubes 23, 15, 13, 22, and 26.

23 and 26 are really the same tube.

Now, in operation the heat exchanger functions like this: The strong solution which flows from the absorber is quite cold and it first comes in contact with the weak solution, marked in blue, and flowing in the opposite direction

through pipe 22. The strong solution is flowing to the right in pipe 23.

In other words, as a result of the heat exchange the cold strong solution is slightly heated and this pre-heated strong solution then flows upward through pipe 23 and comes in contact in pipe 15 with pipe 13, which is being heated by the hot ammonia water vapor mixture, and as a result of that heat exchange the strong solution is still further heated, and then the strong solution over-
39 flows the pipe 15 and flows down through pipe 25 into the vessel marked 24, and from there it flows through pipe 26, again coming into heat exchange with the weak solution, marked in blue which is flowing to the left from the vessel S, and as a result of that heat exchange, the strong solution is heated still further just before it enters the boiler B.

R-D. Q. 33. Now, Doctor, you mentioned previously that in the gas from the separating chamber S which passes through the tube 12 and into the vessel 13, there is a condensing problem present. What happens to the condensate in that gas?

A. As a result of the heat exchange in the tubes 13 and 15, the water in the gas is condensed into a liquid and it is important that that liquid be drained back into the solution circuit of the system.

Therefore, this part of the heat exchanger, which is the important part,—

R-D. Q. 34. (Interposing) Please identify that for the purpose of the record.

A. The part of the heat exchanger consisting of pipes 13 and 15, must be above the solution level which is maintained in the reservoir marked 24, so that the liquid water will drain by gravity back into the solution circuit.

R-D. Q. 35. Is the condensed liquid shown in blue
40 in the vessel 13 which you have just pointed to?

A. Yes, at the bottom of the pipe 13 may be seen the weak solution maintained at a level just high enough to overflow the pipe 12 and flow downward through pipe 28 into the vessel 24 where it mixes with the strong solution.

R-D. Q. 36. Thank you.

Will you please turn to Plaintiff's Exhibit 3.

I have placed upon the easel plaintiff's exhibit No. 3 which comprises a diagrammatic comparison of the heat exchangers on the Coons and Bergholm constructions and I ask you, Dr. Coons, for the benefit of the court, to explain this showing?

A. The exhibit No. 3 consists of figures 1, 2 and 3 and 1A, 2A and 3A.

Figures 1 and 1 A respectively are diagrams or drawings of the heat exchangers lifted bodily from the patents of Coons and Bergholm.

Again we see the heat exchange means between the hot vapors and the strong solution, in Coons by the pipes 13 and 15 and in Bergholm by the pipes 25 and 24.

The strong solution in each drawing is shown being pre-heated by the weak solution, in Coons by pipes 23 and 22 and in Bergholm, by pipes 23 and 24.

And it is also important to note that in each case, 41 the bottom of the gas heat exchange portion of the drawings, in Coons it is pipe 13; and in Bergholm it is pipe 25, the bottom of those pipes must be above the dotted line shown joining these two pipes 13 and 25 in the Coons and Bergholm respectively, so that the liquid formed by condensation in these two pipes will drain by gravity from them down into the solution circuit again.

Now, to simplify the figures 1 and 1A of Coons and Bergholm respectively, the more complicated structure shown in figures 1 and 1A is replaced by the simplified structure shown in figures 2 and 2A.

In figure 2, showing the Coons structure, the heat exchanger between the hot vapors of pipe 15 and the strong solution in pipe 13 are shown as two simple pipes, and in Bergholm, figure 2A, the concentric tube structure is replaced by three simple tubes, and again the heat exchange between the hot vapors and the strong solution is shown by the pipes 25 and 24.

R-D. Q. 37. Is there any real difference between heat exchange by the concentric pipes and pipes which merely make plain contact?

A. No, there is absolutely no difference. It is merely a matter of the area of contact. The principle is exactly the same, regardless of how that contact is brought about, or in what configuration it is brought about.

Again in figures 2 and 2A may be seen the dotted line joining the bottom of pipe 13 of Coons and the bottom of pipe 25 of Bergholm, so that the condensed water may flow by gravity from these pipes into the liquid circuit below.

Now, to go one step further, figures 2 and 2A were changed again to simplify them, and the change is shown in figures 3 and 3A.

It is entirely unimportant where the heat exchange means occurs between pipes 23 and 22 or 26 and 22. That is, that level is unimportant.

And they may be raised upward to contact or to form three pipes in parallel as shown in figure 3.

R-D. Q. 38. To which structure are you referring, Doctor?

A. I am referring to the Coons structure of figure 3.

Again in figure 3 may be seen the heat exchange between the hot ammonia vapors in pipe 13 with the strong solution flowing in pipe 23 and pipe 15 and pipe 26, which is shown in red.

Below that the weak solution, shown flowing in 22 by the blue color is shown in heat exchange with the strong solution, marked in red.

Now, since the actual configuration of structures for heat exchange is unimportant; for the purpose of explanation we can merely shorten pipe 25 of Bergholm to make the smaller U-tube which is shown contacting the pipe 24 conveying the strong solution. The pipe 25, of course, contains the hot ammonia vapors.

Now, it is obvious that figures 3 and 3A are identical, and since 3 is the same as 1 in principle and 3A is the same as 1A in principle, then it follows that figure 1 and figure 1A are identical, which they are exactly in function.

R-D. Q. 39. Did I understand you to say, Doctor, that the only pipe level which is important so far as the heat exchange is concerned is the level of the pipe through which the refrigerant vapor passes?

A. Yes, the bottom part of that pipe.

R-D. Q. 40. And the strong and weak liquid solution pipes can be raised or lowered relative to that as shown without any effect upon the operation?

A. That is absolutely true. It makes no difference.

R-D. Q. 41. Please resume the stand.

As used in the refrigeration art, what is meant by a triple heat exchanger?

A. The refrigeration art refers to a triple heat exchanger as a device for bringing three fluids into heat exchange.

R-D. Q. 42. Are the identical fluids brought into heat exchange in Bergholm and Coons?

A. They are.

R-D. Q. 43. And in the same manner?

44 A. Exactly.

Mr. Sellers: I mark as plaintiff's Exhibit 12, copy of the Mortensen Patent, 1,854,619, which shows a triple heat exchanger, the patent being issued April 19, 1932.

By Mr. Sellers:

R-D. Q. 44. What is a heat exchanger, defined broadly, Dr. Coons.

A. Broadly, a heat exchanger is a device for bringing into heat exchange relationship fluids having different temperatures so that the heat from the hotter fluid can be transferred to the colder fluid.

R-D. Q. 45. Please refer to the Mortensen Patent, Plaintiff's Exhibit No. 12. Does this patent show the triple heat exchanger of the concentric type as shown in Bergholm?

A. Yes, it does.

Mr. Sellers: I mark as Plaintiff's Exhibit No. 6 a chart which shows the application of the four claims here at bar to the Bergholm and Coons construction, and pass that over.

By Mr. Sellers:

R-D. Q. 46. To your knowledge, Dr. Coons, does this chart accurately disclose the application of the four claims to the Bergholm and Coons constructions?

A. Yes, it does.

45 Mr. Sellers: Your Honor, would you like to have us apply these claims for your benefit? That is the issue. This is the issue, your Honor, whether or not the claims read upon these structures.

The Court: Produce whatever testimony you desire. I have no wish in the matter.

By Mr. Sellers:

R-D. Q. 47. Will you please apply, for the benefit of the Court, Dr. Coons Claim 15 to the Coons construction as illustrated in Exhibit No. 1?

A. I read Claim 15 and apply it to the Exhibit No. 1:

"An absorption refrigerating system, having a circuit for absorption liquid."

The circuit for absorption liquid comprises the absorber A, the pipe 22, the pipe 15, the pipe 25, the vessel 24, the pipe 26, the boiler B, the pipe 11, the vessel S, the pipe 22.

"Including a generator."

May I ask how I can distinguish the parts of this Claim?

R-D. Q. 48. Well, I would suggest you use the chart 6, Dr. Coons, which has it divided rather clearly.

A. Using the chart, Exhibit No. 6 now claim 15 will be applied to the Exhibit No. 1, starting at the beginning.

The Claim 15, of course, is shown in the column 46 of figures to the left on the exhibit 6; and the vessels or pipes in question are shown in the column on the right of Exhibit No. 6.

The limitation is the part of the Claim read.

Now, starting in with Claim 15 under limitation, I read:

"An absorption refrigerating system having a circuit for absorption liquid including—"

No question about that.

"—a generator,—"

That is the vessel B, the pipe 11, and the vessel S.

"—an absorber."

The absorber is the vessel A.

"—and a triple heat exchanger—"

That is composed of the pipes 22, 26—22, 23-13, and 15.

"—said exchanger—"

That consists of the pipes whose numbers I just read.

"—being connected to conduct vapors . . . from the generator—"

That is the conduit 12.

"—(being connected to conduct) * * * and liquid from the generator—"

That is the conduit 22.

47 "—(being connected to conduct) * * * and liquid flowing to the generator—"

That consists of conduits 23, 15, 25, vessel 24 and conduit 26.

"—in heat transfer relation out of physical contact with each other,—"

That occurs in pipes 22, 26-22, 23-13 and 15.

R-D. Q. 49. What do you mean by "out of physical contact with each other", Doctor?

A. That means that the two fluids do not come into physical contact. That is, they do not touch or intermingle.

R-D. Q. 50. Just the conduits touch?

A. That is right.

R-D. Q. 51. Continue, Doctor.

A. "—said exchanger—"

R-D. Q. 52. You have identified that?

A. Yes.

"—also being located at a level below the surface level of liquid in both said generator—"

They are the pipes that I have read pertaining to the exchanger and there all of them are below the level of liquid shown in the generating system, which is enclosed within the dotted line marked G.

"—(also being located at a level below the surface levels of liquid in both) * * * and said absorber,—"

48 Again the pipes I have read referring to the triple heat exchanger all lie below the liquid level in the absorber marked A.

"—and means for creating a third surface level of liquid in said circuit—"

That third level is in the vessel 24, enclosed within the dotted line marked RV.

"—below said exchanger"

The vessel 24 is below the bottom of the pipe 13 and pipe 15 for the purpose specified. That is, to permit the

liquid water to drain from the pipe 13 into the vessel 24.

"—to permit drainage of condensate from the vapor portion of said heat exchanger into said liquid circuit."

That I just explained. The drainage occurs from pipe 13 through the conduit 28 into the vessel 24 and then downward through the pipe 26 into the boiler.

R-D. Q. 53. The level in the reservoir 24 is below that portion of the heat exchanger through which the gas flows and in which the condensation occurs?

A. That is right.

R-D. Q. 54. Is there any possible use in putting this reservoir below the fluid conduits in which no condensation occurs?

A. No.

49 R-D. Q. 55. Please now apply Claim 39 to the Coons construction.

A. Again I read from Exhibit No. 6 for Claim 39:

"An absorption refrigerating system having a circuit for absorption liquid including—"

There is no question.

"—a generator—vapor lift assembly,—"

That consists of the vessel B, the pipe 11 and the vessel S, all within—all enclosed within the dotted line marked G.

"—an absorber"

That is the vessel A.

"—and heat exchange means,—"

That consists of the pipes 22, 26—22, 23-13 and 15:

"—said exchange means—"

That consists of the pipes numbered just as I have read them.

"—being connected to conduct vapors * * * from the generator,—"

That is conduit 12:

"—(being connected to conduct) * * * and liquid from the generator—"

That is conduit 22.

"—(being connected to conduct) * * * and liquid flowing to the generator—"

50 That circuit consists of pipes or conduits 23, 15, and 25, vessel 24 and conduit 26.

“—in heat transfer relation out of physical contact with each other,—”

That consists of heat transfer that occurs between the fluids in the pipes whose numbers I have just read.

“—said exchange means—”

Again the numbers I have read apply to those pipes.

“—also being located at a level below the surface levels of liquid in both said generator-vapor lift assembly—”

The heat exchange means, which consists of pipes 22, 26, 22-23, 13 and 15 all lie below the surface level in the vessel S, which is a part of the generating assembly contained within the dotted line marked G.

“—(also being located at a level below the surface levels of liquid in both) . . . and said absorber,—”

The heat exchange means included within the dotted line HE consists of pipes whose numbers I have just read, likewise below the liquid level in the absorber A.

“—and means for creating a third surface level of liquid in said circuit—”

That level is within the vessel marked 24.

“—below a vapor portion of said heat exchange means—”

51 Pipe 24 is below 13.

In other words, the level in the vessel 24 must lie below the bottom of the pipe 13.

“—to permit drainage of condensate from the vapor portion of said heat exchange means into said liquid circuit.”

For the reasons just stated above.

Mr. Sellers: Thank you, Doctor.

I shall, at this time offer into evidence as Plaintiff's Exhibit No. 1, the colored diagrammatic showing of the circulating system which is on the easel; as Plaintiff's Exhibit No. 2, the enlarged diagrammatic colored showing of the Bergholm patent, figure 1; as Plaintiff's Exhibit No. 3, the enlarged diagrammatic showing of the heat exchanger construction; as plaintiff's exhibit No. 4 the enlarged diagrammatic showing of the generating assemblies; as Plaintiff's Exhibit 5 the operating model which

we used; as Plaintiff's Exhibit No. 6 the chart showing the application of the claims of which Dr. Coons applied Claims 15 and 39.

As Plaintiff's Exhibit No. 7, the stipulation relative to photostatic copies and blue prints, et cetera.

As Plaintiff's Exhibit No. 8, the stipulated condensations of the file wrapper and contents.

As Plaintiff's exhibit No. 9, copy of the Hahnel patent 1,877,857.

52 As Plaintiff's Exhibit No. 11, the enlargement of figure 10, showing the older type compressor unit; and

As Plaintiff's Exhibit No. 12, the soft copy of the Mortensen Patent 1,854,619.

The Court: There being no objection, they may be received.

(Plaintiff's Exhibits 1, 2, 3, 4, 5, 6—(7 and 8 received page 10)—9, 11 and 12 received in evidence.)

Mr. Sellers: Do you care to cross-examine further?

Mr. Whitehead: Just two questions.

Recross-examination.

By Mr. Whitehead:

R-X Q. 1. I understood you to say that in the Coons application the heat exchange means is all located below the level of the liquid in the chamber 24.

Is that correct?

A. No, I don't believe I said that all of the heat exchange is located below that level.

R-X Q. 2. Well, is it all located below that level in the Coons' application?

A. No, not the heat exchange means.

R-X Q. 3. Now, about this Mortensen patent, I understood you to say that this disclosed a triple heat exchange?

A. I believe I did.

53 R-X Q. 4. Well, is that so described in the patent?

A. I think it is described as a heat exchanger in which three fluids are brought into heat exchange relationship.

R-X Q. 5. Is the expression "a triple heat exchanger" used in the patent itself?

A. I don't recall. I would have to refer to it.

Mr. Whitehead: The reason I am asking that question is because I understood counsel to ask if it was in the patent.

I may have been mistaken about that. I wish to clear it up if I misunderstood.

Mr. Sellers, you may correct me. I understood you to ask the question, was the triple heat exchanger described and disclosed in this draft?

Mr. Sellers: I don't believe, Mr. Whitehead, I said described and disclosed and claimed.

I was interested in determining whether triple heat exchangers were known in the art, and I asked if this did not show a triple heat exchanger.

Whether it describes and discloses the triple heat exchanger in full, I am not interested in that, but whether or not it shows a structure which is in effect a triple heat exchanger.

54 Mr. Whitehead: No further questions.

Mr. Sellers: One further question.

Further redirect examination.

By Mr. Sellers:

R-D. Q. 56. That Mortensen does show a three fluid triple heat exchanger?

Point out to his Honor whether he uses the term "triple heat exchanger" or not?

A. Yes, he shows and describes a device in which three fluids are brought into heat exchange, just exactly as in both of them.

R-D. Q. 57. In concentric relationship as in Bergholm?

A. That is correct.

R-D. Q. 58. Relative to Exhibit 1, Mr. Whitehead asked you was it a fact that the entire heat exchanger was above the liquid level in the reservoir 24—

Mr. Whitehead: I asked whether it was below.

The Witness: Yes, that is what he asked.

Mr. Whitehead: I understood him to say it was below the level in that chamber 24.

Mr. Sellers: The entire reservoir below the level here (indicating)?

The Witness: No. I understood Mr. Whitehead
55 to ask whether the heat exchanger was entirely below the level of liquid in the vessel 24.

Mr. Whitehead: Yes, that is what I asked.

Mr. Sellers: I have no further questions to ask about that.

By Mr. Sellers:

R-D, Q. 59. Is it not a fact, Dr. Coons, that the gas conduit part of the heat exchanger is above the liquid level in the reservoir 24?

A. That is correct.

R-D, Q. 60. Is it important that that be above?

A. Yes, it is important, and it is unimportant where the other pipes of the heat exchanger lie.

Mr. Sellers: Thank you.

The Court: You are excused.

(Witness excused.)

Mr. Sellers: Your Honor, after due notice to the solicitor for the Commissioner, we took the deposition of Mr. Muffy, the past president of the American Society of Refrigeration Engineers.

That deposition has been filed and we wish to make use of it as a part of our evidence.

That deposition covers much the same ground as Dr. Coons has been over. Our normal procedure, in the Seventh Circuit, would be to read that into the record.

The Court: You can offer it in evidence and the
56 Court will read it when it takes the case under advisement. Where is the deposition?

Mr. Sellers: The deposition has been filed in the case. I wish to have it marked as Plaintiff's Exhibit No. 10.

The Court: Glenn Muffy?

Mr. Sellers: Yes, sir.

The Court: It will be received into evidence.

Mr. Sellers: You prefer that we not read it in?

The Court: I can read it much faster than you could read it in court.

Mr. Sellers: Yes, your Honor.

Then we will not read it. I will merely offer that as Plaintiff's Exhibit No. 10.

Mr. Whitehead: No objection.

The Court: Very well.

That will be received in evidence.

(Plaintiff's Exhibit 10 received in evidence.)

Mr. Sellers: That comprises the direct case for the plaintiff.

57 **Evidence on Behalf of the Defendant.**

Mr. Whitehead: I want to introduce in evidence the folder, which I handed to your Honor this morning, as defendant's Exhibit No. 1.

Mr. Sellers: I have no objection.

The Court: It may be received.

(Defendant's Exhibit 1 received in evidence, containing:

A—Bergholm 2,201,362;

B—Prints of Drawing;

C—Examiner's Statement;

D—Supplemental Examiner's statement;

E—Decision of the Board of Appeals;

F—Decision of the Board of Appeals on Petition for Reconsideration.)

Mr. Whitehead: That is all.

Mr. Sellers: I have nothing further.

The Court: That closes all the testimony in the case?

Mr. Sellers: If does, your Honor.

The Court: Do you want a few minutes to sum up the case on each side?

Mr. Sellers: Yes.

58 **Summation on Behalf of the Plaintiff.**

By: Mr. Fitzsimmons.

Mr. Fitzsimmons: Your Honor, we have shown by demonstration of the physical embodiment of the Coons' disclosure, and the testimony of Dr. Coons, who is eminently qualified to testify as an expert in this art, that the boiler B per se is full of liquid.

We have also shown by the testimony of Dr. Coons and Mr. Muffy, who is past president of the American Society

of Refrigerating Engineers, that any indistinct point of separation between the liquid and the vapor in the boiler B or the tube 11 has no functional significance in this case.

We have also shown by the gauge glasses on the physical exhibit and by the testimony of Dr. Coons that there is a level in the absorber A, there is a level in the gas separation vessel S, and a level in the reservoir RV, which levels are the only levels of importance in the system.

The patent office rejected claim 39 on that sole ground, stating that in view of the fact that plaintiff showed two liquid levels in the generating assembly, which consists of the boiler B, the conduit 11, and the gas separation chamber S, the claim had no meaning.

With the Court's permission may I read claim 39 on the physical exhibit:

"An absorption refrigerating system having a circuit for absorption liquid including a generator-vapor lift assembly,—"

The liquid circuit is the conduits 22 and 23, the absorber, conduits 15 and 13, and the generator-vapor lift assembly comprises the gas separation chamber S, boiler B and conduit 11.

"—an absorber—"

The absorber A..

"—and heat exchange means,—"

Comprising the conduits 22 and 23, where they come into heat exchange relation; and conduits 13 and 15, where they come into heat exchange.

"—said exchange means being connected to conduct vapors from the generator."

Vapors from the generator flow by conduit 12 to the conduit 13.

"—and liquid from the generator—"

Flows from the Vessel S into heat exchange with both conduits 26 and 23,

"—and liquid flowing to the generator—"

Liquid flowing to the generator from the absorber flows through conduit 23 through the heat exchanger and through the conduit 15, vessel 24, conduit 26, back to the generator.

60 "—said exchange means also being located at a level below the surface of liquids in both said generator-vapor lift assembly and said absorber,"

The heat exchange means of the system outlined by the dotted line HE is obviously below a level in the absorber and below a level in the vapor separating chamber S.

"—and means for creating a third surface level of liquid in said circuit below a vapor portion of said heat exchange means to permit drainage of condensate from the vapor portion of said heat exchange means into said liquid circuit."

The only reason the vapor portion is above this vessel (indicating) is so that the vapor condensed therein can flow by gravity to the liquid circuit.

It is submitted that there should be no question as to the readability of claim 39 on the Coons construction:

We have also shown by the testimony of Dr. Coons and Mr. Muffy that both Coons and Bergholm have had a common problem and it is submitted that we are entitled to an interference with that patent, if not upon the other Claims, upon Claim 39.

We have shown by the testimony of Dr. Coons and Mr. Muffy that the term "Triple heat exchanger" as used by Bergholm means the provision of means for the flow of three fluids, two of which are in heat exchange with
61 the third, and that Coons has such an exchanger.

We have also shown by the testimony of Dr. Coons and Mr. Muffy, with reference to Plaintiff's Exhibit 3 that the heat exchanger of Coons is the exact equivalent of that of Bergholm.

We have also shown, by the testimony of Dr. Coons and the patent of Hahnel, that in the refrigeration art to which both the Coons and Bergholm's patents relate, that "a generator" comprises:

1. a place where heat is applied to drive refrigerant vapor from the strong solution,
2. a vapor lift pump which utilizes the vapor thus produced to raise the weakened solution to a

level from which it can flow through the remainder of its circuit by gravity, and,

3. a place of separation where the vapor and solution separate by gravity.

We have also shown that the boiler B tube 11 and vessel S of Coons constitutes a generator in the same sense as Bergholm's heating coil 30, the tube rising therefrom and the vessel 10.

We have also shown by the physical exhibit and by the testimony of experts that the heat exchanger of Coons is below the liquid level in the absorber and below the liquid level in the gas separation chamber.

We have also shown that the only liquid level in the generator having any significance is the level in the gas separation chamber.

Mr. Whitehead said that the doctrine of equivalents does not apply in this case and I would like to call the attention of the Court to the case of Monopower Corp. et al v. Coe 46 USPQ 403, 33 F.S. 934.

In that case, as in this, the claim was copied from a patent and was an action under R.S. 4915 to test the holding of the Patent Office, that the claim would not read on the plaintiff's disclosure.

The question arose in that case as to whether a gear slidable upon a splined shaft to mesh with other gears would respond to the term "Clutch" as required by the claim and whether or not the slidable gear sliding from one to another provided a continuous transmission of power.

The Court said: "The two mechanisms are designed to accomplish changes of speed and without interruption in the flow of power. Thus each structure does by means which, if not identical, serve the same identical purpose. It could hardly be thought that, if either of these structures appeared in the prior art, the other one would be considered patentable. Where two or more parties claim substantially the same patentable invention, the rules of the Patent Office provide for an inter-

ference proceeding, instituted for the purpose of determining the question of priority of invention between such parties.—Where an applicant discloses a mechanism which performs a new and useful function by such substantially similar mechanical operation as a mechanism disclosed in an application, subsequently filed, there should be, by some appropriate means, a determination as to priority of invention before a patent is denied to the first applicant. And while due regard should be given to the meaning of the terms used in claims proposed for a proceeding to determine that priority, the determination of who is the first inventor should not be frustrated by putting the entire emphasis upon the exactitude of terminology employed in the claim."

That case was decided by the U. S. District Court for the District of Columbia.

I also call to the Court's attention too the following other decisions:

Bechtold v. Lanser 29 USPQ 130, 82 F. (2nd) 415 and Wiegel v. Hobbs 87 F (2d) 496.

Hydraulic Press Corp. Inc. et al v. Coe 56 USPQ 437.

Your Honor, it is submitted that each and all of the claims involved in this interference read upon the Coons construction and that an interference should be instituted for the determination of priority.

The Court: This application was first filed in the Patent Office when?

Mr. Fitzsimmons: The Coons application, original application was filed in 1936; the Bergholm in 1937.

The Court: Now then, the Coons application, were certain of the claims granted?

Mr. Fitzsimmons: There are claims allowed in the case.

The Court: How many?

It doesn't make much difference, but how many, about?

Mr. Fitzsimmons: I should say there are at least 14 or 15.

The Court: Claims allowed?

Mr. Fitzsimmons: That is right.

The Court: He has received a patent on certain claims?
Mr. Fitzsimmons: I think there are 9 in the patent as issued.

The Court: Now then, in that same proceeding, certain claims were denied, is that right?

Mr. Fitzsimmons: Not in that proceeding.

The Court: That is what I wanted to find out. In another application?

Mr. Fitzsimmons: We re-issued the patent, and
65 copied claims from the Bergholm for the purpose of interference.

The Court: And those are the claims before the court now?

Mr. Fitzsimmons: That is right.

The Court: So then, your idea is that since the Patent Office has refused to grant these four claims that you have here, this court should find in favor of the Plaintiff and it would be in a position to have interference with Bergholm?

Mr. Fitzsimmons: That is right.

The Court: If I find against you, why, you go to the Court of Appeals and if they found against you, why, then you could not have your interference.

Mr. Sellers: May I add just a word, your Honor, to what my co-counsel has said, to this effect, that here we have a single application before us and this whole question is whether or not we can read these four claims upon our construction.

It is a fact that certain of these claims, not all of them—for example, claim 39 is not taken from the Bergholm patent and it reads, beyond a doubt, upon our construction in our opinion, and is not actually taken from the Bergholm patent.

Claim 15, however, is taken from the Bergholm Patent.

The question is whether or not we can copy that
66 claim now in the Bergholm Patent and our position is that this claim, without limiting the interpretation of the terms in any way, but giving to them their normal meaning, reads upon our construction directly, that there is no real need, in such a case, for resort to the Patent.

Those claims are allowed.

If they read upon our construction clearly, when giving the terms their normal meaning, it is almost elementary that they should stand allowed in our patent.

The Patent Office will have to set up the interference, to be sure, but the Court held, in *Hydraulic Press Corp. Inc., et al., v. Coe*, decided by the Court of Appeals in this District, that the claims must be given the broadest interpretations to which they are reasonably susceptible.

Now, if there is any doubt as to the meaning of the terms used, then it is reasonable to return to the Bergholm patent and see what those terms mean, but here there is no doubt they read just as well upon our construction as upon Bergholm's.

There is no necessity for doctrine of equivalents. We have the exact things called for.

67 **Summation on Behalf of the Defendant.**

By Mr. Whitehead:

Mr. Whitehead: Your Honor, these four claims are composed of two groups.

One, Claim 15 is copied accurately from the Bergholm Patent.

The other—the other three—two of them—I think it is all three of them were slightly modified claims based on the claim of the Bergholm patent.

Now, the point on that is, as I called your attention in a case not long ago, the practice grew up in the Patent Office of allowing an interference between a Patent and an Application where the applicant could not make the claims of the patent literally because of some immaterial limitations, in which the issue would be a claim of the patent with those limitations omitted.

Now, so far as I know, I know of no case in which claims copied from a patent have been allowed to an applicant where they did not literally read on the application.

The Court of Customs and Patent Appeals has repeatedly held that you could not have an interference where claims of the patents didn't read on the application and that the doctrine of equivalents was not material.

Now, as far as this question of the triple heat exchanger is concerned, in the Bergholm Patent that arrangement of concentric pipes is defined as a triple heat exchanger.

68. I may say the citation of this Mortensen patent No. 1,854,619 by plaintiff simply confirms the obvious position that that is what a triple heat exchanger is, and when your pipes are arranged in three different groups, as shown in that chart, those three do not make a triple heat exchanger.

Now, they may, in the end, accomplish the same purpose, but that does not make the claim allowable in the application.

So far as this question of levels is concerned, if you are going to take three groups and call them a triple heat exchanger, and then say that they are above or below a certain level, when some of them are, and some of them are not,—the thing that is characterized by a triple heat exchanger in the Bergholm patent, the level of the pipes or with reference to these surface levels, was specified.

If you are going to take a group of three, all of which are not below a certain level, and say that they constitute a triple heat exchanger, the whole of it is certainly not below nor above, whichever way you put it.

There are one or two things I would like to call your attention to, if I may, about this testimony of Mr. Muffly which was introduced here.

On the bottom of page 26 this question was asked:

69. "Question: Can you state, Mr. Muffly, how the Coons heat exchanger assembly would be constructed and insulated if made in accordance with general practice?"

Now, without saying anything about what the general practice is, he says:

"Answer: The heat exchanger assembly including all parts within the broken line identified by the letters HIE would be enclosed within one continuous body of insulating material, and the broken line HIE may be considered as the outline of such a body of insulation."

I don't know what the practice is and I don't think your Honor knows. What was the established practice? It was just a conclusion of his as to what the established practice was.

Now, again on page 19, he said:

"Comparing the two constructions, the boiler B of Coons is the equivalent of the heating coil 30 of Bergholm."

I call your attention to it just to emphasize that the whole theory of this case is predicated, as I see it, on the doctrine of equivalents and not on the doctrine of direct readability of the claims on the Coons application.

Now again, on page 15 the question is asked:

"Question: Would it be fair to say that functionally Coons and Bergholm heat exchangers are identical and differ merely in immaterial structure details?"

Now, again we are coming back to the question of identity, a question of identity of structure, not to the question of functional identity, and these are physical claims, claims for a physical structure.

Now, as I understand, from the reading of the citations, cited, there they had two applications and not an application and a patent already issued. As I said in the beginning, one means the establishment of an interference when it gets back to the Patent Office in a modified claim and the other means an establishment of interference on the basis of the claims which read directly upon the application.

That is the issue in this case.

70 Mr. Fitzsimmons: Mr. Muffly testified that in actual practice the heat exchanger would be all embedded within one body of insulation.

Mr. Muffly is eminently qualified in refrigeration art and as a matter of fact, it would be.

Apparently Mr. Whitehead is stressing the fact that the doctrine of equivalents should not apply in this case and otherwise, he does not contest it.

However, the Monopower Corp. et al v. Coe, to which I called your Honor's attention awhile ago, was an action under R.S. 4915 where a claim was copied from a patent as in this case.

The Court there admitted that the claim did not read literally on the application and it still allowed the applicant to make it.

I think that is all I care to say.

The Court: The Court will take the case under advisement and counsel will be notified of the decision of the Court.

IN THE DISTRICT COURT OF THE UNITED STATES
FOR THE DISTRICT OF COLUMBIA.

The Hoover Company,
Plaintiff,

Conway P. Coe, Commissioner
of Patents,

Defendant.

Civil Action.

15,028.

The Deposition of Glenn Muffly, taken on behalf of the plaintiff in the above entitled case before William C. Meyer, a Notary Public of Cook County, in the State of Illinois, acting within and for the County of Cook and State of Illinois, on the 30th day of March A. D. 1943, commencing at ten o'clock A. M., at 2300 No. 8 South Michigan Avenue, Chicago, Illinois, pursuant to the notice attached hereto.

Present:

Mr. W. D. Sellers and
Mr. R. R. Fitzsimmons,
appeared for plaintiff.

Defendant was not represented by counsel.

2 **Glenn Muffly**, called as a witness on behalf of plaintiff, having been first duly sworn, testified as follows:

Direct examination.

By Mr. Sellers:

Q. Will you please state your name, address and occupation?

A. Glenn Muffly; Springfield, Ohio; consulting engineer in refrigeration, which has been my principal occupation for the past 18 years. I was formerly Chief Engineer of Copeland, Incorporated, one of the pioneer manufacturers of mechanical refrigerators. I am a member of the American Society of Refrigerating Engineers, and have

been National President of this society. I am a registered mechanical engineer in the State of Ohio, and I am President of the Springfield section of the Ohio Society of Professional Engineers.

My consulting work in refrigeration includes analysis of patents, and I have frequently given expert testimony in patent suits concerning refrigeration. I have had over fifty U. S. patents issued on my applications, mainly pertaining to refrigeration.

I am General Chairman of the Joint Committee on Rating Commercial Refrigerating Equipment, this Joint Committee being sponsored by the American Society of Refrigerating Engineers, and includes members from several other organizations in this field.

I am a member of the Standards Committee of the A. S. R. E., and a member of the American Standards Association's Sectional Committee B-9, on refrigeration safety standards.

During my employment by Copeland Products Inc. as Chief Engineer I had charge of laboratory and development work, and later have carried on private development work in my own laboratory, as well as supervising development work in the laboratories of my various clients in refrigeration.

Q. Mr. Muffly, are you familiar with the Coons invention as disclosed in the Coons patent 2,178,870, and in the application serial No. 373,970, here before the Court?

A. Yes, I have studied the patent and the application.

Q. Will you please describe that invention, referring in particular to Plaintiff's Exhibit No. 1, which I have placed upon the easel?

A. This drawing is a duplication of the patent drawing with the important parts enlarged; that is, the patent with which we are concerned.

The refrigerant which has been condensed in the condenser C, and evaporated in the evaporator E flows as vapor into the absorber A, where the gas, in this case ammonia, is absorbed by the weak aqua solution, called weak liquor, thus forming strong aqua ammonia, which is called strong liquor, strong aqua or rich solution. This

strong liquor leaves the absorber through the tube 23 and flows to the boiler B through the intermediate passages colored red on the drawing. The boiler B is a part of the generator indicated on the drawing as G.

The purpose of the generator is to generate refrigerant vapor by evaporation from the strong solution, and further to separate this vapor from the remaining solution which now becomes weak liquor, and is indicated by the color blue on Plaintiff's Exhibit No. 1.

The tube 11 is the conduit of the generator carrying both liquid and vapor from the boiler B to the separator S, as indicated on the drawing by intermittent yellow for gas and blue for liquid. Due to the lighter weight of the gas, this column of intermittent gas and liquid in the tube 11 flows upwardly into the separator S by virtue of the liquid head established in the reservoir 24, as indicated by the liquid level where red and yellow meet.

The ammonia vapor indicated by the color yellow now leaves the generator through the tube 12, and after passing in heat exchange with the strong liquor goes to the condenser where it is condensed, and the circuit of the refrigerant is completed. In the meantime the weak liquor returns from the generator to the absorber by way of the tube 22 which is in heat exchange with the strong liquor.

Aside from the mention of heat exchange, the foregoing is merely to outline briefly the operation of an absorption system.

Q. Are you familiar, Mr. Muffly, with the invention disclosed in the patent to Bergholm, 2,201,362; and if so, will you please describe that invention, referring particularly to Plaintiff's Exhibit No. 2, which comprises an enlarged colored reproduction of that part of Figure 1 of the Bergholm patent in which we are particularly interested?

A. Yes, I have studied this patent, and find that this Exhibit No. 2 duplicates the Bergholm Figure 1 except for the condenser and the evaporator.

The cycle of operation of this system includes evaporation of ammonia in the evaporator, not shown in the exhibit drawing, but included in the patent drawing. The

cold ammonia vapor resulting from this evaporation flows downwardly, through the tube 13, which is a part of the absorber indicated in general by the letter A; as in the Coons patent, this ammonia vapor combines with this weak liquor to form strong liquor, as indicated by the red flow downwardly in tube 13, and the body of the red liquid in the accumulator or sump 14. The strong liquor, indicated in red, flows through the passage 24 to the generator indicated by the letter G, and boiling of the strong liquor starts in the coil 30, which is heated by the burner 11. This boiling generates ammonia vapor, and, as in Coons, the ammonia vapor and liquor, which is now shown by the color blue to indicate that it has been weakened by the loss of the ammonia vapor, flows upwardly in the tube at the right.

This upward flow results from the low average density of the intermittent blocks of liquid and vapor, as in the Coons patent.

In the upper portion of the generator the liquid and vapor are separated by gravity, and we see solid yellow to indicate ammonia vapor in the top of the generating assembly. This ammonia vapor flows from the generator through the tube 31 downwardly into the reservoir R V, and from this reservoir through passages 25 and 26 to the condenser identified as 18 in the patent drawing, but not shown in this exhibit. The portion 25 of this gas passage is a part of the heat exchanger indicated in general by the letters H E.

As in Coons, the weak liquor returns from the generator to the absorber by way of the heat exchanger, the path through tubes 34, 23 and 35 being indicated in blue. As the blue weak liquor enters the absorber it begins to absorb ammonia vapor, and the color changes to red to indicate strong liquor.

Q. Mr. Muffly, do you have an opinion concerning the basic relationship of the Coons and Bergholm constructions?

A. Yes. I would say that they are substantially the same. The functional operation is the same. The arrangement of parts is slightly modified.

Q. Did Coons and Bergholm have a common problem; and if so, how did they solve that problem?

A. They had a common problem in their objective of economy by the conservation of energy. Prior to these patent applications the practice was to cool the hot vapor, which leaves the generator, as through tube 12 of Coons or tube 31 of Bergholm, by the dissipation of heat to air or to water. Coons and Bergholm both provided means for conserving this by transferring it to the strong liquor which is flowing from the absorber to the generator. This provides for cooling the ammonia vapor, and instead of wasting the heat, it is added to the strong liquor which must be still further heated in the generator to boil vapor out of it. In addition each provides for returning liquor condensed out of the vapor to the generator, this condensate combining with the strong liquor in the reservoir 24 of Coons and in the reservoir 28 of Bergholm. In this reservoir in each patent there is a liquid level located below that portion of the heat exchanger in which condensate is removed from the vapor. This establishment of an additional liquid level to provide for the drainage and return of strong liquor to the generator is accomplished in the same manner by both Coons and Bergholm.

While the exchange of heat from the hot weak liquor to the cooler strong liquor is old in the art of refrigeration, both Coons and Bergholm have shown a novel feature in conducting the strong liquor into heat exchange with the weak liquor prior to conducting the strong liquor into heat exchange with the hot vapor. If the strong liquor were conducted immediately into heat exchange with the vapor without this preliminary heating there would be a part of the ammonia vapor condensed as well as the condensing of water vapor out of the ammonia vapor. It is desirable to remove the water vapor from the ammonia, but not to condense the ammonia vapor before it reaches the condenser. Both Coons and Bergholm have provided for preheating the strong liquor so that it does not overly cool the ammonia vapor and thus short circuit its path.

Q. I refer you now, Mr. Muddy, to Plaintiff's Exhibit No. 3, which shows two columns of figures, the left hand column relating to the Coons construction and the right

hand column to the Bergholm construction, the upper figure in each column being a substantial reproduction of the heat exchanger found in Figures 1 of the Coons and 10 Bergholm patents. The Coons figures have been numbered 1 to 3 and the Bergholm figures 1-A to 3-A.

Q. Will you please discuss and compare the heat exchangers of Coons and Bergholm with particular reference to this exhibit?

A. In the upper Coons Figure 1 we see the strong liquor flowing through 23, 15 and 26, in that order, on the way to the generator. Below this we see the weak liquor flowing to the left through the tube 22. We also see a portion of the path of the ammonia vapor which enters at 29 and flows upwardly through the rectifier 13 to exit at the top on its way to the condenser. We also see the drain 28 for condensate collecting in the rectifier 13.

At the right under Bergholm we see in Figure 1-A, which is likewise a replica of a portion of the patent drawing, the conduit 24 carrying strong liquor from left to right, and the conduit 23 carrying weak liquor from right to left, these two conduits being in heat exchange with each other. We also see a portion of the path of the ammonia vapor which enters at 27 and flows through the passage 25, passing out at the upper left of this passage on the way 11 to the condenser. The inlet passage 27 also serves as a drain outlet for condensate equivalent to the drain outlet 28 seen in Coons.

While Coons has shown one of his conduits 15 as an annular conduit, and Bergholm has shown two of his conduits 24 and 25 as annular conduits, this shape of the conduit is not a feature of the invention.

The important points of similarity are that both Coons and Bergholm bring the strong liquor into heat exchange with the weak liquor first, then into heat exchange with the vapor, and finally again into heat exchange with the weak liquor only. The strong liquor is indicated by the color red and the weak liquor by the color blue in all of the figures on the sheet. The refrigerant vapor is indicated by the color yellow in all six of these figures.

The Coons and Bergholm heat exchangers are shown in simplified form in Figures 2 and 2-A respectively. In these simplified figures, the passages are all shown as simple tubes rather than any one of them surrounding another. While Coons shows one annular passage 15 and Bergholm shows two annular passages 24 and 25, the shapes of these passages are of no moment, the only important consideration being the provision of ample contact areas for transfer of the amount of heat involved at the temperature difference available. In Figures 2 and 2-A, it is assumed that each provides ample contact for heat transfer. Then the simplified figures emphasize the fact that Coons' tubes 13 and 22, are not directly in heat transfer with each other, and that likewise Bergholm's tubes 25 and 23 are not arranged in heat transfer with each other. The red strong liquor separates the blue weak liquor from the yellow vapor in both cases the same as in Figures 1 and 1-A.

The Figures at the right and left are connected by dotted lines representing a common level. Both Coons and Bergholm have located their drainage outlets from the hot vapor passage at a suitable level above the reservoir into which condensate is to be drained, these outlets being 28 in Coons and 27 in Bergholm. Necessarily the liquid level in the reservoir to which the drain leads must be below Coons' conduit 13 or Bergholm's conduit 25. The levels of conduits 22 of Coons and 23 of Bergholm do not enter into the problem, as they would convey their liquids at whatever level might be convenient to arrange them.

It is only necessary that Coons' conduit 23, 15, 26, and Bergholm's conduit 24 be of such shape and location to include heat transfer with the upper yellow tube of vapor and also with the lower blue tube of weak liquor. It is therefore convenient for comparison to consider Figures 3 and 3-A, in which Coons' tube 23, 15 and 26, is shown straight. In both of these Figures 3 and 3-A, we see that the strong liquor and weak liquor are in heat exchange with each other, then the vapor conduit comes into heat exchange with the strong liquor, and finally only the strong liquor and weak liquor lines are in contact with

each other. The common level indicated by the dotted line still retains the outlets 28 of Coons and 27 of Bergholm at a point above the level of liquid in the reservoir to which they drain the condensate from the vapor line.

No change has been made in the function of either Coons or Bergholm in this analysis of their disclosures. It is obvious that Figure 3 is arranged to operate exactly the same as Figure 1, and that Figure 3-A is arranged and operates exactly the same as Figure 1-A. Figures 3 and 3-A are identical.

14 Thus Figures 1 and 1-A are exact equivalents.

Q. In what sense does Bergholm have a "triple heat exchanger"?

A. Bergholm has a heat exchanger through which three fluids flow, and he calls it a "triple heat exchanger" because of this. It is obvious that Bergholm's heat exchanger involves only two pairs of passages, since his passage 23 is not in heat exchange with his passage 25.

Q. Will you please give the numbers of the two pairs, Mr. Muffly?

A. Bergholm has one pair comprising 23 and 24. His second pair comprises 24 and 25.

Q. Does the vapor in conduit 25 ever contact the weak liquid in conduit 23?

A. No. It neither contacts nor exchanges heat with the liquid in 23.

Q. Does Coons have a triple heat exchanger in the sense that Bergholm has?

A. Yes, Coons has exactly the same heat transfer effects, the passage 23, 15, 26 being in heat exchange with both the vapor passage 13 and the weak liquor passage 22.

15 And, as in Bergholm, Coons has no heat exchange between his vapor passage 13 and his weak liquor passage 22.

Q. Is it accurate to state, Mr. Muffly, that both Coons and Bergholm are characterized by the presence of passageways for three fluids, one of which never comes in contact or into heat-exchange relationship with one other passageway?

A. Yes, each has a passageway entirely out of heat exchange with one of the other passageways.

Q. Is it not a fact that in both the Coons and Bergholm constructions, as illustrated in Exhibit No. 3, the strong and weak fluids are in heat exchange relationship both before and after the heat exchange relationship between the strong liquid and the refrigerant vapor?

A. Yes, that is right.

Q. Is it not also true that the refrigerant vapor in both Coons and Bergholm never comes into heat exchange relationship with the weak liquid?

A. That is right.

Q. Would it be fair to say that functionally Coons and Bergholm heat exchangers are identical, and differ merely in immaterial structural details?

A. Yes, I would say that is correct.

Q. What are the three liquid levels in the Coons 16 and Bergholm construction, Mr. Muffly?

A. In the Coons patent we have a liquid level near the bottom of the absorber where the red begins, and we have a liquid level in this reservoir 24, then we have a liquid level in the generator where the liquid accumulates providing the head of the liquid to force the weak liquor back to the absorber.

Q. Will you please identify the level in the generator more definitely, please?

A. The level of liquid is the level made by the line between the blue and the yellow in the upper part of the generator. This provides the liquid head for forcing the liquid back to the absorber.

Q. What is the vessel in which the liquid level appears in the generator unit? What reference character is that vessel indicated by?

A. The reference character S identifies the separating portion of the generator. In the Bergholm patent, as exemplified by Plaintiff's Exhibit No. 2, we see the liquid level in the absorber at the junction of the green and the red, the red being liquid accumulating in the absorber. We see the liquid level in the generator. We find the yellow above the blue at the upper part of the vessel 10,

17 and in the vessel identified by the letters R V we see the liquid level at the junction of the yellow and the red, the yellow representing vapor and the red representing the strong liquor, this level being below the chamber from which condensate drains.

Q. You have just stated, Mr. Muffly, that the liquid level in the reservoir R V or 28 in Bergholm is below the heat exchanger. How does that compare with the relationship of the liquid level in the reservoir R V or 24 in the Coons construction?

A. In the same way the reservoir R V in Coons is below the portion of the heat exchanger from which the drain occurs, so that the drainage is to this liquid level in the Coons the same as it is in Bergholm.

Q. Do I understand you to say that in each construction the reservoir liquid level is below that part of the heat exchanger from which drainage takes place?

A. That is right.

Q. Does that drainage take place from more than one part of either heat exchanger?

A. No, from only one.

Q. In the refrigeration field to which the Coons and Bergholm construction relate, what does a generator or generating assembly comprise, please?

18 A. It comprises a boiler or chamber in which heat is applied to the strong liquor to evaporate from it vapor, and a separating chamber in which gravity separates the evaporated vapor from the remaining liquid. Means must also be provided for the transfer of fluids from the boiling portion of the generator to the separating, and in both Bergholm and Coons we see this in the form of a vertical tube in which alternate vapor and liquid blocks of fluid rise because of the low average gravity of such interspersed liquid and vapor.

Q. I now refer you to Plaintiff's Exhibit No. 4, which discloses diagrammatic showings of the Coons and the Bergholm generating assemblies, and ask you to explain and compare these two constructions.

A. We have in Bergholm a chamber 28 corresponding to chamber 24 of Coons. This is the chamber into which

strong liquor and condensate flow, the liquid level in this chamber being below the portion of the heat exchanger from which the condensate flows in each case. This strong liquor flows into the boiler 30 of Bergholm or B of Coons, where evaporation is caused by the application of heat to release the vapor by means of which the remaining liquid is lifted vertically to the upper part of vessel 10 in Bergholm or vessel S in Coons, the liquid dropping to the bottom of this chamber and vapor collecting in the top.

Comparing the two constructions, the boiler B of Coons is the equivalent of the heating coil 30 of Bergholm. The vertical tube 11 of Coons is identical with the vertical tube 11 at the right of the figure representing Bergholm. The separator S of Coons serves the same purpose as the chamber 10 of Bergholm. The level of liquid in the chamber S of Coons corresponds to the level of liquid in the vessel 10 of Bergholm. The outlet for liquid 34 of Bergholm corresponds to the outlet for liquid 22 of Coons. The dotted extension on the lower part of the vessel S in Coons indicates that a change of depth of this vessel would have no effect on the liquid held in the tube 22. Functionally these two are the same.

Q. Where is the liquid level in the Coons and in the Bergholm generating assemblies?

A. We have the liquid level shown in Coons in the vessel S where the broken lines indicate liquid and the clear white space vapor. Similarly indicated is the liquid and vapor in Bergholm vessel 10, and between the two figures is a broken line indicating this level. The vessels 24 of Coons and 28 of Bergholm likewise have liquid levels in them, but these vessels are not a part of the generating assembly in either case. They are shown in these figures to illustrate the source of the fluid which flows to the generator through the tube 29 of Bergholm or the tube 26 of Coons, these tubes not forming part of the generating assembly. The generator of Bergholm begins at the coiled tube 30, and the generator of Coons begins where the tube 26 enters the boiler B.

Q. Are the liquid levels in the separator S of Coons and the chamber indicated at 10 in Bergholm the only levels having any functional significance in the operation of the generating assemblies?

A. Yes.

Q. Refer again to Plaintiff's Exhibit No. 1 and to Claim 39 of the Coons application. Will you please point out for the benefit of the Court how this claim is readable upon the construction, in your opinion?

A. Claim 39 reads, "An absorption refrigerator system having a circuit for absorption liquid,"

This refers to the entire system and its circuit.

21 "including a generator-vapor lift assembly";

This assembly is the one indicated generally by the letter G and inclosed within the dotted line in Plaintiff's Exhibit No. 1, including the boiler B, the vapor lift 11 and separator S.

"an absorber", the absorber is shown encircled by a dotted line as indicated by the letter A.

"and heat exchange means"; The heat exchange means is inclosed by the broken line indicated by the letters H E, including the tubes or passages 23, 15, 26, 22 and 13.

"said exchange means being connected to conduct vapors—from the generator", This connection conducting vapor from the generator is through the tube 12.

"said exchange means being connected to conduct—liquid from the generator," The liquid is conducted from the generator through the tube 22, this liquid being the weak liquor.

"and (to conduct) liquid flowing to the generator", The heat exchange means is connected to receive liquid through the vertical portion of the tube 23 at the left of the drawing,

22 this liquid being that which is flowing to the generator. This liquid leaves the heat exchanger through that portion of tube 26 which joins the boiler B outside of the enclosure made by the broken line identified as H E.

"in heat transfer relation out of physical contact with each other," The heat transfer relation referred to is that between the liquid in tube 23 and the liquid in tube 22;

also that between the liquid in 15 and the vapor in 13; also that between the tube 26, and the tube 22. These heat transfers are effected without the fluids involved coming into physical contact with each other.

"said exchange means also being located at a level below the surface level of liquids in both said generator-vapor lift assembly and said absorber," We see the complete heat exchange means enclosed by the broken line H-E located below the level in the absorber where the red and green join, and below the level in the generator-vapor lift assembly where the solid blue and solid yellow join within the chamber S.

"and means for creating a third surface level of liquid in said circuit below the vapor portion of said heat
23 exchange means to permit drainage of condensate from the vapor portion of said heat exchange means into said liquid circuit." The means for creating a third surface level is the receiver R V, or 24, its location and its connections, thus forming a surface level of liquid indicated by red below the yellow vapor within the chamber 24. This liquid level is in the liquid circuit and is located below the vapor portion of the heat exchanger identified by 13, into which vapor flows from the generator through the tube 12, and leaves through the tube 16 on its way to the condenser.

Q. Mr. Muffy, will you please apply Claim 15 of Coons which, incidentally, is Claim 7 of Bergholm, to the Coons construction as illustrated in Plaintiff's Exhibit No. 1?

A. This claim states "An absorption refrigeration system having a circuit for absorption liquid," Coons shows an absorption system and a circuit for absorption liquid.

"including a generator," The Coons generator includes those parts indicated by the letter G and surrounded by the broken line. This includes the boiler B, the vapor lift 11, and the separator S.

"an absorber," The absorber is that part inclosed
24 by the dotted circle and indicated by the letter A.

"and a triple heat exchanger," The triple heat exchanger is inclosed by the broken line indicated by the letters H E. This heat exchanger is "triple" because of handling three fluids.

"said exchanger being connected to conduct vapors and liquid from the generator," This heat exchanger receives vapors from the generator through the tube 12 which leads into the chamber 13. The heat exchanger also receives liquid from the generator through that portion of the tube 22 passing downwardly from the generating assembly at S and entering the broken line inclosure identified by the letters H E, within which inclosure this tube is part of the heat exchanger.

"and liquid flowing to the generator," The liquid flowing to the generator passes downward in the extreme left portion of the tube 23 and enters the heat exchanger where the tube 23 first come into contact with the tube 22. This liquid flows through the heat exchanger and leaves it through the tube 26 at the point where this tube leaves contact with the tube 22 just prior to its connection 25 with the boiler B.

"in the heat transfer relation out of physical contact with each other," In each of the heat transfer portions of the heat exchange we find the fluids contained within conduits, the conduits being in physical contact with each other, but the fluids themselves not being in such contact.

"said exchanger also being located at a level below the surface levels of liquid in both said generator and said absorber," The heat exchanger assembly above defined is located entirely below the liquid level where green is seen joining red liquid in the absorber A, and below the level where yellow vapor joins blue liquid in the generator assembly.

"and means for creating a third surface level of liquid in said circuit below said heat exchanger to permit drainage of condensate from the vapor portion of said heat exchanger into said liquid circuit." The means for creating this third surface level of liquid is the chamber 24, its connection and location. This receiver is located below the portion of the heat exchanger from which drainage occurs to permit such drainage of condensate from the vapor 26 portion of the heat exchanger. From the level of red liquid within the receiver 24, identified generally as R V, the liquid circuit continues through a further portion

of the heat exchanger and thence to the generator. The path of condensate from the vapor portion 13 of the heat exchanger to the receiver is by way of the tube 28 which joins the tube 12.

Q. Can you state, Mr. Muffly, how the Coons generating assembly would be constructed and insulated if made in accordance with general practice?

A. The generating assembly, comprising the boiler B, the lift tube 11 and the separator S would be inclosed within one body of insulation as indicated by the broken line marked G.

Q. Can you state, Mr. Muffly, how the Coons heat exchanger assembly would be constructed and insulated if made in accordance with general practice?

A. The heat exchanger assembly, including all parts within the broken line, identified by the letters H E, would be inclosed within one continuous body of insulating material, and the broken line H E may be considered as the outline of such a body of insulation.

Q. In your opinion, Mr. Muffly, is the heat exchange assembly, or heat exchanger, of Coons, a single unitary construction?

A. Yes, I would call it a unitary construction.

By Mr. Sellers: The taking of testimony is concluded.

Subscribed and sworn to before me this day of April, A. D. 1943.

.....
Notary Public.

28

IN THE DISTRICT COURT OF THE
UNITED STATES,
FOR THE DISTRICT OF COLUMBIA.

THE HOOVER COMPANY,
Plaintiff.

vs.

CONWAY P. COE, Commissioner
of Patents,
Defendant.

CIVIL ACTION

15,028

State of Illinois,
County of Cook.

} SS: ...

I, William C. Meyer, a Notary Public, in and for the County of Cook and State of Illinois, do hereby certify that heretofore, to-wit, on the 30th day of March, A. D. 1943, personally appeared before me GLENN MUFFLY, at suite 2300, No. 8 South Michigan Avenue, Chicago, Illinois, a witness produced on behalf of the plaintiff in a certain action now pending and undetermined in the District Court of the United States for the District of Columbia, wherein the Hoover Company is plaintiff and Conway P. Coe, Commissioner of Patents, is defendant, Civil Action No. 15,028.

I further certify that the said witness was by me first duly sworn to testify the truth, the whole truth and
29 nothing but the truth in relation to the matters in controversy herein insofar as he should be interrogated concerning the same; that the testimony then given by him was by me reduced to writing, in the presence of the said witness, by means of shorthand, and thereafter transcribed upon a typewriter under my direction.

I further certify that after said testimony had been so transcribed, it was read over by the said witness, who then and there did subscribe and again make oath to the same.

I further certify that the taking of the deposition of GLENN MUFFLY, was in pursuance of the notice hereto attached and herewith returned.

I further certify that there were present at the taking of this deposition MR. W. D. SELLERS and Mr. R. R.

FITZSIMMONS, on behalf of plaintiff, and that defendant was not present in person nor represented by counsel.

I further certify that I am not a relative, employe, attorney nor counsel of any of the parties, nor a relative or employe of such attorney or counsel, and that I am not directly nor indirectly interested in the matter in controversy.

IN TESTIMONY WHEREOF I have hereunto set
 30 my hand and affixed my Notarial Seal this,
 day of April, A. D. 1943.

.....
 Notary Public.

My commission expires

June 7, 1943.

Notary's Fee \$.....

PLAINTIFF'S EXHIBIT NO. 6.

CHART

<i>Claims</i>	<i>Limitation</i>	<i>Bergholm</i>	<i>Coons</i>
15, 16, 38, 39	An absorption refrigerating system having a circuit for absorption liquid including—	(No question)	(No question)
15, 38	—a generator,—	10, 12, 30	B, 11, S
16, 39	—a generator vapor lift assembly,—	ditto	ditto
15, 16, 38, 39	—an absorber	13	A
15	—and a triple heat exchanger,—	(22) 23, 24, 25	2, 26-22, 23-13, 15
16	—and a heat exchanger,—	ditto	ditto
38	—and a three-part heat exchanger,—	ditto	ditto
39	—and heat exchange means,—	ditto	ditto
15, 16, 38	—said exchanger—	ditto	ditto
39	—said exchange means—	(22) 23, 24, 25	22, 26-22, 23-13, 15
15, 16, 38, 39	—being connected to conduct vapors— from the generator,—	by conduit 31, vessel 28 and conduit 27	by conduit 12
15, 16, 38, 39	—(being connect to conduct) —and liquid from the generator—	by conduit 34	by conduit 22
15, 16, 38, 39	(being connected to conduct)—and liquid flowing to the generator—	by conduits 33, 31 & 29 and vessel 28	by conduits 23, 15, 25, vessel 24 and 26
15, 16, 38, 39	—in heat transfer relation out of physical contact with each other,—	in (22) 23, 24, 25	in 22, 26-22, 23-13, 15
15, 16, 38	—said exchanger—	(22) 23, 24, 25	22, 26-22, 23-13, 15

<i>Claims</i>	<i>Limitation</i>	<i>Bergholm</i>	<i>Coons</i>
39	—said exchange means—	(22) 23, 24, 25	22, 26-22, 23-13, 15
5, 38	—also being located at a level below the surface level of liquid in both said generator—	(22) 23, 24, 25 below liquid level in 10	22, 26-22, 23-13, 15 below liquid level in S
16, 39	—also being located at a level below the surface levels of liquid in both said generator-vapor lift assembly—	ditto	ditto
5, 16, 38, 39	—(also being located at a level below the surface levels of liquid in both) and said absorber,—	(22) 23, 24, 25 below liquid level in 14	22, 26-22, 23-13, 15 below liquid level in A
5, 16, 38, 39	—and means for creating a third surface level of liquid in said circuit—	vessel 28	vessel 24
5, 38	—below said exchanger	28 is below (22) 23, 24 25	24 is below 13, 15 for purpose specified
16	—below a portion of said heat exchanger—	28 is below (22) 23, 24, 25	24 is below 13, 15
39	—below a vapor portion of said heat exchange means—	28 is below 25	24 is below 13
5, 16, 38	—to permit drainage of condensate from the vapor portion of said heat exchanger into said liquid circuit.	25 drains to 29 by conduit 27 and vessel 28	13 drains to 26 by conduits 12, 28 and vessel 24
39	—to permit drainage of condensate from the vapor portion of said heat exchange means into said liquid circuit.	ditto	ditto

IN THE DISTRICT COURT OF THE UNITED STATES
FOR THE DISTRICT OF COLUMBIA.

The Hoover Company,
Plaintiff,

vs.

Conway P. Coe,
Commissioner of Patents,
Defendant.

Civil Action No. 15,028.

DESIGNATION OF RECORD.

Appellant hereby designates the following as the portions of the record, proceedings and evidence to be contained in the record on appeal in this case:—

1. Complaint.
2. Answer.
3. Stipulated Condensation of the file wrapper and contents of Coons application for patent Serial No. 373,970 identified as Plaintiff's Exhibit 8. Note that this item includes duplicates of all of Defendant's Exhibits 1-B, 1-C, 1-D, 1-E and 1-F.
4. Stipulation as to the use of printed copies etc. identified as Plaintiff's Exhibit 7.
5. Deposition of Glenn Muffly, identified as Plaintiff's Exhibit 10.
6. Reporter's Transcript of the Proceedings before the District Court.
7. Findings of Fact and Conclusions of Law.
8. Plaintiff's Proposed Findings of Fact and Conclusions of Law, filed in the District Court on June 15, 1943.
9. Judgment.
10. Notice of Appeal.
11. Designation of Record.

12. Plaintiff's Exhibit No. 1—colored diagrammatic showing of circulating system. (Physical.)
13. Plaintiff's Exhibit No. 2—enlarged diagrammatic colored showing of Figure 1 of Bergholm Patent No. 2,201,362. (Physical.)
14. Plaintiff's Exhibit No. 3—enlarged diagrammatic colored showing of the heat exchanger construction. (Physical.)
15. Plaintiff's Exhibit No. 4—enlarged diagrammatic showing of the generating assembly. (Physical.)
16. Stipulation dated July 19, 1943 substituting photographs Plaintiff's Exhibits 5A and 5B for Plaintiff's Physical Exhibit No. 5.
17. Plaintiff's Exhibit No. 6—chart showing the application of the claims of which the witness Coons applied claims 15 and 39.
18. Plaintiff's Exhibit No. 9—copy of the Hahnel Patent No. 1,877,857.
19. Enlargement of Figure 10 of the Oswald Patent No. 1,482,028. (Physical.) Plaintiff's Ex. No. 11.
20. Plaintiff's Exhibit No. 12—copy of the Martensen Patent No. 1,854,619.
21. Defendant's Exhibit 1-A—copy of Bergholm Patent No. 2,201,362.
22. This Designation of Record.

W. D. SELLERS,

RICHARD FITZSIMMONS,

Attorneys for Plaintiff.

Washington, D. C.

July 19, 1943.

Service of the foregoing Designation of Record, and receipt of a copy thereof acknowledged this 19th day of July 1943.

W. W. COCHRAN,

Attorney for Defendant.

IN THE DISTRICT COURT OF THE UNITED STATES
FOR THE DISTRICT OF COLUMBIA.

The Hoover Company,
Plaintiff,

vs.

Conway P. Coe,
Commissioner of Patents,
Defendant.

Civil Action No. 15,028.

SUPPLEMENTAL DESIGNATION OF RECORD.

Appellant hereby designates the following additional portions of the record, proceedings and evidence to be contained in the record on appeal in this case:—

22. Stipulation re transmission of original Exhibits to the Court of Appeals.
23. Order authorizing transmission of original Exhibits to the Court of Appeals.
24. Stipulation re extending time in which to file certified transcript of the record.
25. Order extending time for filing certified transcript of record.
26. This Supplemental Designation of Record.

Omit item No. 8 of the original Designation of Record, re "Plaintiff's Proposed Findings of Fact."

Washington, D. C.

August 13, 1943.

WM. S. HODGES,

900 F Street N. W.

Of Counsel for Plaintiff.

Certificate of Service.

I hereby certify that a copy of the above Supplemental Designation of Record has this day been mailed to W. W. Cochran, United States Patent Office, Department of Commerce Building, Washington, D. C., attorney for defendant.

Dated August 13, 1943.

WM. S. HODGES,

Of counsel for plaintiff..

PLAINTIFF'S EXHIBIT NO. 7.**IN THE DISTRICT COURT OF THE UNITED STATES
FOR THE DISTRICT OF COLUMBIA.**

The Hoover Company,
Plaintiff,

vs.

Conway P. Coe,
Commissioner of Patents,
Defendant.

In Civil Action
No. 15028.

STIPULATION.

It is hereby stipulated and agreed by and between counsel for the respective parties as follows:

1. That copies hereto attached are correct condensations of the file wrapper and contents and drawings of the following application for United States Letters Patent:

Curtis C. Coons, Serial No. 373,970 filed Jan. 10, 1941, application for original patent No. 2,178,870 filed Aug. 8, 1936; and

2. That the above condensations of the file wrapper and contents and drawings of the said application may be received in evidence in lieu of the complete file wrapper and contents or certified copies thereof, subject to correction should any error be found.

(Signed) RICHARD R. FITZSIMMONS,

W. D. SELLERS,

Attorneys for Plaintiff.

Chicago, Illinois,
Mar. 18, 1943.

.....
Attorney for Defendant.

Washington, D. C.

....., 1943.

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TO ALL WHOM IT MAY CONCERN:

Be it known that I, Curtis C. Coons, a citizen of the United States, residing at North Canton, in the County of Stark, and State of Ohio, have invented certain new and useful Improvements in

CONTINUOUS ABSORPTION REFRIGERATING SYSTEM

of which the following is a full, clear and concise description:

This invention relates to continuous absorption refrigerating systems and more particularly to rectifiers and heat exchangers adapted to be used therein.

In the operation of a known type of continuous absorption refrigerating system using inert gas, approximately one-fourth of the heat input to the boiler is discharged at the rectifier. The heat that is discharged from the rectifier to the cooling medium such as the air, in an air cooled absorption system is relatively high grade heat energy. If this heat is discharged to the cooling medium or to other than a part of the refrigerating system, the heat ratio of the refrigerator is not high.

By means of the present invention, it is proposed to provide a continuous absorption refrigerating system in which this heat of rectification is discharged into the strong aqua or strong solution flowing from the absorber to the boiler, thereby improving the heat ratio.

It is preferable in accordance with the present invention to discharge the heat of rectification to the strong aqua instead of to the weak aqua due to the fact that the quantity of strong aqua flowing is larger than the quantity of weak aqua by the amount of refrigerant absorbed in the absorber. Because of this it is not as practical to transfer the heat of rectification to the weak aqua.

Accordingly it is one object of the present invention to effect a savings of heat and to bring about an improvement in the heat ratio of a continuous absorption refrigerating system by transferring heat from the rectifier to the strong aqua flowing to the boiler.

It is still another object of the invention to provide an improved heat exchanger for transferring heat in the fluid leaving the boiler of a continuous absorption refrigerating system to fluid entering the boiler of that system.

It is still another object of the invention to provide an improved rectifier adapted for use in a continuous absorption refrigerating system.

In the following description, means is described for discharging heat of rectification to the strong aqua in the system. In all of the arrangements shown and described a single stage continuous absorption system using inert gas is illustrated but it is obvious that the rectifier and associated parts may be used in absorption systems which do not employ inert gas and also in systems in which two or more stages are employed. It will also be clear to those skilled in the art that the rectifier of one of the following figures may be used in other figures described herein.

Various other objects and advantages reside in certain novel features of the arrangement and construction of parts as will be apparent from the following description taken in connection with the accompanying drawings in which,

Figure 1 is a diagram of a continuous absorption refrigerating system using inert gas and in which a rectifier constructed in accordance with the present invention is illustrated in cross section, this arrangement showing one embodiment of the invention.

Figure 2 is a diagram of a modified form of continuous absorption refrigerating systems and illustrating a further embodiment of the invention.

Figure 3 is a fragmentary, vertical cross sectional view of the rectifier of Figure 2 shown somewhat enlarged.

Figure 4 is a horizontal, cross sectional view of the rectifier shown in Figure 3, the view being taken on the line 4-4 thereof.

Figure 5 is a diagram of a continuous absorption refrigerating system illustrating still another embodiment of the present invention and showing the rectifier and a portion of the analyzer of the system in vertical cross section.

Figure 6 is an enlarged fragmentary view in cross section of the rectifier assembly shown in Figure 5.

Figure 7 is a horizontal cross sectional view of the rectifier assembly of Figure 6 taken on the line 7-7 thereof.

Figure 8 is a diagram of a continuous absorption refrigerating system illustrating still another embodiment of the invention and showing a horizontal rectifier in vertical cross section.

Figure 9 is an enlarged fragmentary vertical cross sectional view of the rectifier assembly shown in Figure 8.

Figure 10 is a transverse cross sectional view of the rec-

tifier assembly shown in Figure 8, the view being taken on line 10-10 thereof, and-

Figure 11 is a transverse cross sectional view of the rectifier of Figure 8, the view being taken on the line 11-11 thereof.

Referring to the drawings in detail, and first to the arrangement diagrammatically illustrated in Figure 1, it will be seen that a continuous absorption refrigerating system is there illustrated as consisting of a boiler B, a gas separation chamber S, the rectifier designated generally at R, a condenser C, an evaporator E and an absorber A, these vessels being connected by a number of conduits to form the complete refrigerating system.

In the arrangement of Figure 1, a gas lift pump 11 is employed for lifting absorption liquid from the boiler B into the gas separation chamber S. The refrigerant gas developed in the boiler system leaves the gas separation chamber S through the conduit 12 and enters the bottom of the rectifier proper. The rectifier consists of a vertically disposed cylinder 13 provided with a number of baffle plates 14 therein. The cylinder 13 is surrounded by an outer jacket 15 through which liquid may be circulated to remove heat from the interior of the cylinder 13 and from the baffle plates 14 therein to effect the rectification as will presently be described more in detail.

The refrigerant gas leaves the top of the rectifier 13 through the conduit 16 which conveys it to the condenser C. After the refrigerant condenses in the condenser, it flows into the evaporator through the conduit 17.

The evaporator E is connected to the absorber A by means of two inert gas conduits 18 and 19 which may be in heat exchange relation. The conduit 19 may connect the bottom of the evaporator to the top of the absorber and the conduit 18 may connect the top of the evaporator to the bottom of the absorber.

The conduit 18 may have an inert gas circulator mounted therein as shown at 20 and this circulator may be an ordinary centrifugal fan driven by a hermetically sealed electric motor 21.

A liquid conduit 22 connects the bottom of the gas separation chamber S to the top of the absorber. The bottom of the absorber is connected to the lower end of the jacket 15 on the rectifier by means of the liquid conduit 23. The top of the jacket 15 is connected to a reservoir 24 by means of a liquid conduit 25 and the bottom of the reservoir 24 is connected to the boiler B by means of the liquid conduit 26.

It will be apparent that with this arrangement of liquid conduits, liquid may flow by gravity from the gas separation chamber S through the conduit 22 into the top of the absorber and after trickling downwardly over baffle plates of the like within the absorber, flow by gravity through the conduit 23 upwardly through the jacket 15 and then downwardly through the liquid conduit 25 and the reservoir 24 back to the boiler through the conduit 26.

To prevent the accumulation of gas in the upper part of the jacket 15 a reversely bent pipe 27 may connect the top of the jacket to the refrigerant conduit 16.

The rectifier 13 must be provided with means for draining the liquid which collects therein. This is provided by the liquid drain conduit 28 connecting the lower portion of the conduit 12 to the reservoir 24.

It will be apparent from the above description that in the arrangement illustrated in Figure 1, the rectifier is located below the bottom of the absorber but above the normal level of the solution in the boiler B and in the reservoir 24. It will also be apparent that the strong aqua leaving the absorber through the conduit 23 is brought into heat exchange relation with the fluids in the rectifier 13 by means of the jacket 15. It will also be clear

that the pipes 23 and 22 may be in heat exchange relation and also that the pipe 26 which is connected to the bottom of the reservoir 24 may be in heat exchange relation with a portion of the pipe 22. The relative amounts of heat exchange area between the pipes 22 and 23 as compared with the amount of heat exchange area between the pipes 22 and 26 may be varied as desired to bring about the proper operation of the system.

The rectifier itself is essentially a heat exchanger and is part of the means for transferring heat from the fluids leaving the boiler to the strong aqua flowing to the boiler and it thus aids in the economy of heat.

While the arrangement illustrated in Figure 1 shows baffle plates within the rectifier cylinder 13, it is obvious that other filling material may be used.

The general features of the refrigerating system shown in Figure 1 are known to those skilled in the art and the operation of the system as a whole need not be described herein detail.

A modified form of the invention is shown in Figure 2 of the drawings. The general arrangement of the assembly may be the same as in Figure 1 and the parts which correspond are similarly designated. The rectifier assembly is combined with the reservoir into a single cylindrical arrangement, the rectifier 13 occupying the upper portion thereof and consisting of a cylindrical vessel placed within the outer casing 15. This is but a variation in details of construction from the arrangement shown in Figure 1. The reservoir 24 is vented through a conduit 29 which passes from the top of the reservoir to the conduit 16. Another vent conduit 30 connects the top of the jacket formed by the upper portion of the cylinder 15 to the upper end of the conduit 29.

An important feature of the arrangement of Figure 2 and one which differs from the arrangement of Figure 1,

results from the fact that the absorption liquid leaving the absorber A through the conduit 31 is divided into two streams by means of a solution divider 32. The solution divider may consist merely of a knife blade disposed below the lower end of the pipe 31. One stream of solution flows from the dividing chamber 32 through the horizontal pipe 33 into the top of the cylinder 15 around the rectifier.

This stream is the only one which flows in heat exchange with the rectifier, the other stream passing downwardly through the conduit 34 and back to the boiler B. The stream of liquid which passes through the jacket formed by the cylinder 15 flows through the conduit 35 into the conduit 29 and from there into the reservoir 24 and drains back to the boiler through the conduit 36 connected to the conduit 34. The conduit 34 may be in heat exchange relation with the conduit 22 and the point of connection of the conduit 36 to the conduit 34 may be varied as desired to obtain the best operation of the system.

It will be apparent that the rectifier assembly of Figure 2 causes a transfer of heat to the strong aqua from the refrigerant gas flowing from the gas separation chamber through the conduit 12 to the conduit 16 in a way similar to that described above in connection with Figure 1. One difference is to be noted, however, and that is that in the arrangement of Figure 2 the absorption liquid flows downwardly through the jacket 15 whereas in Figure 1 it flows upwardly therethrough. The strong aqua thus flows in counterflow to the movement of vapors through the inner cylinder 13 of the rectifier.

In the arrangement of Figures 1 and 2 a gas lift pump is employed for circulating the absorption liquid. The present invention may be advantageously carried out where some motor or power driven liquid circulating means is employed and Figure 5 illustrates one way for accomplishing this. In this figure, the boiler B is shown pro-

vided with an analyzer chamber 37 which has a number of baffle plates therein as shown at 38. The top of the analyzer chamber is connected to the bottom of the rectifier cylinder 13 by means of a conduit 39. The gases pass upwardly through the rectifier cylinder 13 and flow through the conduit 16 into the condenser C as in the arrangement of Figure 1. The evaporator and absorber may be the same as described above in connection with Figure 1 and the parts which correspond are similarly designated. Absorption liquid is circulating between the boiler, the rectifier and the absorber by means of a liquid pump diagrammatically illustrated at 40 which is adapted to be driven by an electric motor 41. Liquid is supplied to the pump 40 through the conduit 42 from a reservoir 43. The liquid is then lifted through the discharge conduit 44 of the pump into the top of the absorber and it then flows by gravity down through the absorber, then through the conduit 45 into the top of the jacket 15 surrounding the rectifier cylinder 13. The bottom of the jacket 15 is connected to some convenient point in the analyzer 37 by means of the conduit 46. After trickling downwardly over the baffle plates 38 in the analyzer, the liquid flows through the boiler B and back to the reservoir 43 through the conduit 47. Both the conduits 45 and 46 may be in heat exchange relation with the conduit 47 as in the somewhat similar arrangement in Figure 1. The heat transfer area between these conduits may be varied as desired.

The jacket 15 may be vented into the conduit 16 by means of a pipe 27 and the rectifier chamber 13 may be drained into the conduit 46 by means of the small U pipe 48 connected to the lower end of the conduit 39.

The top of the reservoir 43 should be vented by means of a conduit 49 connected to the lower end of the inert gas conduit 18.

The operation of this system is similar to that described above in connection with Fig. 1, the only difference being in the means for circulating the absorption liquid.

In both of the arrangements of Figures 1 and 2, the jacket 15 surrounding the rectifier cylinder 13 is merely a plain cylinder and is maintained full of strong aqua. In the arrangement of Figure 5, on the other hand, the jacket 15 is provided with a number of baffle plates arranged in staggered relation, as best shown in Figure 6 and which are marked 50. The baffle plates 50 aid in causing the transfer of heat from the vapors in the rectifier cylinder 13 to the aqua solution in the jacket 15.

In the design of an absorption apparatus to include the special rectifier for permitting heat exchange between the hot vapors from the boiler and the strong aqua, the dimensions of the apparatus may be important if it is necessary to install the apparatus in a cabinet. In order to decrease the height to which the absorber must be elevated above the boiler to permit the use of the special heat exchange rectifier described above the use of a horizontal or slightly inclined rectifier may be employed and an arrangement of this sort is illustrated on the drawings in Figures 8 to 11, inclusive.

In the arrangement of Figure 8 a gas lift pump is employed for raising the absorption liquid as in the arrangement of Figure 1 and various other parts are the same as that in Figure 1 and are similarly designated.

A solution divider 32 is shown located below the absorber, as in the arrangement of Figure 2 and this element is similarly designated. Solution drains from the absorber through the conduit 31 into the solution divider 32 and some flows through the conduit 34 back to the boiler while others flow through the conduit 33 into the jacket 15 around the rectifier. The solution leaves the jacket 15 through the conduit 25 and flows into the reservoir 24 and from there

to the conduit 36 back to the boiler, the conduit 36 joining the conduit 34.

The rectifier shown in Figures 8, 9, 10 and 11 consists of a horizontal or slightly inclined cylinder 51 provided with a number of horizontally extending baffle plates 52. The baffle plates are preferably inclined in the same angle as the cylinder 51. The trays may be supported on and held in spaced relations by means of a number of substantially vertically extending baffle plates 53 arranged in staggered relation. The baffle plates which extend down to the bottom of the cylinder 51 may be provided with small openings 54 to allow the passage of liquid therethrough. With this construction gas enters the cylinder 51 through the conduit 12 and passes upwardly and then downwardly over the trays 52, as directed by the baffle plates 53 until it leaves the cylinder 51 through the conduit 16 at the left hand end thereof, as viewed in Figure 8.

The trays 52 which pass horizontally, or substantially horizontally, through the baffle plates 53 may have slots therein for permitting the liquid to flow along each tray but in the arrangement shown a substantially tight fit is illustrated so that the liquid which collects upon the trays as the result of the rectification (which may be called the reflux solution) drips from the upper trays on to the lower one in between each of the baffle plates 53 until it collects at the bottom of the vessel 51 and is drained through the holes 54 in the alternate baffle plates 53 and leaves the rectifier through the conduit 28 connected to the lower end of the vapor supply conduit 12.

It will be seen that with this construction a large area of contact for rectification is provided and at the same time a system for transferring heat to strong aqua is provided while utilizing a slight amount of vertical space.

From the above description, it will be clear that several different types of rectifiers adapted to be cooled by strong

aqua in accordance with the present invention have been illustrated and described. In all of these arrangements the rectifier is shown situated above the normal solution level in the boiler so that the rectifier can be drained by gravity flow into the boiler. It is of course within the purview of the invention to locate the rectifier partly, or entirely, below the normal solution level in the boiler and use a pump to pump the strong aqua from the level of the rectifier into the boiler.

It will also be apparent to those skilled in the art that while only a few embodiments of the invention have been illustrated and described herein, various changes may be made in the arrangement and construction of parts without departing from the spirit of the invention or the scope of the annexed claims.

I CLAIM:

1. In an absorption refrigerating system having a boiler, an absorber, means for circulating absorption liquid between the boiler and the absorber and a liquid heat exchanger, the combination of a rectifier and means for transferring heat from the rectifier to absorption liquid flowing from the absorber to the boiler, the arrangement being such that the absorption liquid flowing from the absorber to the boiler passes first in heat exchange relation with solution flowing from the boiler to the absorber, then in heat transfer relation with the rectifier and then again in heat exchange relation with absorption solution flowing from the boiler to the absorber.

2. In an absorption refrigerating system having a boiler, an absorber and means for circulating absorption liquid therebetween, the combination of a rectifier and means for transferring heat from the rectifier to absorption liquid flowing from the absorber to the boiler, the arrangement including a liquid divider for dividing the absorption liquid leaving the absorber into two streams,

one of which flows to the boiler and the other of which flows in heat transfer relation with the rectifier and then to the boiler.

3. In a continuous absorption refrigerating system having a boiler, an absorber and means for circulating absorption liquid therebetween, the combination of a rectifier and means for transferring heat from the rectifier to absorption liquid flowing from the absorber to the boiler, both said rectifier and said heat transfer means including baffling means positioned to cause the fluids within the rectifier and the absorption liquid to flow through tortuous passageways, the arrangement being such that the liquid leaving the absorber flows by gravity in heat transfer relation with the rectifier and then by gravity to the boiler.

4. A rectifier assembly adapted for use in an absorption refrigerating system, said assembly consisting of a cylindrical vessel disposed substantially in a horizontal position, a jacket surrounding said vessel, means for supplying vapors to the inner vessel and means for supplying liquid from a part of said refrigerating system to said jacket to take up heat from the vapors in said vessel, said vessel having a plurality of substantially horizontal trays therein and a plurality of substantially vertical baffle plates in spaced, staggered relation along said trays.

5. That improvement in an absorption refrigeration apparatus of the type having a boiler assembly, a condenser, an evaporator, and an absorber in circuit, and containing a refrigerant and an absorbent therefor, which comprises returning strong absorbent solution from the absorber to the boiler out of contact but in heat exchange relation with a mixture of hot refrigerant and absorbent vapor intermediate the boiler and condenser, whereby absorbent vapor is condensed and its heat of condensation is given up to said strong absorbent solution, and conducting refrigerant vapor liberated from said strong absorbent

solution as a result of said heat transfer to the condenser.

6. An absorption refrigeration system comprising a boiler, a condenser, an evaporator and an absorber connected in circuit, rectifying means in the circuit between the boiler and the condenser, means for returning at least part of the strong absorbent solution from the absorber to the boiler in heat exchange relation with said rectifying means, and means for venting said strong solution return means to a point intermediate the evaporator and the rectifying device.

7. That method of separating absorbent vapor from refrigerant vapor produced in an absorption refrigeration apparatus which comprises passing said vapor mixture into heat exchange relation but out of contact with a strong solution of absorbent medium and refrigerant whereby the absorbent vapor is condensed and the heat of condensation is given up to the strong absorbent solution, and conducting any refrigerant vapor liberated from said strong absorbent solution into the refrigerant vapor from which the absorbent vapor has been removed.

8. An absorption refrigeration apparatus of the type comprising a boiler assembly, a rectifier assembly, a condenser, an evaporator, and an absorber in circuit, and containing a refrigerant, an absorbent therefor, said rectifier assembly comprising an elongated vessel positioned at an angle to the horizontal and having one end thereof connected to the condenser and the other end connected to said boiler assembly, means forming a passageway in heat exchange relation with said vessel, said passageway being connected between said absorber and said boiler assembly in such manner that at least a part of the strong absorbent solution flowing from the absorber to the boiler passes therethrough, and a refrigerant vapor passageway from an upper part of said passageway aforesaid and said connection between the condenser and said rectifier assembly.

9. That improvement in the art of rectification in absorption refrigeration apparatus of the type having a boiler assembly and an absorber connected in circuit, and containing a refrigerant in solution in an absorbent medium, comprising passing refrigerant and absorbent vapor liberated by the application of heat to the boiler assembly through a rectifier having a tortuous passageway formed by baffling means therewithin, condensing said absorbent vapor by passing a stream of liquid at a lower temperature than said vapor in heat exchange relation but out of contact with said vapor in said rectifier, and subsequently returning the liquid heated by the heat of condensation of said absorbent vapor to the boiler assembly, and simultaneously conducting lean absorbent medium from said boiler to said absorber independently of said rectifier.

10. That method of producing refrigeration by means of an absorption refrigeration apparatus of the type having a boiler, a rectifier, a condenser, an evaporator, and an absorber connected in circuit and containing a refrigerant, an absorbent therefor and a pressure equalizing medium, which method consists in liberating refrigerant vapor from the absorbent by the application of heat, condensing said vapor, evaporating the condensate so formed into the pressure equalizing medium to produce refrigeration, conducting weak absorbent and the mixture of refrigerant vapor and pressure equalizing medium into intimate contact whereby the weak absorbent is enriched by refrigerant, returning the pressure equalizing medium into the presence of more condensate, which method is characterized by the fact that at least a part of the enriched absorbent is returned to the heating zone after first passing in heat exchange relation but out of contact with freshly liberated hot refrigerant whereby absorbent vapor contained therein is condensed and the heat of condensa-

tion serves to preheat said enriched absorbent, and conducting refrigerant vapor liberated therefrom by reason of said preheating to the main stream of refrigerant vapor.

11. That method of producing refrigeration by means of an absorption refrigeration system having a boiler, rectifier, condenser, evaporator and absorber connected in circuit and containing a refrigerant, an absorbent medium therefor, and an inert gas, which method includes generating refrigerant vapor from rich solution in a generating zone, passing lean solution directly to an absorption zone independently of an absorption vapor rectifying zone, and returning enriched absorption solution to said generating zone after passing the same in heat exchange relation but out of contact with the vapors emanating from said generating zone to condense absorption medium vapor from said vapors and to preheat said enriched solution.

12. In an absorption refrigerating system, a generator, a rectifier, an absorber, and a vapor liquid lift for causing circulation of absorption liquid between said generator and absorber; said rectifier being arranged for cooling thereof by absorption liquid flowing toward said generator, and said lift being connected to said absorber and said rectifier and said generator to receive liquid from both said absorber and rectifier and vapor from said generator.

13. In an absorption refrigerating system, a generator, a rectifier, a absorber, and a vapor liquid lift for causing circulation of absorption liquid between said generator and said absorber, said rectifier being arranged for cooling thereof by absorption liquid flowing toward said generator, and means for connecting said lift absorber, rectifier and generator so that said lift receives liquid from both said absorber and rectifier and vapor from said generator.

14. In an absorption refrigerating system, a generator, a rectifier, an absorber, a liquid heat exchanger connected between said generator and absorber, said rectifier being

in heat transfer relation with said exchanger, and a vapor liquid lift for causing circulation of absorption liquid between said generator and absorber through said exchanger, said lift being connected to receive liquid from both absorber and rectifier and vapor from said generator.

15. An absorption refrigerating system having a circuit for absorption liquid including a generator, an absorber, and a triple heat exchanger, said exchanger being connected to conduct vapors and liquid from the generator and liquid flowing to the generator in heat transfer relation out of physical contact with each other, said exchanger also being located at a level below the surface levels of liquid in both said generator and said absorber, and means for creating a third surface level of liquid in said circuit below said exchanger to permit drainage of condensate from the vapor portion of said heat exchanger into said liquid circuit.

16. An absorption refrigerating system having a circuit for absorption liquid including a generator-vapor lift assembly, an absorber, and a heat exchanger, said exchanger being connected to conduct vapors and liquid from the generator and liquid flowing to the generator in heat transfer relation out of physical contact with each other, said exchanger also being located at a level below the surface level of liquids in both said generator-vapor lift assembly and said absorber, and means for creating a third surface level of liquid in said circuit below a portion of said heat exchanger to permit drainage of condensate from the vapor portion of said heat exchanger into said liquid circuit.

17. An absorption refrigerating system as set forth in claim 15 in which vapors conducted from the generator to the heat exchanger pass in physical contact with absorption liquid flowing from said heat exchanger to said generator.

18. An absorption refrigerating system having a circuit for absorption liquid including a generator-vapor lift assembly, an absorber, and a heat exchanger, said exchanger being connected to conduct vapors and liquid from the generator and liquid flowing to the generator in heat transfer relation out of physical contact with each other, said exchanger also being located at a level below the surface level of liquid in both said generator-vapor lift assembly and said absorber, and means for creating a third surface level of liquid in said circuit below a portion of said heat exchanger to permit drainage of condensate from the vapor portion of said heat exchanger into said liquid circuit, said connection for flowing vapors from said generator to said heat exchanger being so related to said connection for flowing liquid to said generator that vapors flowing from said generator to said heat exchanger pass in physical contact with absorption liquid flowing from said heat exchanger to said generator.

19. In an absorption refrigerating apparatus, a generator including a vapor liquid lift, an absorber, a heat exchanging device, means for conducting weak absorption liquid from said generator to said absorber, means for conducting a portion of the strong absorption liquid from the absorber to said lift in heat exchange relation with said weak liquid, means for conducting another portion of said strong absorption liquid from the absorber to said heat exchanging device, means for conducting the liquid from the heat exchanging device to said lift and means for conducting vapor from said generator to the heat exchanging device.

20. In an absorption refrigerating apparatus, an absorber having a liquid sump, a generator having a vapor liquid lift chamber located below the liquid level in said sump, a heat exchanging device below said level and above said chamber, means for conducting weak absorption liquid

from said generator to said absorber, means for conducting a portion of the strong absorption liquid from said sump to the generator in heat exchange relation with said weak liquid, means for conducting another portion of said strong absorption liquid from said sump by gravity flow to said heat exchanging device, means for conducting liquid from said heat exchanging device to said lift chamber by gravity flow and means for conducting vapor from said generator to said heat exchanging device.

21. That improvement in the art of refrigeration which includes absorbing refrigerant vapor in an absorption liquid to form a strong solution, flowing a portion of said strong solution to a region of high temperature to evaporate refrigerant vapor therefrom and to form a weak solution, passing said vapor in heat exchange relation with another portion of strong solution, transferring heat from said weak solution to the first mentioned portion of said strong solution, uniting said portions to form a single stream and elevating said stream by the application of heat thereto.

22. An absorption refrigerating system including a generator, a rectifier for vapor from said generator connected to said generator and arranged to be cooled by absorption liquid flowing to said generator, and an analyzer in which the vapors from said generator flow and contact with absorption liquid flowing to said generator and which is connected to the rectifier to receive condensate from said rectifier.

23. An absorption refrigerating apparatus comprising, an absorber, a generator-vapor lift assembly, a condenser, a triple pass heat exchanger having the passes thereof sealed from one another, means for conducting vapor from said generator-vapor lift assembly through one pass of said heat exchanger to said condenser, an absorption liquid circuit including means for conducting weak absorp-

tion liquid from said generator-vapor lift assembly through a second pass of said heat exchanger to said absorber and means for conducting strong absorption liquid from said absorber through the third pass of said heat exchanger to said generator-vapor lift assembly, said exchanger being located at a level below the surface level of liquid in both said generator-vapor lift assembly and said absorber, said circuit including means between said heat exchanger and said generator-vapor lift assembly for creating a third surface level below a portion of said heat exchanger for permitting drainage of condensate from the vapor pass of said heat exchanger to said circuit.

24. An absorption refrigerating apparatus comprising, an absorber, a generator-vapor lift assembly, a condenser, a triple pass heat exchanger having the passes thereof sealed from one another, means for conducting vapor from said generator-vapor lift assembly through one pass of said heat exchanger to said condenser, an absorption liquid circuit including means for conducting weak absorption liquid from said generator-vapor lift assembly through a second pass of said heat exchanger to said absorber and means for conducting strong absorption liquid from said absorber through the third pass of said heat exchanger to said generator-vapor lift assembly, said exchanger being located at a level below the surface level of liquid in both said generator-vapor lift assembly and said absorber, said circuit including means between said heat exchanger and said generator-vapor lift assembly, for creating a third surface level below a portion of said heat exchanger for permitting drainage of condensate from the vapor pass of said heat exchanger to said circuit, and said means for conducting vapor to said heat exchanger being so related to said means for conducting strong absorption liquid to said generator-vapor lift assembly, that

vapors flowing to said heat exchanger come into physical contact with rich solution flowing to said generator-vapor lift assembly.

25. In an absorption refrigerating apparatus, a generator, a condenser, an absorber, a solution circuit for conducting weak solution from said generator to said absorber and strong solution from said absorber to said generator, vapor lift means for circulating said solution in said circuit, conduit means for conducting vapor from said generator to said condenser, said solution circuit including means to conduct a portion of said strong solution into heat exchange with vapor flowing from said generator to said condenser and another portion of said strong solution into heat exchange with weak solution leaving the boiler.

26. In an absorption refrigerating apparatus, a generator, a condenser, an absorber, a solution circuit for conducting weak solution from said generator to said absorber and strong solution from said absorber to said generator, vapor lift means for circulating said solution in said circuit, conduit means for conducting vapor from said generator to said condenser including a rectifier in heat exchange relation with strong solution flowing to said generator.

27. In an absorption refrigerating apparatus, a generator, a condenser, an absorber, a solution circuit for conducting weak solution from said generator to said absorber and strong solution from said absorber to said generator, vapor lift means for circulating said solution in said circuit, conduit means for conducting vapor from said generator to said condenser including a rectifier in heat exchange with strong solution flowing to said generator and means for bringing vapor flowing from said generator into contact with strong solution flowing to said generator.

28. In an absorption refrigerating apparatus, a generator, a condenser, an absorber, a solution circuit for conducting weak solution from said generator to said absorber and strong solution from said absorber to said generator, vapor lift means for circulating said solution in said circuit, conduit means for conducting vapor from said generator to said condenser including a rectifier in heat exchange with strong solution flowing to said generator, means for conducting condensate from said rectifier to said circuit and vapor from said strong solution circuit to said conduit means leading to the condenser.

29. In an absorption refrigerating apparatus, a generator, a condenser, an absorber, means for flowing weak solution from said generator to said absorber; conduit means for vapor from said generator to said condenser including a rectifier, and means for flowing strong solution from said absorber to said generator, said last mentioned means including means for bringing said strong solution into heat exchange with said rectifier and into contact with vapor in said vapor conduit means.

30. In an absorption refrigerating apparatus, a generator, a condenser, an absorber, means for flowing weak solution from said generator to said absorber, a vapor conduit from said generator to said condenser including a rectifier, conduit means for flowing strong solution from said absorber to said generator, said conduit means including a heat exchanger for exchange of heat between said strong solution and vapor in said rectifier and means for conducting vapor generated from said strong solution in said exchanger to said vapor conduit and condensate from said rectifier to said conduit means.

31. In an absorption refrigerating apparatus, a generator, a condenser, an absorber, means for flowing weak solution from said generator to said absorber, means for

conducting vapor from said generator to said condenser including a rectifier, conduit means for flowing strong solution from said absorber into heat exchange with said rectifier and to said generator and means for flowing liquid from said rectifier into said conduit means.

32. In an absorption refrigerating apparatus, a generator, a condenser, an absorber, means for flowing weak absorption liquid from said generator to said absorber, a vapor conduit from said generator to said condenser including a rectifier, means for flowing strong absorption liquid from said absorber to said generator, said last mentioned means including a heat exchanger for exchange of heat between said strong absorption liquid and vapor in said rectifier and means for leading vapor generated from said strong solution in heat exchange with said rectifier, to said vapor conduit.

33. In an absorption refrigerating apparatus, a generator, a condenser, an absorber, means for flowing weak solution from said generator to said absorber, conduit means for vapor from said generator to said condenser including a rectifier positioned below the normal liquid level in the absorber, means for flowing strong solution from said absorber into heat exchange with said rectifier by gravity and means for flowing liquid condensed in said rectifier and strong solution from the heat exchanger to said generator by gravity.

34. In an absorption refrigerating apparatus, a generator, a condenser, an absorber, means for flowing weak solution from said generator to said absorber, conduit means for vapor from said generator to said condenser including a rectifier, positioned below the liquid level in said absorber, means for flowing strong solution from said absorber into heat exchange with said rectifier by gravity and means for flowing liquid condensed in said rectifier

and strong solution from the heat exchanger, by gravity to said generator, said last mentioned means including means for bringing said liquid and strong solution into contact with vapor leaving the generator.

35. That method of separating absorbent vapor from refrigerant vapor produced in an absorption refrigeration apparatus which comprises passing said vapor mixture into heat exchange relation but out of contact with a strong solution of absorbent medium and refrigerant whereby the absorbent vapor is condensed and the heat of condensation is given up to the strong absorbent solution, conducting any refrigerant vapor liberated from said strong absorbent solution into the refrigerant vapor from which the absorbent vapor has been removed and conducting absorbent vapor condensed from said vapor mixture into the strong absorbent solution.

36. An absorption refrigeration system including a condenser, an evaporator, an absorber, a generator including a heated chamber, a rising conduit having its lower end extending into said heated chamber and forming a vapor lift by which vapor formed by heating of liquid in said chamber raises liquid to a level from which it flows by gravity to said absorber, a rectifier for vapor flowing from said generator to said condenser and located at a level below the surface level of liquid in said absorber, and conduits interconnecting said absorber and generator and also connecting said rectifier to said generator so that liquid flows by gravity from both said absorber and said rectifier to said generator.

37. In an absorption refrigerating system, a generator, a rectifier, an absorber, heat exchange means connected between said generator and absorber, said rectifier being in heat exchange relation with said heat exchange means, and a vapor liquid lift for causing circulation of absorp-

tion liquid between said generator and absorber through said heat exchange means, said lift being connected to receive liquid from both absorber and rectifier and vapor from said generator.

38. An absorption refrigerating system having a circuit for absorption liquid including a generator, an absorber, and a three-part heat exchanger, said exchanger being connected to conduct vapors and liquid from the generator and liquid flowing to the generator in heat transfer relation out of physical contact with each other, said exchanger also being located at a level below the surface levels of liquid in both said generator and said absorber, and means for creating a third surface level of liquid in said circuit below said exchanger to permit drainage of condensate from the vapor portion of said heat exchanger into said liquid circuit.

39. An absorption refrigerating system having a circuit for absorption liquid including a generator-vapor lift assembly, an absorber, and heat exchange means, said exchange means being connected to conduct vapors and liquid from the generator and liquid flowing to the generator in heat transfer relation out of physical contact with each other, said exchange means also being located at a level below the surface level of liquid in both said generator-vapor lift assembly and said absorber, and means for creating a third surface level of liquid in said circuit below a vapor portion of said heat exchange means to permit drainage of condensate from the vapor portion of said heat exchange means into said liquid circuit.

40. An absorption refrigerating system as set forth in Claim 38 in which vapors conducted from the generator to the heat exchanger pass in physical contact with absorption liquid flowing from said heat exchanger to said generator.

41. An absorption refrigerating system having a circuit for absorption liquid including a generator-vapor lift assembly, an absorber, and heat exchange means, said exchange means being connected to conduct vapors and liquid from the generator and liquid flowing to the generator in heat transfer relation out of physical contact with each other, said exchange means also being located at a level below the surface level of liquids in both said generator-vapor lift assembly and said absorber, and means for creating a third surface level of liquid in said circuit below a portion of said exchange means to permit drainage of condensate from the vapor portion of said exchange means into said liquid circuit, said connection for flowing vapors from said generator to said heat exchange means being so related to said connection for flowing liquid to said generator that vapors flowing from said generator to said exchange means pass in physical contact with absorption liquid flowing from said heat exchange means to said generator.

Nov. 7, 1939.

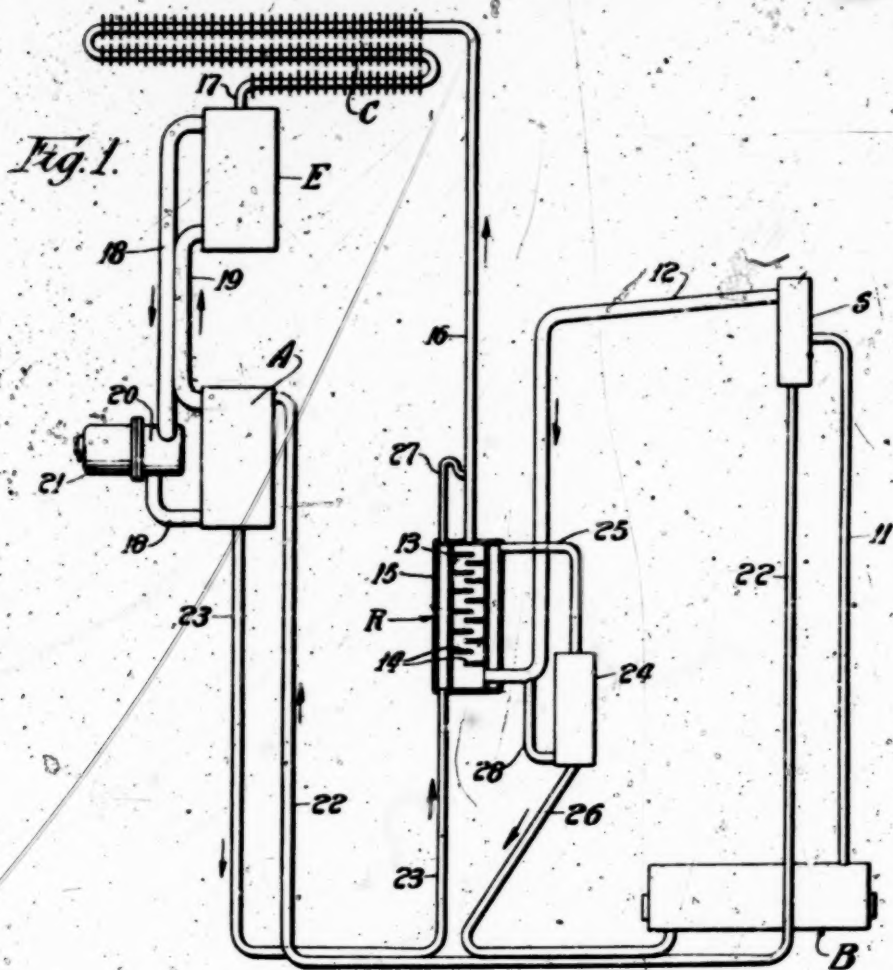
112a
C. C. COONS

2,178,870

CONTINUOUS ABSORPTION REFRIGERATING SYSTEM

Filed Aug. 8, 1936

4 Sheets-Sheet 1



Witness:
E. Camporini

Inventor:
Curtis E. Coons,
By Harry S. Dumas
Attorney

Nov. 7, 1939.

112b

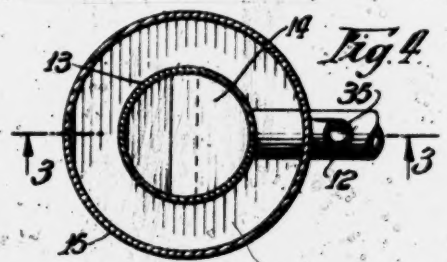
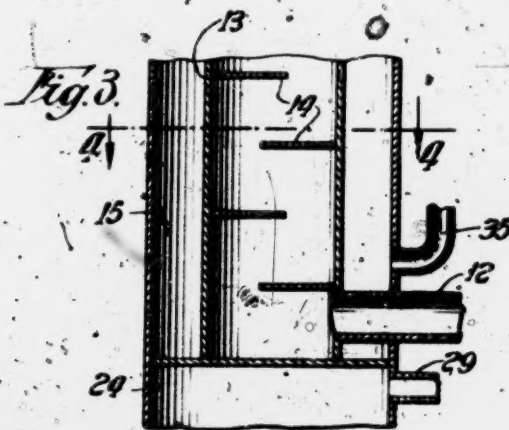
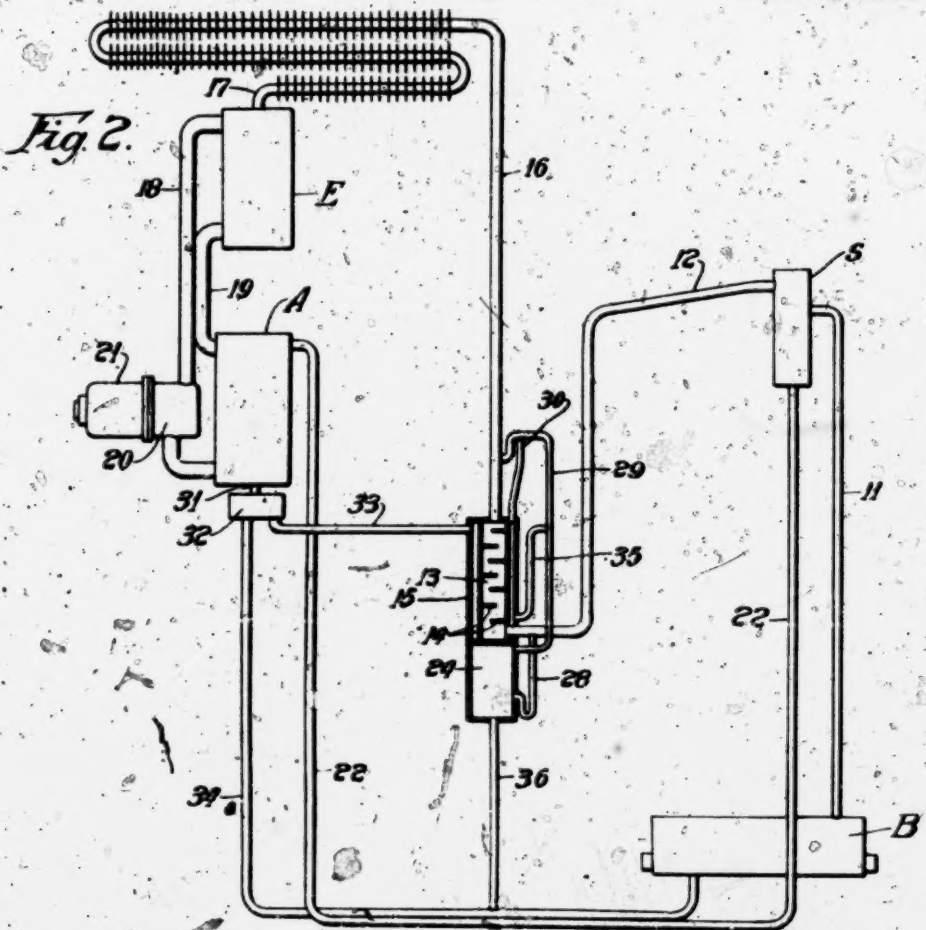
C. C. COONS

2,178,870

CONTINUOUS ABSORPTION REFRIGERATING SYSTEM

Filed Aug. 8, 1936

4 Sheets-Sheet 2



Witness:
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Inventor:
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Attorney.

Nov. 7, 1939.

112c

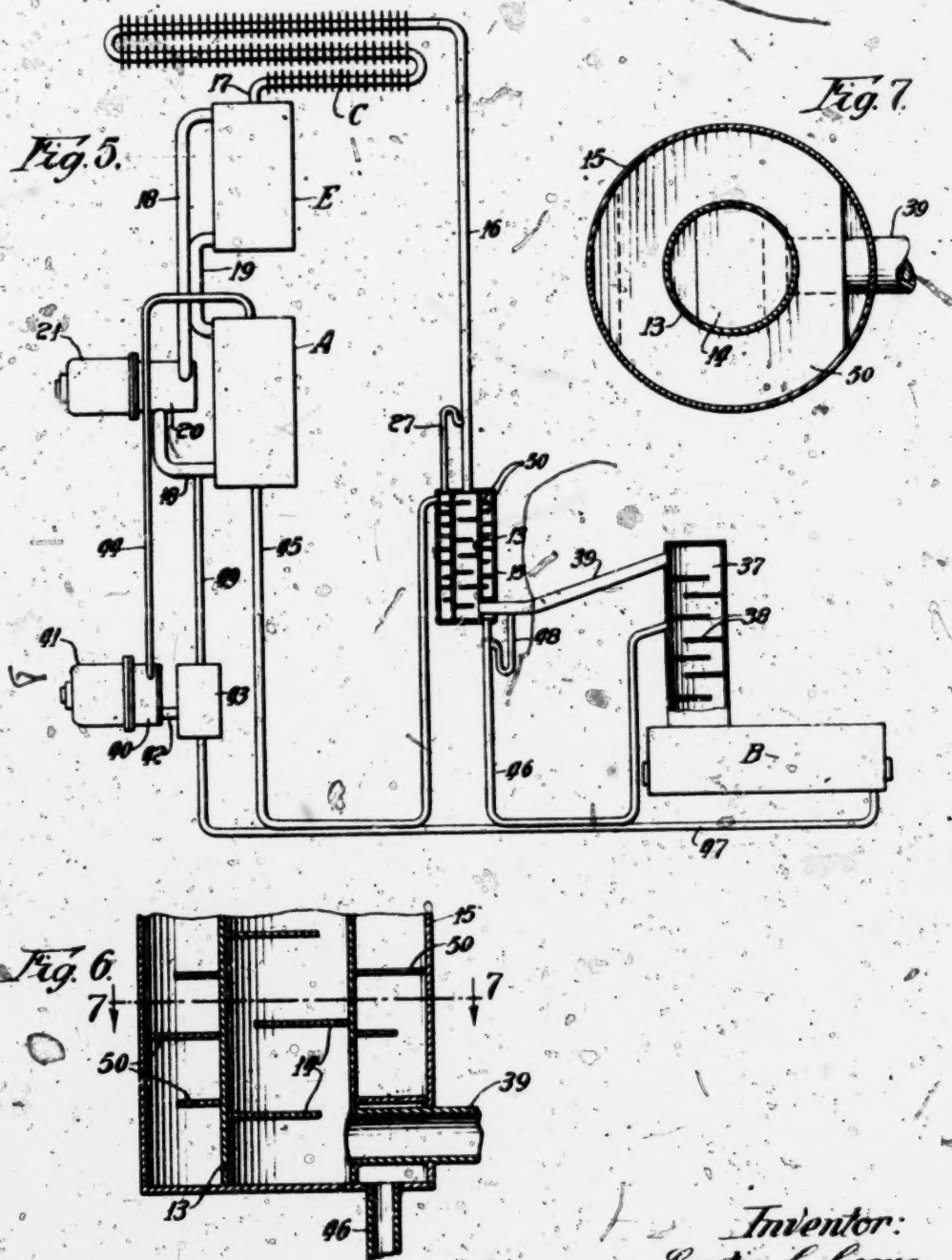
C. C. COONS

2,178,870

CONTINUOUS ABSORPTION REFRIGERATING SYSTEM

Filed Aug. 8, 1936

4 Sheets-Sheet 3



Witness:
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Nov. 7, 1939.

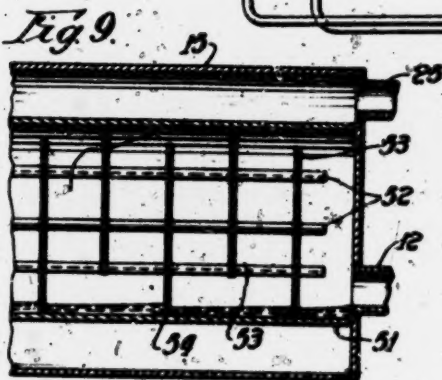
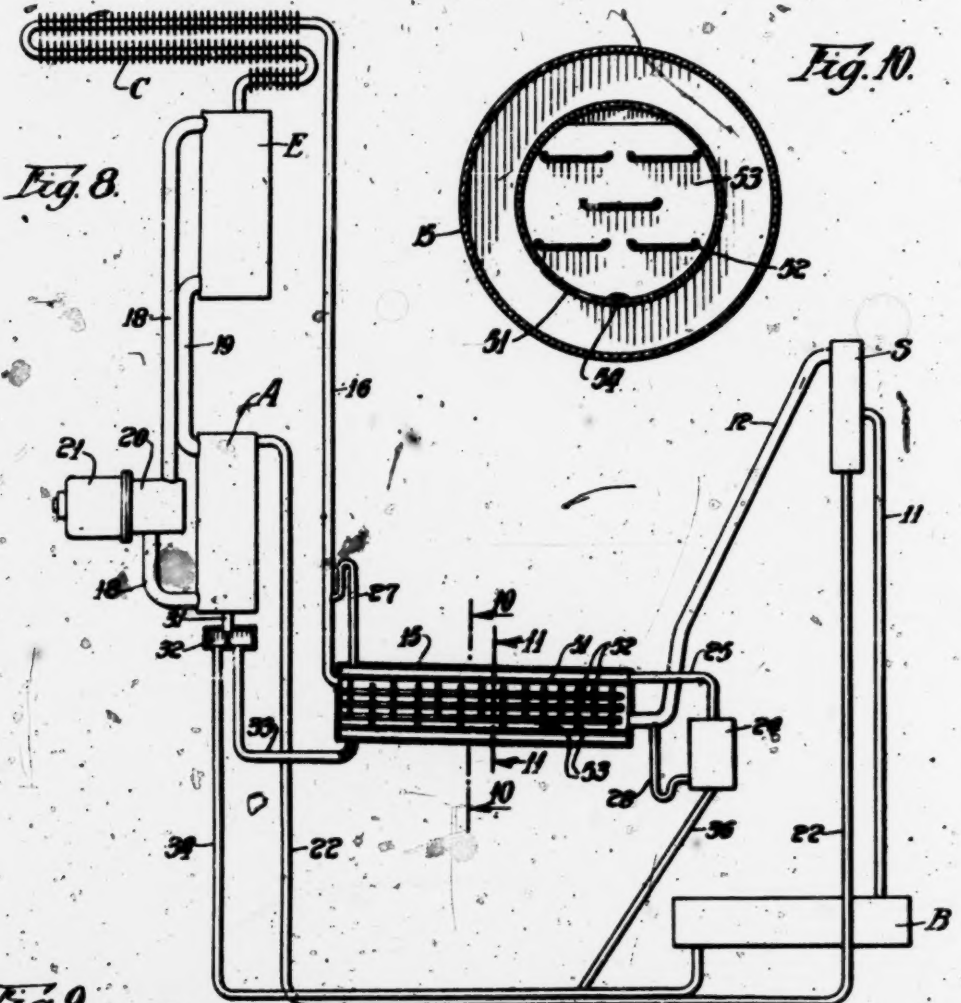
C. C. COONS

2,178,870

CONTINUOUS ADSORPTION REFRIGERATING SYSTEM

Filed Aug. 8, 1936

4 Sheets-Sheet 4



Witness
L. Compton

Inventor:
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By: Harry S. Dumas,
Attorney.

Div. 44 Room 4087B

Paper No. 4

DEPARTMENT OF COMMERCE

United States Patent Office

WASHINGTON

K:mb

Conway P. Coe

Commissioner of Patents

Harry S. Demaree	Applicant: Curtis C. Coons
2300 Willoughby Tower	Ser. No. 373,970
Chicago, Ill.	Filed Jan. 10, 1941
	For Continuous Absorption Refrigerating System.

Mailed
Mar. 28, 1941

Responsive to amendment filed Feb. 24, 1941.

Claim 14 has been reconsidered but is again rejected as not reading on applicant's disclosure for reasons pointed out in detail in the last preceding Office action. In applicant's disclosure the heat exchangers 22-23 and 22-26 are no more in heat transfer relation with the rectifier R than is the boiler B or the evaporator E. In other words the phrase "in heat transfer relation" is meaningless as applicant endeavors to apply it to his disclosure.

Claims 15, 16, 17 and 18 have been reconsidered but are also again rejected as not reading on applicant's disclosure for reasons pointed out in detail in the last preceding Office action.

New claim 36, which is claim 3 of the patent to Anderson No. 2,203,074, June 4, 1940 (Filed Dec. 31, 1937), and which was copied from said patent for the purpose of interference, appears to be patentable and readable upon this application, therefore an interference will be declared promptly between this application and the Anderson patent.

New claim 37 which is based on claim 3 of the patent to Ullstrand 2,215,674 is rejected as not reading on applicant's disclosure for much the same reason as claim 14, above. Applicant's disclosure does not support the phrase, "said rectifier being in heat exchange relation with said heat exchange means", as called for in this claim.

New claims 38, 39, 40 and 41, which are similar to claims 15 to 18 inclusive, and which in turn are based upon claims 7 and 8 of the patent to Bergholm No. 2,201,361, are rejected as not reading on applicant's disclosure for much the same reasons as claims 15 to 18 inclusive.

Applicant does not disclose a "three-part heat exchanger", as called for in claims 38 and 40, any more than does he disclose "a triple heat exchanger" as called for in claim 15. Also applicant does not disclose a three part heat exchanger "located at a level below the surface levels of liquid in both said generator and said absorber," as called for in claims 38 and 40.

Applicant does not disclose "heat exchange means being connected to conduit vapors and liquids from the generator . . . said exchange means being also located at a level below the surface level of liquids in both said generator vapor lift assembly and said absorber," as called for in claims 39 and 41. Also "the surface level" in "the generator vapor lift assembly" is meaningless as applied to applicant's disclosure; the surface of the liquid in applicant's generator B is at one level, while that in his separator S is at a different level.

SUMMARY

Claims 1-8 inclusive, 10, 11 and 34 appear at present to be allowable.

Claim 12, which is claim 1 of the patent to Ullstrand No. 2,215,674, and which was copied from said patent ap-

appears to be patentable and readable upon this application and an interference is being declared between this application and the Ullstrand patent.

Claim 13, which is modified claim 1 of the Ullstrand patent appears to be patentable and readable upon this application. However as previously stated, this claim is deemed to be unwarranted for interference purpose.

Claims 14 and 37 which have been copied and substantially copied, respectively, from the Ullstrand patent are rejected as not reading on applicant's disclosure. If applicant desires to further contest priority as to these two claims his remedy is by a proper motion under Rule 109 during the motion period of the interference that is being declared between this application and the Ullstrand patent.

Claims 15, 16, 17, 18, 38, 39, 40 and 41, which have been copied or substantially copied from the patent to Berg-holm No. 2,201,362 are rejected as not reading on applicant's disclosure and this rejection is Made Final.

Claims 19, 20 and 21, which are based upon claims 1, 2 and 4, respectively, of the patent to Taylor No. 2,222,548 appear to be patentable and readable upon this application, but as stated in the last preceding Office action, these claims do not come within the doctrine of Ex parte Card and Card, therefore an interference between this application and the Taylor patent is unwarranted.

Claims 9, 22-23 inclusive and 35 stand rejected as of the Office action of February 4, 1941.

If applicant desires to further contest priority as to claims 15, 16, 17, 18, 38, 39, 40 and 41 he is required, under the provisions of Rule 63, to appeal to the Board of Appeals from the final rejection of these claims on or before April 25, 1941. Failure to appeal within the time fixed will be deemed a disclaimer of the invention claimed.

Examiner.

IN THE UNITED STATES PATENT OFFICE,

Before the Board of Appeals.

Application of:

Curtis C. Coons

Sérial No. 373,970

Filed: January 10, 1941

For: Continuous Absorption
Refrigerating System

Div. 44

Room 4087B

April 24, 1941

NOTICE OF APPEAL.Hon. Commissioner of Patents
Washington, D. C.

Sir:—

The applicant hereby appeals to the Board of Appeals from the Examiner's final rejection of Claims 15, 16, 17, 18, 38, 39, 40 and 41 on the following grounds:

1. The Examiner erred in finally rejecting Claims 15, 16, 17, 18, 38, 39, 40 and 41.
2. The Examiner erred in finally rejecting Claims 15, 16, 17, 18, 38, 39, 40 and 41 as not reading on applicant's disclosure.

The appeal fee of \$15.00 is forwarded herewith.

Respectfully,

CURTIS C. COONS,

By

Attorney.

RRF:hks

AIRMAIL

DEPARTMENT OF COMMERCE

UNITED STATES PATENT OFFICE

WASHINGTON

Mailed
July 12, 1941

In re application of
Curtis C. Coons
Serial No. 373,970
Filed: Jan. 10, 1941
For: Continuous Absorption
Refrigerating System

On Appeal
to the
Board of Appeals

EXAMINER'S STATEMENT.

This is an appeal from the action of the Primary Examiner in finally rejecting claims 15, 16, 17, 18, 38, 39, 40, and 41.

Claim 15 is claim 7 of the patent to Bergholm No. 2,201,362, May 21, 1940, and has been copied into this reissue application for the purpose of interference.

Claims 16, 17, 18, 38, 39, 40 and 41 are based on claims 7 and 8 of said Bergholm patent, and have been inserted into this application for the purpose of interference under the doctrine of Ex parte Card and Card (1120 O. G. 499; 1904 C. D. 383).

The appealed claims have all been finally rejected for the reason that they are not supported by applicant's disclosure.

The appealed claims read as follows:

Claim 15. An absorption refrigerating system having a circuit for absorption liquid including a generator, an absorber, and a triple heat exchanger, said exchanger being connected to conduct vapors and liquid from the generator and liquid flowing to the

generator in heat transfer relation out of physical contact with each other, said exchanger also being located at a level below the surface levels of liquid in both said generator and said absorber, and means for creating a third surface level of liquid in said circuit below said exchanger to permit drainage of condensate from the vapor portion of said heat exchanger into said liquid circuit.

Claim 16. An absorption refrigerating system having a circuit for absorption liquid including a generator-vapor lift assembly, an absorber, and a heat exchanger, said exchanger being connected to conduct vapors and liquid from the generator and liquid flowing to the generator in heat transfer relation out of physical contact with each other, said exchanger also being located at a level below the surface level of liquids in both said generator-vapor lift assembly and said absorber, and means for creating a third surface level of liquid in said circuit below a portion of said heat exchanger to permit drainage of condensate from the vapor portion of said heat exchanger into said liquid circuit.

Claim 17. An absorption refrigerating system as set forth in the preceding claim in which vapors conducted from the generator to the heat exchanger pass in physical contact with absorption liquid flowing from said heat exchanger to said generator.

Claim 18. An absorption refrigerating system having a circuit for absorption liquid including a generator-vapor lift assembly, an absorber, and a heat exchanger, said exchanger being connected to conduct vapors and liquid from the generator and liquid flowing to the generator in heat transfer relation out of physical contact with each other, said exchanger also being located at a level below the surface level of liquid in both said generator-vapor lift assembly and said absorber, and means for creating a third surface level of liquid in said circuit below a portion of said heat exchanger to permit drainage of condensate from the vapor portion of said heat exchanger into

said liquid circuit, said connection for flowing vapors from said generator to said heat exchanger being so related to said connection for flowing liquids to said generator that vapors flowing from said generator to said heat exchanger pass in physical contact with absorption liquid flowing from said heat exchanger to said generator.

Claim 38. An absorption refrigerating system having a circuit for absorption liquid including a generator, an absorber, and a three-part heat exchanger, said exchanger being connected to conduct vapors and liquid from the generator and liquid flowing to the generator in heat transfer relation out of physical contact with each other, said exchanger also being located at a level below the surface levels of liquid in both said generator and said absorber, and means for creating a third surface level of liquid in said circuit below said exchanger to permit drainage of condensate from the vapor portion of said heat exchanger into said liquid circuit.

Claim 39. An absorption refrigerating system having a circuit for absorption liquid including a generator-vapor lift assembly, an absorber, and heat exchange means, said exchange means being connected to conduct vapors and liquid from the generator and liquid flowing to the generator in heat transfer relation out of physical contact with each other, said exchange means also being located at a level below the surface level of liquids in both said generator-vapor lift assembly and said absorber, and means for creating a third surface level of liquid in said circuit below a vapor portion of said heat exchange means to permit drainage of condensate from the vapor portion of said heat exchange means into said liquid circuit.

Claim 40. An absorption refrigerating system as set forth in Claim 38 in which vapors conducted from the generator to the heat exchanger pass in physical contact with absorption liquid flowing from said heat exchanger to said generator.

Claim 41. An absorption refrigerating system having a circuit for absorption liquid including a generator-vapor lift assembly, an absorber, and heat exchange means, said exchange means being connected to conduct vapors and liquid from the generator and liquid flowing to the generator in heat transfer relation out of physical contact with each other, said exchange means also being located at a level below the surface level of liquids in both said generator-vapor lift assembly and said absorber, and means for creating a third surface level of liquid in said circuit below a portion of said exchange means to permit drainage of condensate from the vapor portion of said exchange means into said liquid circuit, said connection for flowing vapors from said generator to said heat exchange means being so related to said connection for flowing liquid to said generator that vapors flowing from said generator to said exchange means pass in physical contact with absorption liquid flowing from said heat exchange means to said generator.

The invention pertains to a heat operated absorption refrigerating apparatus of the type having an inert gas in the system into which the refrigerant diffuses in the evaporator to produce cooling.

Applicant's Disclosure.

In so far as the appealed claims are concerned, a description of the refrigerating system illustrated in Fig. 1 is believed to be sufficient. In this figure an absorption refrigerating system is disclosed wherein heat is supplied to the boiler B to drive refrigerant vapor out of a saturated solution of ammonia and water, commonly referred to as strong aqua. Ammonia vapor boils off from the water and in passing through the vapor lift pump 11 carries slugs of weakened absorption solution (weak aqua) into the separating chamber S. From the separating

chamber the ammonia vapor passes through conduit 12, rectifier R, conduit 16 to condenser C. In condenser C the ammonia vapor condenses to liquid. The liquid ammonia flows through conduit 17 into evaporator E. In evaporator E, the liquid ammonia evaporates by diffusing through an inert gas such as nitrogen and this evaporation produces the desired cooling. The mixture of ammonia and nitrogen gas formed in the evaporator passes through conduit 18 and gas circulator 20 into the lower end of absorber A. Weak aqua passes from gas separator S through conduit 22 into the upper end of absorber A. In passing through the absorber the weak aqua absorbs the ammonia from the mixture of ammonia and nitrogen. The strong aqua formed by this absorption flows from the bottom of the absorber through conduit 23, rectifier R, conduit 25, reservoir 24 and conduit 26 back to boiler B where the ammonia is again boiled off. The nitrogen is not absorbed by the weak aqua in the absorber and returns through conduit 19 the bottom of evaporator E to cause more diffusion and evaporation of ammonia in the evaporator. The strong aqua in passing from the absorber to the boiler is conducted in heat exchange relation with the weak aqua passing from the gas separator S to the absorber in two places, one where conduits 23 and 22 are in heat exchange relation, and another where the conduits 26 and 22 are in heat exchange relation. The strong aqua also passes in heat exchange relation with the ammonia vapor as the former passes through the outer chamber 15 of the rectifier R and the latter passes through the inner chamber 13 of said rectifier. In other words, the application discloses three separate and distinct heat exchangers.

Bergholm Patent Disclosure.

The Bergholm patent, from which the appealed claims were copied or substantially copied by applicant for the purpose of interference, discloses a refrigerating system of the absorption type containing a refrigerant fluid such as ammonia, an absorption liquid for the refrigerant such as water, and an inert pressure equalizing gas such as hydrogen. Figure 1 of this patent illustrates such a refrigerating system wherein ammonia vapor, expelled from solution by heating generator 10, flows through conduit 31, vessel 28, conduit 27 outside passage 25 of triple heat exchanger 22, and conduit 26 to condenser 18. Ammonia vapor is condensed to liquid in the condenser and the liquid flows through conduit 20 into the upper end of evaporator 16. Liquid ammonia flows downward in evaporator 16 and evaporates and diffuses into hydrogen which flows upward in the evaporator, producing a refrigerating effect. The mixture of ammonia vapor and inert gas flows by gravity from the upper end of the evaporator through the inner passage of gas heat exchanger 21, into the lower end of the absorber.

Weakened absorption liquid flows by gravity from the lower part of generator 10 through conduit 34, inner passage 23 of triple heat exchanger 22, and conduit 35 into the upper part of absorber 13. Absorption liquid flows downward in the absorber and absorbs ammonia vapor out of the mixture of ammonia vapor and inert gas from the evaporator which flows upwards through the absorber. Enriched absorption solution flows from the lower end of absorber 13 into vessel 14. From vessel 14 the enriched absorption solution flows through conduit 32, the middle passage 24 of the triple heat exchanger 22, conduit 33, and conduit 31 into reservoir 28. From reservoir 28 the enriched absorption solution flows through

conduit 29 and vapor-lift pump 30 back to the top of generator 19, where the solution is again heated to expel the ammonia vapor therefrom.

The "triple heat exchanger" 22 of this patent is so constructed and arranged that the refrigerant vapor in passing from the generator to the condenser passes in heat exchange relation with the enriched absorption solution passing from the absorber to the generator, and the said enriched absorption solution is simultaneously in heat exchange relation with weak absorption solution passing from the generator to the absorber. In other words, this patent discloses a single heat exchanger wherein three fluids are brought into heat exchange relation.

Claim 15, which is a verbatim copy of claim 7 of the patent to Bergholm, stands finally rejected as not being supported by applicant's disclosure. This claim includes:

"* * * a triple heat exchanger, said exchanger being connected to conduct vapors and liquid from the generator and liquid flowing to the generator in heat transfer relation out of physical contact with each other, said exchanger also being located at a level below the surface levels of liquid in both said generator and said absorber, and means for creating a third surface level of liquids in said circuit below said heat exchanger * * *".

In this instant application, as stated above, there is disclosed three separate and distinct heat exchangers, and not "a triple" heat exchanger as called for in claim 15. Also one of the heat exchangers, the rectifier R, is above the surface level of liquid in the generator B and not "below" the surface levels in both said generator and said absorber. Furthermore, the reservoir 24, which is

the only element that may be said to be a "means for creating a third surface level", is above the two heat exchangers 23-22 and 26-22 and not "below said exchanger.", as called for in this claim.

Claim 16, which may be taken as representative of finally rejected claims 16, 17, 18, 39, 40 and 41 includes:

"* * * a heat exchanger, said exchanger being connected to conduct vapors and liquids from the generator and liquids flowing to the generator * * *, said exchanger also being located at a level below the surface level of liquids in both said generator-vapor lift assembly and said absorber * * *"

Applicant discloses three heat exchangers and not "a" heat exchanger arranged in the manner called for in claim 16. Also the phrase "surface level" is meaningless when applied to applicant's so called "generator-vapor lift assembly". In applicant's generator (boiler B) the surface level of liquid is somewhere in the vicinity of the connection between the boiler B and the vapor lift pump 11, depending on the type of vapor lift pump that is used, and in applicant's gas separator S, which he includes as a part of the generator-vapor lift assembly, the surface level is somewhere below the connection between the vapor lift pump 11 and said gas separator S. In other words, there are two surface levels in applicant's generator-vapor lift assembly and not a surface level as required by claim 16.

Claim 38, which is a duplicate of claim 15, except that claim 15 recites "a triple heat exchanger", and claim 38 calls for "a three-part heat exchanger", stands finally rejected for the same reasons as claim 15. Applicant does not disclose a three-part heat exchanger any more than he does a triple heat exchanger. Also the other criticism

applied to claim 15, above, applies in the same manner to claim 38.

Conclusions.

None of appealed claims 15, 16, 17, 18, 38, 39, 40 or 41 read on applicant's disclosure. It is submitted, therefore that these claims stand properly rejected.

Respectfully submitted,

Examiner, Division 44.

DEPARTMENT OF COMMERCE

UNITED STATES PATENT OFFICE

WASHINGTON

Mailed
Sep 9 1941

In re application of
Curtis C. Coons
Serial No. 373,970
Filed: Jan. 10, 1941
For: Continuous Absorption
Refrigerating System

On Appeal
to the
Board of Appeals

SUPPLEMENTAL EXAMINER'S STATEMENT.

This case has been remanded to the Primary Examiner for his disposition of the communication filed by applicant July 16, 1941, wherein applicant requested the Examiner to indicate on record that the affidavit of applicant and the amendment filed April 23, 1941 were considered by the Examiner.

The Examiner's Statement does not specifically state that the above affidavit and amendment were considered by the Examiner. However, both the affidavit and the amendment were carefully considered by the Examiner at the time the Examiner's Statement was written.

To amplify the Examiner's Statement, as to applicant's affidavit, the Examiner does not consider that this affidavit adds anything to the case insofar as the rejection of the appealed claims is concerned. As a matter of fact, applicant in his affidavit more or less admits that there are two surface levels in his so called "generator-vapor lift assembly", and not a surface level in the generator as required by appealed claim 16, for instance. In page 2, lines 12 to 17 inclusive of applicant's affidavit the following statement is found:

"... there is no definite liquid level maintained in the boiler B per se but that the liquid in the boiler B rises in the conduit 11 so as to maintain a definite depth of immersion on the vapor lift 11. That the level of liquid in the vessel 24 is below the liquid level in the gas separation chamber S and also below the liquid level in the absorber A".

In other words, there is one liquid level in the vicinity of the connection between the boiler B and the vapor lift conduit 11, and another liquid level in the separator chamber S.

Furthermore, the last phrase of the above quotation, "and also below the liquid level in the absorber A", is not supported by applicant's original disclosure. In none of the systems disclosed by applicant is there a liquid level in the absorber. While applicant has not disclosed any particular type of absorber, he states in page 2, column 2, lines 43-48 inclusive of his specification:

"... liquid may flow ... through the conduit 22 into the top of the absorber and after trickling downwardly over baffle plates or the like within the absorber, flow by gravity through the conduit 23...."

Since the conduit 23 is connected to the bottom of the absorber and the rich gas conduit 18 leads into the bottom of the absorber it is not seen how it may be said that there is a "liquid level in the absorber".

In the Bergholm patent from which the appealed claims were copied, or substantially copied, for the purpose of interference, a liquid level is clearly shown in the sump portion 14 of the absorber. That the sump 14 is a part of Bergholm's absorber is clear from the following statement found in page 1, column 1, lines 15-17 of his specification:

"An absorber comprises a conduit 13 and a liquid accumulation vessel or sump 14."

As to the amendment of April 23, 1941, referred to by applicant in his communication of July 16, 1941, this amendment had been entered and was obviously a part of the case when the Examiner's Statement was written.

It is submitted that the appealed claims stand properly rejected for reasons pointed out in the Examiner's Statement of July 12, 1941, and amplified in this Supplemental Examiner's Statement.

Respectfully submitted,

Examiner, Division 44.

Appeal No. 39,111

Hearing:

September 25, 1941

IN THE UNITED STATES PATENT OFFICE

Before the Board of Appeals.

Ex parte Curtis C. Coons.

Application for patent filed January 10, 1941, Serial No. 373,970, for the reissue of patent No. 2,178,870 granted November 7, 1939. Continuous Absorption Refrigerating System.

Mr. Harry S. Demaree and Mr. Richard R. Fitzsimmons
for applicant.

This is an appeal from the decision of the examiner finally rejecting claims 15 to 18 and 38 to 41. In the brief filed notice is given that the appeal is withdrawn as to claims 17, 18, 40 and 41 leaving only claims 15, 16, 38 and 39 for our consideration.

The following claim is representative:

15. An absorption refrigerating system having a circuit for absorption liquid including a generator, an absorber, and a triple heat exchanger, said exchanger being connected to conduct vapors and liquid from the generator and liquid flowing to the generator in heat transfer relation out of physical contact with each other, said exchanger also being located at a level

below the surface levels of liquid in both said generator and said absorber, and means for creating a third surface level of liquid in said circuit below said exchanger to permit drainage of condensate from the vapor portion of said heat exchanger into said liquid circuit.

Claim 15 was copied from the patent to Bergholm No. 2,201,362 May 21, 1940 for the purpose of interference. The remaining claims are based on claims 7 and 8 of said Bergholm patent and have been inserted here for the purpose of interference under the practice set forth in *Ex parte* Card and Card, 1904 C.D. 383. The subject matter involved here is an absorption refrigerating machine of the inert gas type. The structure involved in this application and that disclosed in the Bergholm patent have been clearly and adequately described in the examiner's statement and need not be repeated here.

In general, the subject matter in dispute appears to center about the mechanism for causing exchange of heat between the hot gas, the hot weak liquor flowing from the generator and the comparatively cool strong liquor returning to the generator. In the patent these features have been incorporated in a unitary structure consisting of concentric pipes and is defined in claim 15 as "a triple heat exchanger" as used in claim 5, or "a heat exchanger" as used in claim 16, and like expressions used in claims 38 and 39 do not read on appellant's disclosure. Also difficulty has been encountered in attempting to apply the "surface level" as used in these claims to appellant's structure. As pointed out by the examiner in appellant's structure there are two surface levels in the generator-vapor lift assembly and not a single surface level as required by claim 16. As pointed out above, the expression "a triple heat exchanger" as used in claim 38 does not read on appellant's disclosure.

For reasons stated, the decision of the examiner is affirmed as to claims 15, 16, 38 and 39 and the appeal is dismissed as to claims 17, 18, 40 and 41.

Eugene Landers
Examiner-in-Chief

F. P. Edinburg
Examiner-in-Chief

C. H. Shaffer
Examiner-in-Chief

Board
of
Appeals

Mr. Harry S. Demaree
2300 Willoughby Tower
Chicago, Ill.
Oct. 6, 1941.

Appeal No. 39,111

MM

IN THE UNITED STATES PATENT OFFICE,

Before the Board of Appeals.

Ex parte Curtis C. Coons.

Application for patent filed January 10, 1941, Serial No. 373,970 for the reissue of patent No. 2,178,870 granted November 7, 1939. Continuous Absorption Refrigerating System.*

Mr. Harry S. Demaree and Mr. Richard R. Fitzsimmons
for applicant.

ON PETITION FOR RECONSIDERATION.

This petition is directed mainly to claim 39. The expression "heat exchange means", may be taken to read on appellant's structure, but this heat exchange means is in three parts and the part R is above not below the surface level of the generator-vapor lift assembly. When in operation it is almost impossible to state just where the liquid level is in the generator-vapor lift apparatus but the assumption of the examiner that it "is somewhere below the connection between the vapor lift pump 11 and said gas separator 5" appears to be correct. For reasons stated we are still of the opinion that claim 39 does not read on the disclosure in this case, and our former decision remains unchanged.

The petition has been granted to the extent indicated.

Eugene Landers
Examiner-in-Chief

F. P. Edinburg
Examiner-in-Chief

C. H. Shaffer
Examiner-in-Chief

Board
of
Appeals

Mr. Harry S. Demaree,
2300 Willoughby Tower
Chicago, Ill.
Oct. 17, 1941.

May 21, 1940.

H. K. BERGHOLM

2,201,362

REFRIGERATION

Filed Nov. 20, 1937

2 Sheets-Sheet 1

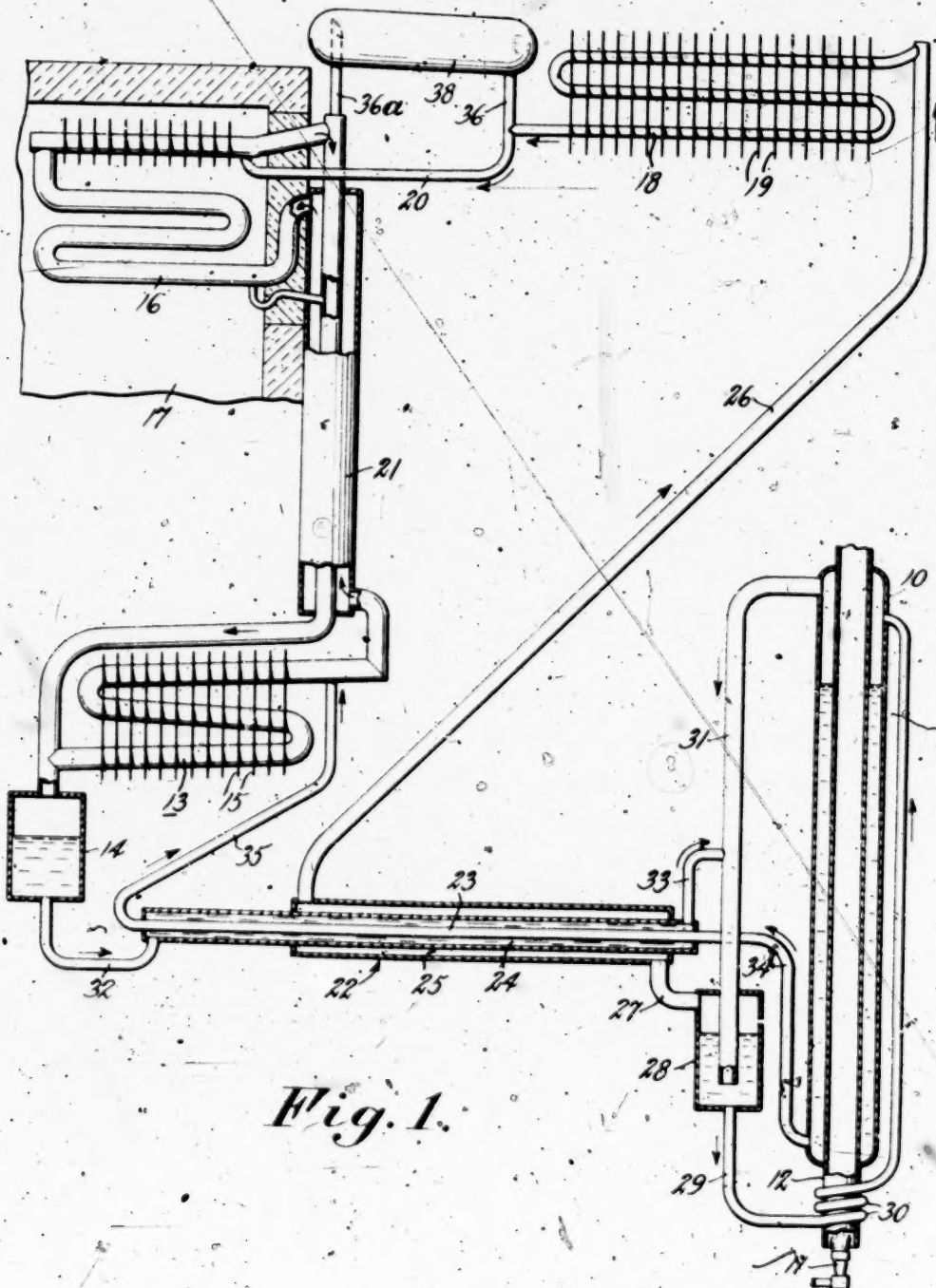


Fig. 1.

Olav K. Bergholm INVENTOR

BY

O. E. Glick
his ATTORNEY.

135

May 21, 1940.

H. K. BERGHOLM
REFRIGERATION

2,201,362

Filed Nov. 20, 1937

2 Sheets-Sheet 2

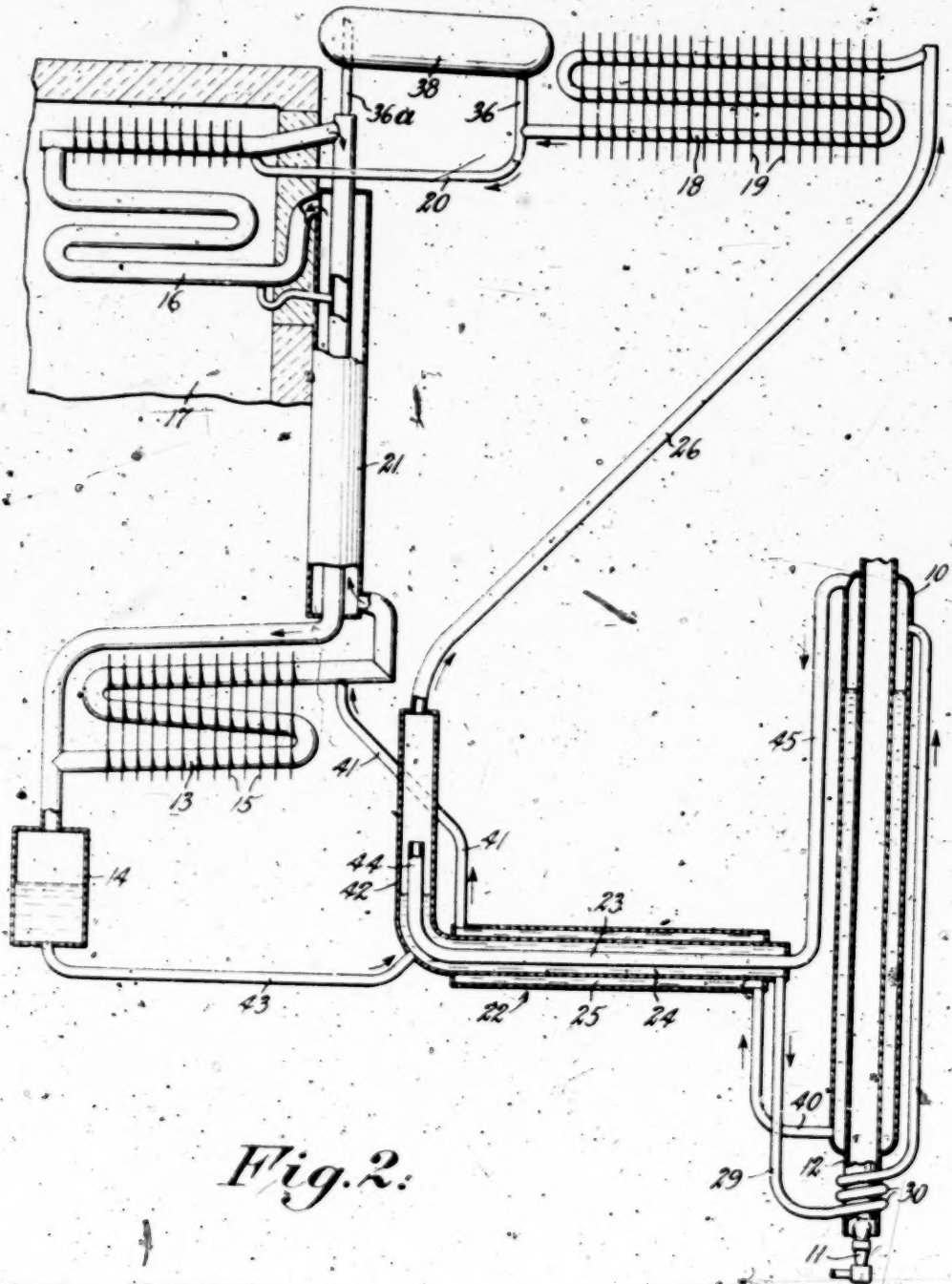


Fig. 2.

INVENTOR
Harry K. Bergholm
BY
D. L. Olcott
ATTORNEY

CERTIFICATE OF CORRECTION.

Patent No. 2,201,362.

May 21, 1940.

HARRY K. BERGHOLM.

It is hereby certified that error appears in the above numbered patent requiring correction as follows: In the heading to the printed specification, line 7, for "In Germany August 27, 1937" read -- In Germany August 17, 1937 --; and that the said Letters Patent should be read with this correction therein that the same may conform to the record of the case in the Patent Office.

Signed and sealed this 20th day of July, A. D. 1940.

(Seal)

Henry Van Arsdale,
Acting Commissioner of Patents.

UNITED STATES PATENT OFFICE

2,201,362

REFRIGERATION

Harry K. Bergholm, Stockholm, Sweden, assignor,
by mesne assignments, to Servel, Inc., New
York, N. Y., a corporation of Delaware

Application November 20, 1937, Serial No. 175,632
In Germany August 27, 1937

9 Claims. (Cl. 62-119.5)

My invention relates to an absorption type refrigeration system and it is an object of the invention to provide a system of this type having greater efficiency.

In the drawings:

Fig. 1 shows more or less diagrammatically the invention embodied in an absorption refrigeration system of a type making use of a pressure equalizing fluid; and

Fig. 2 shows a modification embodied in a system like that shown in Fig. 1.

Referring to Fig. 1, a generator 10 is heated by a suitable means such as a gas burner 11 arranged so that the burner flame projects into the lower end of a flue 12. An absorber comprises a conduit 13 and a liquid accumulation vessel or sump 14. The lower end of conduit 13 is connected to the upper part of vessel 14. Conduit 13 is provided with heat transfer fins 15 for cooling of the absorber by air. The absorber 13 may be cooled in any other suitable manner, as by a vaporization-condensation circuit or a water circulating coil.

An evaporator comprises a pipe coil 16 located in an insulated refrigerator compartment 17. A condenser comprises a pipe coil 18 provided with heat transfer fins 19 for cooling by air.

The lower part of condenser 18 is connected by a conduit 20 to the upper part of evaporator 16 for flow of condensed liquid refrigerant from the condenser to the evaporator. The evaporator 16 and absorber 13 are interconnected for circulation of inert gas therethrough and therebetween by conduits including a gas heat exchanger 21.

The absorber 13 and generator 10 are interconnected for circulation of absorption liquid therethrough and therebetween by conduits including a triple heat exchanger 22 and vapor flows from the generator 10 to the condenser 18 through conduits which also include the triple heat exchanger 22 as hereinafter described.

The triple heat exchanger 22 comprises an inner passage 23, a middle passage 24 and an outer passage 25. One end of the outer passage 25 is connected by a conduit 26 to the upper end of condenser 18. The other end of the outer passage 25 is connected by a conduit 27 to the upper part of a vessel 28. The lower part of vessel 28 is connected by a conduit 29 to the upper part of generator 10. Conduit 29 has a part formed as a coil 30 around the lower end of the generator heating flue 12. Conduit 29 forms a vapor liquid lift for raising liquid from vessel 28 into generator 10.

The upper end of a conduit 31 is connected to the upper part of generator 10. The lower end of conduit 31 extends into the lower part of vessel 28. One end of the middle passage 24 of the triple heat exchanger 22 is connected by a conduit 32 to the lower part of the absorber vessel 14. The other end of the middle heat exchanger passage is connected by a conduit 33 to conduit 31. The connection of conduit 33 to conduit 31 is made at a level above the bottom of absorber vessel 14 and below the lower end of the absorber conduit 13. The lower part of generator 10 is connected by a conduit 34 to one end of the inner passage 23 of the triple heat exchanger 22. The other end of inner passage 23 is connected by a conduit 35 to the upper part of the absorber coil 13.

The system contains a refrigerant fluid such as ammonia, an absorption liquid for the refrigerant such as water, and inert pressure equalizing gas such as hydrogen. The lower end of condenser 18 is connected by a conduit 36 to the gas circuit. Conduit 36 may be referred to as a vent conduit and includes a vessel 38 which serves as a storage chamber for gas, as known.

In operation, ammonia vapor, expelled by heating from solution in generator 10, flows through conduit 31, vessel 28, conduit 27, the outside passage 25 of the heat exchanger 22, and conduit 26 to the condenser 18. Ammonia vapor is condensed to liquid in condenser 18 and the liquid flows through conduit 20 into the upper end of evaporator 16. Liquid ammonia flows downward in evaporator 16 and evaporates and diffuses into hydrogen which flows upward in evaporator 16, producing a refrigerating effect.

Weakened absorption liquid flows from the lower part of generator 10 through conduit 34, inner passage 23 of the heat exchanger 22, and conduit 35 into the upper part of absorber 13. Absorption liquid flows downward in absorber 13 and absorbs ammonia vapor out of gas from the evaporator which flows upward in the absorber. Enriched absorption liquid flows from the lower end of conduit 13 into the sump 14. Enriched solution flows from the absorber vessel 14 through conduit 32, the middle passage 24 of the heat exchanger 22, conduit 33, and conduit 31 into vessel 28. From vessel 28 rich solution flows through conduit 29 into the generator 10, being raised through conduit 29 in a known manner by the lifting action of vapor formed by heating the solution in coil 30.

The level of liquid in generator 10 is high enough so that the described flow of weak solution from the generator to the absorber is caused

by overflow of liquid from the upper end of conduit 35 into the upper part of absorber coil 13. The level of rich solution in the absorber vessel 14 is high enough so that the described flow of rich solution from the absorber to the vessel 28 is caused by overflow of liquid from the upper end of conduit 33 into the descending vapor conduit 31. Conduit 29 is generally U-shaped with the descending leg connected to vessel 28 and the coiled portion 30 formed in the rising leg which is connected to the upper part of the generator. The level of liquid in vessel 28 is high enough so that the column of liquid in this vessel and the descending leg of conduit 29 balances the column of vapor and liquid in the right hand leg of conduit 29 with the rising column extending to the upper end of the rising leg of conduit 29 so that the liquid in this column flows into the upper part of the generator.

There are, thus, three levels of liquid in the system: An upper level in generator 10; an intermediate level in absorber vessel 14; and a lower level in vessel 28.

The lower end of conduit 31 may or may not extend below the level of liquid in vessel 28. If the lower end of conduit 31 is extended below the level of liquid in vessel 28, as shown, vapor from the generator will bubble upward through liquid in vessel 28. In such case vessel 28 may be referred to as an analyzer. The level of liquid in generator 10 will be lowered a distance depending upon the distance of immersion of the lower end of conduit 31 into liquid in the analyzer vessel 28.

In the triple heat exchanger 22, hot weak solution from the generator flows in the inner passage in counter-current to cooler strong solution from the absorber flowing in the middle passage and gives up heat to the latter. Vapors from the generator flowing in the outside passage 25 in counter-current relation to cooler strong solution in the middle passage 24 also give up heat to the latter. The heat transferred from generator vapors to the strong solution in the heat exchanger 22 may be referred to as heat of rectification. The efficiency of the system is increased because this heat comes from the generator and is returned to the generator with the strong solution. The transfer of heat of rectification is accompanied by condensation of water vapor in the outside passage 25 of the heat exchanger. The condensate formed in the outside passage 25 of the heat exchanger drains through conduit 27 into vessel 28 whence it is returned along with strong solution through conduit 29 to the generator, whereby the sensible heat in the condensate is also conserved.

In order to bring the generator vapors into heat exchange relation with solution flowing between the absorber and generator, the vapors are conducted to a level below the surface levels of liquid in the generator and absorber. In order to return to the generator water formed by condensation due to this heat exchange, I have introduced the further surface level of liquid in vessel 28 which is below the level at which condensation takes place so that the condensate may join the rich solution and be raised therewith above the heat exchanger.

In Fig. 2 the system is the same as that described in connection with Fig. 1, and in these figures like parts are indicated by the same reference numerals. In this modification, however, weakened absorption liquid flows from the lower part of generator 10 through a conduit 40, the

outside passage 25 of the triple heat exchanger 22, and conduit 41 to the upper end of the absorber 13. The lower end of an upright conduit or standpipe 42 is connected to one end of the middle passage 24 of the heat exchanger. The other end of the middle passage 24 is connected to the descending leg of the vapor liquid lift conduit 29. The upper end of the standpipe 42 is connected to the lower end of conduit 26 which leads to the condenser 18. The lower part of the absorber vessel 14 is connected by a conduit 43 to the lower part of the standpipe 42. Within the standpipe 42 is a conduit 44. The upper end of this conduit is open and located in the upper part of the standpipe 42. The lower end of conduit 44 is connected to one end of the inner passage 23 of the heat exchanger 22. The other end of the inner passage 23 is connected by a conduit 45 to the upper part of generator 10.

Strong solution flows from the absorber through conduit 43, standpipe 42, the middle passage 24 of the heat exchanger 22, and conduit 29 to the generator. The level of liquid in the absorber vessel 14 is below the lower end of the column of liquid in the descending leg of conduit 29 is sufficient to balance the rising column of gas and liquid in the rising leg of conduit 29 to the upper part of the generator. The level of liquid in the standpipe 42 is substantially the same as the level of liquid in the absorber vessel 14. The upper end of conduit 44 is open above this level of liquid in standpipe 42.

Vapors flow from the generator 10 through conduit 45, the inner passage 23 of the heat exchanger 22, conduit 44, the upper part of standpipe 42, and conduit 26 to the condenser 18. In the triple heat exchanger 22, heat is transferred from the weak solution in the outside passage 25 and the vapors in the inner passage 23 flowing counter-current to the cooler rich solution flowing in the middle passage 24. The inner passage 23 of the heat exchanger, and conduit 44 are made small in internal diameter so that water formed by condensation of water vapor in the heat exchanger 22, as previously described, will be swept along by the vapor and caused to flow upward in conduit 44 into the upper part of the standpipe 42. In the upper part of standpipe 42 the condensate is separated from the vapor and descends into the rich solution standing in the lower part of the standpipe 42, so that the condensate is thereby returned into the liquid circuit.

Other changes and modifications may be made within the scope of the invention which is not limited except as indicated in the following claims.

What is claimed is:

1. A method of refrigeration which includes expelling refrigerant from absorption liquid at a place of heating, liquefying the expelled refrigerant, evaporating the liquefied refrigerant, absorbing the evaporated refrigerant into absorption liquid, flowing vapors from said place of heating and liquid to said place of heating in heat transfer relation out of physical contact at a place of heat exchange to cause rectification by condensation of vaporous absorption liquid and conservation of latent heat of rectification by return thereof in the liquid to said place of heating, and utilizing said vapors flowing from the place of heating to cause the condensate to rise above said place of heat exchange in a path of flow returning to said place of heating for conservation of the sensible heat in the condensate.

2. A refrigeration system containing refrigerant and a liquid absorbent for the refrigerant and having a place of heating for causing expulsion of refrigerant from absorption liquid, a place of heat exchange, means to conduct vapors from said place of heating and liquid to said place of heating in heat transfer relation out of physical contact at said place of heat exchange to cause rectification by condensation of vaporous absorption liquid and conservation of the latent heat of rectification by return thereof in the liquid to said place of heating, and means utilizing flow of said vapors from the place of heating to cause the condensate to rise above said place of heat exchange for return to said place of heating to conserve the sensible heat in the condensate.

3. A refrigeration system as set forth in claim 2 which also has means to conduct liquid from said place of heating in thermal exchange relation at said place of heat exchange with liquid flowing to said place of heating.

4. A refrigeration system as set forth in claim 2 which also has means to conduct liquid from said place of heating in heat transfer relation at said place of heat exchange with liquid flowing to said place of heating, and vapor lift means for effecting the flow of liquid.

5. An absorption refrigeration system having a circuit for absorption liquid including a generator, an absorber, and a triple heat exchanger, said exchanger being connected to conduct vapors and liquid from the generator and liquid flowing to the generator in heat transfer relation out of physical contact with each other, means for caus-

ing flow of liquid in said circuit, and means utilizing flow of vapor through said heat exchanger for causing condensate formed in the vapor portion of the heat exchanger to be raised for return flow to said generator.

6. Absorption refrigeration apparatus as set forth in claim 5 in which said means for causing flow of liquid in said circuit is a vapor liquid lift.

7. An absorption refrigeration system having a circuit for absorption liquid including a generator, an absorber, and a triple heat exchanger, said exchanger being connected to conduct vapors and liquid from the generator and liquid flowing to the generator in heat transfer relation out of physical contact with each other, said exchanger also being located at a level below the surface levels of liquid in both said generator and said absorber, and means for creating a third surface level of liquid in said circuit below said heat exchanger to permit drainage of condensate from the vapor portion of said heat exchanger into said liquid circuit.

8. An absorption refrigeration system as set forth in claim 7 in which vapors conducted from the generator to the heat exchanger pass in physical contact with absorption liquid flowing from said heat exchanger to said generator.

9. An absorption refrigeration system as set forth in claim 7 in which vapors flowing from said generator to said heat exchanger bubble through absorption liquid below said third surface level.

HARRY K. BERGHOLM,

[fol. 140]

Friday, April 7th, A. D., 1944.

Before Honorable Justin Miller, Henry W. Edgerton, and
Thurman Arnold, Associate Justices.

No. 8602, April Term, 1944

THE HOOVER COMPANY, Appellant,

vs.

CONWAY P. COE, Commissioner of Patents, Appellee

Argument commenced by Mr. Richard R. Fitzsimmons, attorney for appellant, continued by Messrs. William D. Sellers, attorney for appellant, and R. F. Whitehead, attorney for appellee, and concluded by Mr. William D. Sellers, attorney for appellant. The Court requested each side to file as soon as possible and not later than fifteen days, a memorandum on the question has the Court under Section 4915 the power to hand down a decree which does not determine the right of an applicant to receive a patent but which only determines that claims which may subsequently be held to be unpatentable by the Patent Office are supported by the application.

[fol. 141] [Stamp:] United States Court of Appeals for the
District of Columbia: Filed Jul. 10, 1944. Joseph W.
Stewart, Clerk

UNITED STATES COURT OF APPEALS, DISTRICT OF COLUMBIA

No. 8602

THE HOOVER COMPANY, Appellant,

v.

CONWAY P. COE, Commissioner of Patents, Appellee

Appeal from the District Court of the United States for the
District of Columbia

Argued April 7, 1944. Decided July 10, 1944.

Messrs. Richard R. Fitzsimmons and William W. Sellers,
with whom Mr. William S. Hodges was on the brief, for
appellant.

Mr. R. F. Whitehead, with whom *Mr. W. W. Cochran*, Solicitor, United States Patent Office, was on the brief, for appellee.

Before Miller, Edgerton and Arnold, Associate Justices

ARNOLD, Associate Justice:

Both parties to this suit claim that the sole issue involved is whether the patent claims set out in the complaint are supported by plaintiff's application. One of these claims has been copied from another patent. Others are substantially the same as the claims in the second patent, yet all of them were formulated for the express purpose of provoking interference proceedings in the Patent Office. All were rejected on the sole ground that they did not rest on the disclosure of plaintiff's application. In substance this meant that the Patent Office did not consider the patent with which plaintiff hoped to provoke an interference sufficiently similar to the patent from which the claims were copied to justify interference proceedings.

Counsel for both parties admit that if plaintiff's claims are allowed the court will be unable to declare that plaintiff is entitled to a patent because the record does not show whether plaintiff made the prior discovery. The only result will be to overrule the administrative decision that interference proceedings are not justified. The case will then be sent back to the Patent Office to determine priority. The complaint itself does not ask the court to adjudge that plaintiff is entitled to a patent. The only relief requested is a decree directing the Commissioner of Patents to find the claims are readable on plaintiff's disclosure and allowable to him provided that he later is determined to have priority. [fol. 142] On its own motion this court raised the question whether Section 4915 R. S. confers jurisdiction on the District Court to enter a decree which does not determine the right of the applicant to receive a patent but which instead directs the examiner to allow claims for the purpose of provoking subsequent interference proceedings. Both parties submitted memoranda of authority supporting the jurisdiction of the District Court in the above situation.

In the absence of controlling decisions it would seem clear from the statute that the District Court had no jurisdiction over this suit. The language of Section 4915 R. S. gives the court authority to adjudge that an applicant is entitled

according to law to receive a patent for his invention as specified in his claim, or any part thereof, as the facts in the case may appear. Such an adjudication cannot be made in this case. Before plaintiff here is entitled to a patent it must establish priority over the patent from which the claims are copied. Such priority cannot be determined here for two reasons: (1) The party against whom the plaintiff claims priority is not before the court; (2) There has been no decision of priority by the Board of Interference Examiners. The statute clearly indicates that the issue of priority can be heard in a suit in equity only when a patent has been refused by the Board of Appeals of the Patent Office or when the plaintiff is dissatisfied with a decision of the Board of Interference Examiners.

In substance, this case is not a suit on the merits but an appeal from the refusal of the Patent Office to take preliminary steps which would lead to interference proceedings. Sections 4911 and 4914 R. S. give the United States Court of Customs and Patent Appeals jurisdiction to correct an administrative ruling of the Patent Office for error appearing on the Patent Office record. Nothing in Section 4915 R. S. indicates that a suit in equity tried on new evidence is a duplicate method of reviewing an administrative ruling in a case where the plaintiff's right to a patent cannot be determined. Furthermore, considerations of sensible and orderly procedure are against this construction. The idea that a court of equity should interfere with the proceedings of an administrative tribunal by a trial de novo at a stage when no decision on the merits can be given is contrary to the fundamental concept of equity jurisdiction.

Turning now to the cases we find an explicit ruling by the Supreme Court that a proceeding under Section 4915 R. S. cannot select a single issue which affects plaintiff's right to a patent, without determining all the other issues on which that right depends. The Court said:

"The provision of section 4915 is that the circuit court may adjudge that the applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim, or for any part thereof, as the facts in the case may appear; and that if the adjudication is in favor of the right of the applicant, it shall authorize the commissioner to issue the patent. It necessarily follows that no adjudication can be made

in favor of the applicant, unless the alleged invention for which a patent is sought is a patentable invention. The litigation between the parties on this bill cannot be concluded by solely determining an issue as to which [fol. 143] of them in fact first made a cabinet creamery. A determination of that issue alone, in favor of the applicant, carrying with it, as it does, authority to the commissioner to issue a patent to him for the claims in interference, would necessarily give the sanction of the court to the patentability of the invention involved." (Italics added.)¹

Our own decision in *Radtke Patents Corporation v. Coe*² is to the same effect.

In the case before us we cannot determine plaintiff's right to a patent because it involves deciding that he is prior in time to another applicant who is not a party to the suit. Since the court cannot decide the whole controversy on its merits we have no jurisdiction over the intermediate proceedings in the Patent Office.³

¹ *Hill v. Wooster*, 132 U. S. 693, 698 (1890). —

² 74 App. D. C. 251, 122 F. (2d) 937 (1941). In *Butterworth v. United States ex rel. Hoe*, 112 U. S. 50, 61 (1884), it was indicated that the record in a suit under Section 4915 R. S. should include the whole merits of the applicant's right to a patent. The court said: "It is thereby provided (referring to R. S. 4915) that the applicant may have remedy by bill in equity. This means a proceeding in a court of the United States having original equity jurisdiction under the patent laws, according to the ordinary course of equity practice and procedure. It is not a technical appeal from the Patent Office, like that authorized in Section 4911, confined to the case as made in the record of that office, but it is prepared and heard upon all competent evidence adduced and upon the whole merits. Such has been the uniform and correct practice in the circuit courts. *Whipple v. Mimer*, 15 Fed. Rep. 117; *ex parte Squire*, 3 Ban. and A., 133; *Butler v. Shaw*, 21 Fed. Rep. 321." (Parenthetical matter and italics added.)

³ Cf. *Synthetic Plastics Co. v. Ellis-Foster Co.*, 78 F. (2d) 847 (C. C. A. 3rd, 1935); *Cherry-Burrell Corp. v. Coe*, No. 8487 (decided June 19, 1944).

The notion that an equity suit under Section 4915 R. S. gave jurisdiction to authorize the issuance of a patent to a party where the issue of priority could not be determined stems from the case of *Pitman v. Coe*. In that case the Commissioner moved to dismiss a proceeding under Section 4915 R. S. because the denial of plaintiff's claim by the Patent Office was based on improper joinder of claims in one application. The Commissioner argued that, since patentability was yet to be determined, the order refusing the claims was interlocutory and not final. No question of priority was involved and all the necessary parties were before the court. The court declared that the refusal of a patent claim based on an order of division could be reviewed by a suit in equity. The prayer of the complaint asked for the issuance of a patent and not for a limited review of the order of division by itself. It is, therefore, not clear from the decision whether the court thought that the District Court had authority to review the single question of division and send the case back to the Patent Office for determination of patentability or whether it considered the trial court had the power to conduct an original hearing on patentability. If the decision be construed as holding that the issue of patentability need not be decided in a Section 4915 R. S. proceeding it is inconsistent with the Supreme Court's ruling in *Hill v. Wooster* and has been overruled by our decision in *Radtke Patents Corp. v. Coe*. If it be construed as authorizing the District Court to decide the question of patentability before the Patent Office has determined that issue, it sets forth a highly questionable doctrine which [fol. 144] in effect transfers to the court the duty of the Patent Commissioner⁵ to make an original expert investigation of the prior art. But even if we followed the dubious course of allowing the District Court to make an original investigation of priority before the Patent Office acted, there would be no jurisdiction here because the holder of the interfering application or patent would be an indispensable party.⁶

⁴ 62 App. D. C. 365, 68 F. (2d) 412 (1933).

⁵ Section 4904 R. S.

⁶ *Hazeltine Corp. v. White*, 68 F. (2d) 715 (C. C. A. 2d, 1934).—That case was a suit by a losing party in a multiple interference proceeding, brought against the successful interferent. It was held that the other losing interferents

Appellant asserts that this court has tacitly approved administrative review of Patent Office rulings under Section 4915 R. S. in cases where the record showed that the claims involved were copied from other patents or applications to provoke interference proceedings. It cites the cases of *International Cellulotton Products Co. v. Coc*⁷ and *American Cyanamid Co. v. Coc*.⁸ Those cases involved the refusal to grant claims copied from another patent. Nevertheless, the mandate directed the Patent Office to issue a patent to the plaintiff. The Patent Office was unable to comply because priority had not been determined. The mandate was, therefore, ignored and interference proceedings were instituted after our decision. The question of jurisdiction was not raised by the Patent Office or considered by this court. Our attention was not called to the fact that the mandate in favor of plaintiff's right to a patent could not be carried out. Instead of supporting jurisdiction the unforeseen results of these cases illustrate the inappropriateness of an independent suit in equity to determine the correctness of an intermediate ruling in the Patent Office.

were indispensable parties to a suit under Section 4915 R. S. The court said, at page 717: "Only in the sense that a decree in this suit would be futile to establish the right of any one to a patent, on the assumption that the Commissioner would not be authorized to issue it, can it be said that a decree can be made which does not affect the interests of the absent adverse parties, . . . A decree which did authorize the Commissioner to issue the patent would ignore the right of the absent adverse parties to be heard, and leave the controversy in such a condition that its final determination might be contrary to fundamental principles of equity and good conscience."

If, as the statute requires, this court were to issue a decree adjudging that the plaintiff is entitled to the claims in issue, it would likewise "ignore the right of the absent adverse parties to be heard". That the rival claimant is an adverse party and that the issue of readability may be the most crucial one in his case is illustrated by *Smith v. Carter Carburetor Corp.*, 130 F. (2d) 555 (C. C. A. 3rd, 1942).

⁷ 66 App. D. C. 248, 85 F. (2d) 869 (1936).

⁸ 70 App. D. C. 330, 106 F. (2d) 851 (1939).

They present a procedure in which a court of equity makes a declaratory judgment on a record which compels the Patent Office to ignore the terms of that judgment.

Doubtless the failure of this court to notice the lack of jurisdiction in the cases above referred to was due to the artificial form in which they were presented. Theoretically each patent claim is a distinct invention. Therefore, the refusal of any single claim appears in the pleadings under Section 4915 R. S. as the refusal of a patent on a distinct invention. Actually, however, in applications containing multiple claims the claims often do not represent distinct inventions but only different ways of describing a single invention. This is particularly true when claims are copied [fol. 145] to be used as counts in an interference. The purpose of such copied claims is not to claim distinct inventions but to compare similar single inventions detail by detail. This method of limiting or enlarging the scope of a single invention through the device of multiple claims should be recognized for what it is,—an administrative method by which the Patent Office clarifies the issues in an interference proceeding. The fact that the Patent Office uses an artificial conception of the phrase "distinct invention" should not be made a vehicle to enlarge the jurisdiction of this court to include appeals which may properly be taken only to the United States Court of Customs and Patent Appeals.

For these reasons the judgment of the court below dismissing the complaint will be

Affirmed.

[fol. 146] [Stamp:] United States Court of Appeals for the District of Columbia. Filed Jul. 10, 1944. Joseph W. Stewart, Clerk

UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA, APRIL TERM, 1944

No. 8602

THE HOOVER COMPANY, Appellant,

vs.

CONWAY P. COE, Commissioner of Patents, Appellee

Appeal from the District Court of the United States for the District of Columbia

JUDGMENT

This cause came on to be heard on the transcript of the record from the District Court of the United States for the District of Columbia, and was argued by counsel.

On consideration whereof, It is now here ordered and adjudged by this Court that the judgment of the said District Court appealed from in this cause be, and the same is hereby, affirmed.

Per Mr. Justice Arnold.

Dated July 10, 1944.

[fol. 147-148] [Stamp:] United States Court of Appeals for the District of Columbia. Filed Jul. 26, 1944. Joseph W. Stewart, Clerk

UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA

No. 8602

THE HOOVER COMPANY, Appellant,

v.

CONWAY P. COE, Commissioner of Patents, Appellee

DESIGNATION OF RECORD

The Clerk will please prepare a certified transcript of record for use on petition to the Supreme Court of the

United States for writ of certiorari in the above-entitled cause, and include therein the following:

1. Appendix to appellant's brief. Appendices to briefs of the parties.
2. Minute entry of argument.
3. Opinion.
4. Judgment.
5. * [Minute entry of denial of petition for rehearing.]
6. This designation.
7. Clerk's certificate.

Richard R. Fitzsimmons, W. D. Sellérs, Attorneys
for Appellant.

Wm. S. Hodges, of Counsel.

Service of a copy of the above Designation of Record acknowledged this 26th day of July, 1944.

W. W. Cochran, of Counsel for Appellee.

* Matter inclosed in brackets, struck out in copy.

[Vol. 149] SUPREME COURT OF THE UNITED STATES

ORDER ALLOWING CERTIORARI—Filed November 6, 1944

The petition herein for a writ of certiorari to the United States Court of Appeals for the District of Columbia is granted.

And it is further ordered that the duly certified copy of the transcript of the proceedings below which accompanied the petition shall be treated as though filed in response to such writ.

(5567)

FILE COPY

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SEP 20 1944

CHARLES ELMORE GOSLEY
CLERK

IN THE

Supreme Court of The United States

October Term, 1944.

No. 486

THE HOOVER COMPANY,

Petitioner,

vs.

CONWAY P. COE, Commissioner of Patents,

Respondent.

**PETITION FOR A WRIT OF CERTIORARI TO THE
UNITED STATES COURT OF APPEALS FOR THE
DISTRICT OF COLUMBIA.**

WILLIAM D. SELLERS,

RICHARD R. FITZSIMMONS,

Attorneys for Petitioner.

WILLIAM S. HODGES,

Of Counsel.

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IN THE

Supreme Court of The United States

October Term, 1944.

No.

THE HOOVER COMPANY,

Petitioner,

vs.

CONWAY P. COE, Commissioner of Patents,

Respondent.

**PETITION FOR A WRIT OF CERTIORARI TO THE
UNITED STATES COURT OF APPEALS FOR THE
DISTRICT OF COLUMBIA.**

*To the Hon. The Chief Justice and Associate Justices of
the Supreme Court of the United States:*

Your Petitioner, The Hoover Company, by its undersigned attorneys, respectfully prays that a writ of certiorari issue to the United States Court of Appeals for the District of Columbia to review the judgment of that Court entered in the above cause on July 10, 1944, affirming the dismissal of petitioner's bill of complaint.

A transcript of the record including the proceedings in the said United States Court of Appeals for the District of Columbia is furnished herewith in accordance with Rule 38 in this Court.

Short and Summary Statement of the Matter Involved.

On January 10, 1941, Curtis C. Coons, petitioner's assignor, filed an application for reissue patent in the United States Patent Office of his original patent 2,178,870 which had been granted November 7, 1939, upon an original application filed August 8, 1936. The invention of the application comprises a refrigeration system.

The Examiner in the Patent Office finally rejected Claims 15, 16, 38 and 39 (R. 115), stating that the claims were "rejected as not reading on applicant's disclosure and this rejection is Made Final." Upon appeal the Board of Appeals of the United States Patent Office affirmed the Examiner's decision (R. 131).

Claims 16, 38 and 39, which were finally rejected by the Examiner, originated in the Coons' reissue application. Claim 15 was copied from the patent to Bergholm 2,201,362 (R. 134) for purposes of interference to determine priority of invention.

The Bergholm patent 2,201,362 (R. 134) was filed in the United States Patent Office on November 20, 1937, and issued as a patent on May 21, 1940, being assigned to Servel, Inc., a corporation of Delaware. Bergholm's earliest date in the record is over one year later than petitioner's.

Petitioner filed its complaint (R. 3) in the United States District Court for the District of Columbia under the provisions of Revised Statutes 4915, U. S. C., Title 35, Section 63 (Appendix, p. 3), praying for the relief pro-

vided by Section 4915, R. S. The District Court in a decree (R. 14) dated June 21, 1943, dismissed the complaint, the decision being based upon the merits of petitioner's case. The only question considered by the District Court was the question of whether or not the claims were readable upon the Coons application construction.

Appeal (R. 15) was taken from the decision of the District Court for the District of Columbia to the Court of Appeals for the District of Columbia which, in a decision (R. 140) dated July 10, 1944, affirmed the judgment of the lower Court without touching the merits, the decision being based solely upon the grounds that "the District Court had no jurisdiction over this suit."

Questions Presented.

The decision of the Court of Appeals for the District of Columbia raises three questions of law:

Question 1.

Does Section 4915 R. S. (U. S. C., Title 35, Sec. 63) convey jurisdiction upon the District Court for the District of Columbia of an action begun by bill in equity by an applicant who has been refused a patent by the Board of Appeals where, if the Court holds for the applicant, further prosecution in the Patent Office may take place in "complying with the requirements of law"? (R. S. 4915 at Appendix, p. 3.)

Question 2:

In Section 4915 R. S. (U. S. C., Title 35, Sec. 63), which provides "Whenever a patent on application is refused by the Board of Appeals or whenever any applicant is dissatisfied with the decision of the board of interference ex-

4/

aminers, the applicant * * * may have remedy by bill in equity * * *," does the word "or" mean "and," whereby action by both boards must precede applicant's right to the remedy provided?

Question 3.

In an action brought by an applicant for a patent under Section 4915 R. S. (U. S. C., Title 35, Sec. 63) against the Commissioner of Patents as defendant, and following a refusal by the Board of Appeals to grant the patent, is a third party claiming the same invention a necessary party when not involved in interference with the applicant to determine priority of invention but where an interference may be set up by the Patent Office if the Court holds for the applicant?

Reasons Relied Upon for the Allowance of the Writ of Certiorari.

The discretionary power of the Court is invoked upon the following grounds:

- 1. The Questions of Law Presented Depend Upon the Construction of a United States Statute and Are of Great Public Importance.**

The United States Court of Appeals for the District of Columbia in denying the jurisdiction of the District Court has raised several questions of general importance relating to the construction of a Statute of the United States (Revised Statute, Section 4915, as amended by Act of August 5, 1939) (Appendix, page 3). That statute provides for an action by bill in equity whenever a patent is refused by the Board of Appeals of the Patent Office.

The questions potentially affect the right of every applicant for a patent to the relief provided by law from an unjust refusal of a patent in the Patent Office. The facts of the present case are on all fours with the facts mentioned in Footnote (1) of the *Minnesota Mining* case, F. (2d), 62 U. S. P. Q. 119, decided the same day by the same Court and in which the Court said, " * * * It is not clear that the doctrine of *Hoover v. Coe* (No. 8602), decided this day, applies. * * * "

The Rules of Practice in the United States Patent Office are inconsistent with the requirements of the lower Court and make impossible the prerequisites to its jurisdiction which it demands. The statutory duty placed upon the Commissioner of Patents in Section 4904 R. S. also make it impossible for the required prerequisite to be present.

2. The Questions of Law Presented Have Not Been But Should Be Decided by this Court.

The questions of law presented have not been considered by this Court for the decision of the Court of Appeals for the District of Columbia represents a departure from established practice as set forth by that Court in *Pittman v. Coe* (68 F. (2d) 412, 19 U. S. P. Q. 307). For the first time an applicant for a patent is denied the relief provided by Section 4915, R. S., because of what the Patent Office may subsequently do should the applicant prove himself entitled to a favorable decision. The decision is inconsistent with this Court's views as expressed in *Gandy v. Marble* (122 U. S. 432). The decision is in direct conflict with the same Court's decision upon the question of jurisdiction in *Thorne, Neale & Co. v. Coe* (143 F. (2d) 155, 62 U. S. P. Q. 22), decided after the present case was argued and 28 days prior to decision in this case.

As the Commissioner of Patents has his official residence in the District of Columbia, and as today all suits of an *ex parte* nature in which he is named as the sole party defendant are necessarily brought in the District of Columbia, it is entirely unlikely that these questions will be raised in cases arising in other jurisdictions (*Butterworth v. Hill*, 114 U. S. 128). However, under a discarded practice in which in such cases the Commissioner of Patents accepted service in jurisdictions other than the District of Columbia the Circuit Court of Appeals for the Second Circuit in *Gold v. Newton* (254 F. 824) followed a contrary practice, the question of jurisdiction being in issue.

The law of this case has been cited as controlling by the Court of Appeals for the District of Columbia in later decided cases, (*The Colgate-Palmolive-Peet Co. v. Coc*, 125 App. D. C.; 62 U. S. P. Q. 121, *Line Material Co. v. Coc*, 125 App. D. C.; 62 U. S. P. Q. 120).

3. The Court of Appeals Has Not Given Proper Effect to Applicable Decisions of this Court.

The Court below denied that 4915 R. S. (Appendix, p. 3) was a proper method "of reviewing an administrative ruling in a case where plaintiff's right to a patent cannot be determined" (R. 142).

This Court in *Steinmetz v. Allen*, 192 U. S. 543, held that the requirement of "division" made by the Examiner without action upon all the merits of Steinmetz's case was "final and appealable."

This Court in *Frash v. Moore*, 211 U. S. 1, recognized the right of an applicant to bring a bill in equity under Section 4915 R. S. where the refusal of the patent was based upon a requirement for division, with which the applicant refused to comply.

4. The Judgment and Opinion of the Court of Appeals May Seriously Hinder and Confuse the Future Administration of the Law by the Patent Office, Particularly With Respect to Revised Statute 4904.

This reason is believed alone to be adequate to support the granting of the petition (*Federal Trade Com. v. Amer. Tobacco*, 274 U. S. 543, 47 S. Ct. 663).

Section 4904, Revised Statutes, as amended by Act of August 5, 1939 (Appendix, p. 2), provides that the Commissioner of Patents shall direct the setting up of an interference "to determine the question of priority of invention whenever an application is made for a patent which, in the opinion of the Commissioner would interfere with any pending application, or with an unexpired patent." The setting up of the interference is, as noted, made dependent upon the "opinion of the Commissioner" and is not mandatory.

In conformance with Section 4904 (Appendix, p. 2), Revised Statutes, Rule 94 (Appendix, p. 6) of the Patent Office provides for interferences when the claims which recite the common invention "are allowable in the application of each party," or when a patent and an application are involved when the claims "are allowable in all the applications involved."

The decision of the Court of Appeals requires, in order for an applicant for a patent to be entitled to the relief provided by Revised Statutes, Section 4915 (Appendix, p. 3), that the Commissioner set up an interference even though he is of the opinion that the claimed subject matter is not allowable in all the applications.

If the Commissioner is not to deprive applicants for patents of their rights as provided by Revised Statutes, Section 4915, then he must, under the decision of the Court below, set up interferences when in his opinion none prop-

erly should be contested. The function is administrative and properly lies entirely within the Commissioner's discretion.

WHEREFORE your Petitioner respectfully prays that a Writ of Certiorari be issued out of and under the seal of this Court directed to the United States Court of Appeals for the District of Columbia, commanding the said Court to certify and send to this Court on a day designated a full and complete transcript of the record and all proceedings in the Court of Appeals had in this cause, to the end that this case may be reviewed and determined by this court; that the judgment of the said Court of Appeals be reversed; and that said Petitioner be granted such other and further relief as may be deemed proper.

THE HOOVER COMPANY,

Petitioner.

By RICHARD R. FITZSIMMONS,

WILLIAM D. SELLERS,

Attorneys for Petitioner.

WILLIAM S. HODGES,

Of Counsel.

We hereby certify that we have read the foregoing petition for Certiorari, and that in our opinion it is well founded and presents grounds whereon the prayer ought to be granted; and we further certify that it is not intended for purposes of delay.

WILLIAM D. SELLERS,

RICHARD R. FITZSIMMONS,

Attorneys for Petitioner.

WILLIAM S. HODGES,

Of Counsel.

IN THE

Supreme Court of The United States

October Term, 1944

THE HOOVER COMPANY,**vs.****CONWAY P. COE, Commissioner of Patents,**

**BRIEF IN SUPPORT OF PETITION FOR WRIT OF
CERTIORARI.**

The Opinion of the Court Below.

The opinion of the Court of Appeals for the District of Columbia is reported at 125 App. D. C., F. (2d), 62 U. S. P. Q. 115, and appears herewith in the record filed herewith (R. 140).

The District Court did not enter an opinion, but its findings of fact and conclusions of law appear in the record (R. 10).

Jurisdiction.

The grounds on which the jurisdiction of this Court is invoked follow:

- (1) The statute under which jurisdiction is invoked is Section 240 (a) of the Judicial Code, 28 U. S. C. 347, as amended by the Act of February 13, 1925.

(2) The judgment of the United States Court of Appeals for the District of Columbia was entered on July 10, 1944.

(3) The foregoing judgment was entered on appeal from a judgment by the District Court for the District of Columbia in a suit in equity brought under the Revised Statutes, Section 4915, 35 U. S. C. 63, as amended by Act of August 5, 1939, to have remedy from the refusal of the Board of Appeals of the Patent Office to grant a patent to Petitioner as assignee of reissue patent application Serial No. 373,970, filed by Curtis C. Coons.

(4) Some of the previous decisions of this Court which are believed to sustain jurisdiction in this case are:

Butterworth v. Hill, 114 U. S. 128.

Gandy v. Marble, 122 U. S. 432.

Morgan v. Daniels, 153 U. S. 120.

Steinmetz v. Allen, 192 U. S. 543.

American Steel Foundries v. Robertson, 262 U. S. 209.

Statement of the Case.

The facts are set forth in the Petition.

Specification of Errors.

The errors which the petitioner will urge, if the Writ of Certiorari is issued, are that the Court of Appeals for the District of Columbia erred:

1. In affirming the dismissal of Petitioner's Bill of Complaint and upon the grounds that the District Court had no jurisdiction under the provisions of Section 4915, R. S.

2. In holding, contrary to past practice, that Petitioner was not entitled to relief under the provisions of Section

4915, R. S. after having been refused a patent by the Board of Appeals and because he had not established priority of invention over another claiming the same invention, the Patent Office having refused to set up an interference to determine the question of priority after having been requested to do so by Petitioner and in conformance with its long-established practice.

3. In holding, contrary to past practice, that Petitioner is not entitled to relief under Section 4915, R. S. because a third party, who was not an adverse party to Petitioner in the Patent Office, was not made a party defendant to the action in addition to the Commissioner of Patents, there having been a refusal to grant the patent to Petitioner by the Board of Appeals of the Patent Office but no interference or decision by the board of interference examiners.

4. In refusing to decide the case upon its merits and instead dismissing upon the grounds of lack of jurisdiction.

Summary of Argument.

1. Section 4915 R. S. conveys jurisdiction upon the District Court for the District of Columbia of an action begun by bill in equity by an applicant who has been refused a patent by the Board of Appeals and the fact that further prosecution may take place in the Patent Office in "complying with the requirements of law," should the Court hold for the applicant, does not deprive the Court of its jurisdiction.

2. The question of the District Court's jurisdiction depends upon the construction of Section 4915 R. S. and is of great public importance.

3. This Court has not ruled upon the question of the District Court's jurisdiction of an action brought under Section 4915, R. S. in a case in which, following a decision favorable to the complainant, further prosecution might

take place in the Patent Office, and the decision of the Court of Appeals for the District of Columbia has not given proper effect to the applicable decisions of this Court.

4. The judgment and opinion of the Court of Appeals holding that the Court has no jurisdiction of an action brought under Section 4915, R. S. may seriously hinder and confuse the administration of the law in the Patent Office, particularly with respect to Section 4904, R. S. (Appendix, p. 2).

5. The provision in Section 4915 R. S. of a "remedy by bill in equity" . . . "Whenever a patent on application is refused by the Board of Appeals or whenever any applicant is dissatisfied with the decision of the Board of interference examiners," provides for remedies under two separate conditions.

6. In an *ex parte* action brought under Section 4915 R. S. by an applicant after refusal of a patent by the Board of Appeals, a third party claiming the same invention is not a necessary party where no interference between applicant and the third party was instituted by the Patent Office.

ARGUMENT.

1. **Section 4915 R. S. (Appendix, p. 3) Conveys Jurisdiction Upon the District Court for the District of Columbia of an Action Begun by Bill in Equity by an Applicant Who Has Been Refused a Patent by the Board of Appeals and the Fact that Further Prosecution May Take Place in the Patent Office in "Complying With the Requirements of Law" Should the Court Hold for the Applicant Does Not Deprive the Court of Its Jurisdiction.**

Section 4915 R. S. has been in existence since 1836. It clearly gives an applicant the right to seek relief from the refusal of a patent by the Patent Office Board of Appeals.

by filing a bill in equity. (*Bakelite Corp. v. Nat'l Aniline & Chem. Co.*, 83 F. (2d) 176.)

Petitioner was refused a patent containing Claims 15, 16, 38 and 39 and was entitled to bring an action in the District Court for the District of Columbia against the Commissioner of Patents. The Court of Appeals below was of the opinion that the present case was not covered by the statute even though it fell within the precise wording thereof because of certain facts which appeared in the record of the case but which facts might be true in any case ever brought under the statute. These facts were that the record showed that further prosecution might be necessary in the Patent Office should the Court's decision be in favor of the applicant.

The statute itself provides that after a favorable decision in the action brought under Sec. 4915 R. S. an applicant is only entitled to a patent upon "filing in the Patent Office a copy of the adjudication and otherwise complying with the requirements of law." The provision "otherwise complying with the requirements of law" clearly envisages the duty residing on the applicant of successfully overcoming any legal barrier raised by the Commissioner to the grant of a patent as "authorized" after the return of the application to the Patent Office; and the Courts have so stated.

In *Gandy v. Marble*, 122 U. S. 432, 1887, this Court said:

"* * * the Commissioner is not authorized to issue the patent unless the applicant otherwise complies with the law."

In *Philadelphia Storage Battery Co. v. Zenith Radio Corp.*, C. C. A. 7th, 117 F. (2d) 642, 645, the Court said:

"We do not understand that Section 4915 of the Revised Statutes contemplates that the Court shall direct the Commissioner to issue a patent. This must

be true because there are other matters which the department must decide favorably to Jacke's assignee before a patent can issue to it. The statute which authorizes the issuance of patents must be complied with in every respect, and we have no power under Section 4915 to restrict those requirements."

It is the usual practice in the Patent Office to consider the "other requirements of the law" when a case is returned to the Patent Office after a favorable decree under Section 4915, R. S. Examples of this practice are: *Gold v. Newton*, 254 F. 824; *Radtke Patents Corp. v. Coc*, 74 App. D. C. 251; 122 F. (2d) 937. *Tully v. Robertson*, 19 F. (2d) 954. Rule 96, Rules of Practice of the Patent Office (Appendix, p. 7), states:

"After judgment of priority the application of any party may be held for revision and restriction, subject to interference with other applications."

The same is true after a case is allowed *ex parte*. The above rule applies whether the judgment is by the examiner or the Court under Section 4915 R. S. Subsequent Patent Office prosecution could comprise a previously anticipated or new discovered interference as provided in Section 4904 R. S. (Appendix, p. 2). That subsequent interferences do occur is evidenced by the facts of many cases, see *Gold v. Newton*, 254 F. 824; *Radtke Patent Corp. v. Coc*, 122 F. (2d) 937. Subsequent Patent Office prosecution might also comprise action for the first time upon the merits of an invention, as in a case in which the Board of Appeals refused a patent upon the sole grounds that the applicant could not claim the invention at all, as in *Frash v. Moore*, 211 U. S. 1, and *Steinmetz v. Allen*, 192 U. S. 543, *Pitman v. Coc*, 68 F. (2d) 412.

If the Patent Office prosecution of an application must be complete in order properly to bring an action under

Section 4915 R. S. then a great number of actions which have been brought under Section 4915 R. S. where the grounds of rejection was one of estoppel, and where further Patent Office prosecution would clearly be necessary, have been heard by the District Courts in error. Examples are: *International Cellucotton Products Co. v. Coe*, 85 F. (2d) 869, App. D. C. 1936, *De Pont v. Coe*, 89 F. (2d) 679, App. D. C. 1937, *American Cyanamid v. Coe*, 106 F. (2d) 851, App. D. C. 1939, *American Viscose Corp. v. Coe*, 106 F. (2d) 849, App. D. C. 1939, *Power Patents Co. v. Coe*, 110 F. (2d) 550, App. D. C. 1940, *Bendix Aviation Corp. v. Coe*, 61 U. S. P. Q. 78, D. C. D. C. 1943, *Bates et al. v. Coe*, 40 U. S. P. Q. 220, D. C. D. C., *Tinnerman Products v. Coe*, 50 F. S. 337, D. C. D. C., *Gyro Process Co. v. Coe*, 107 F. (2d) 195, 42 U. S. P. Q. 413. It is to be presumed that the Courts in these cases assumed the duty which was theirs of determining their own jurisdiction. *Minnesota v. Hitchcock*, 185 U. S. 373, *Reid v. U. S.*, 211 U. S. 529.

That a decision not going to the merits but instead requiring an applicant to divide his application and claim part of his invention in separate applications is "final and appealable" was determined by this Court in *Steinmetz v. Allen*, 192 U. S. 543. The Court there said:

"True, a distinction can be made between his ruling and one on the merits, if we regard the merits to mean invention, novelty or the like. But in what situation would an applicant for a patent be? If he yields to the rule he gives up his right of joinder. If he does not yield he will not be heard at all, and may subsequently be regarded as having abandoned his application. (Sec. 4894 Rev. Stats.) A ruling having such effect must be considered as final and appealable."

In the *Steinmetz* case Steinmetz was seeking a writ of mandamus to compel the Commissioner to forward his appeal from the requirement of division to the Examiners-in-

Chief (now Board of Appeals). This Court's decision was that the Examiner's holding was "final." Clearly an affirmation of the Examiner by the Board of Appeals upon appeal would render the decision no less "final."

Revised Statute 4915 (Appendix, p. 3) provides a remedy by bill in equity when a "patent or application is refused" by the Board of Appeals. No limitation is provided as to the grounds of the Board's refusal. Clearly in the performance of its judicial function (*Butterworth v. Hoe*, 112 U. S. 50, U. S. ex rel. *Bernardin v. Duell*, 172 U. S. 576) the Board can base its decision upon any ground it sees fit, as can a Court in making a decision. The decision is final so far as the applicant is concerned for he is deprived of his patent. It is no less final, from his aspect, merely because subsequent prosecution may be necessary should the decision be reversed. The decision of the lower Court adding limitations as to the grounds upon which the "patent or application is refused" and still bring the refusal within the statute must be considered judicial legislation.

The refusal of a patent upon one ground has the same final effect as the refusal upon another ground and Section 4915 R. S. does not distinguish. Petitioner was refused a patent containing certain claims upon the grounds that they did not read upon his invention (R. 129). Frash, in the case *Frash v. Moore*, 211 U. S. 1, was denied a patent because of his refusal to comply with a requirement of division, there having been no action upon the merits. Frash appealed to the Court of Appeals for the District of Columbia which then had the jurisdiction now residing in the Court of Customs and Patent Appeals under Section 4911 R. S. (U. S. C. Title 35, Sec. 35a) (Appendix, p. 2). The Court in dismissing the appeal and writ of error and in denying *certiorari* said:

“ * * * the decision of that Court (in the action under Section 4911 R. S.) may be challenged generally and a refusal of patent may be reviewed and contested by bill (under Section 4915 R. S.) as provided.” (Parenthetical matter added.)

The remedy available under Section 4915 R. S. (Appendix, p. 3) is co-extensive with the remedy available under Section 4911 R. S. (Appendix, p. 2). That such is the case was clearly stated by the Court below in comparing the relief available under the two sections in *Pitman v. Coe*, 68 F. (2d) 412, 414, and as follows:

“ There is no reason to believe that Congress intended that any remedy which might be obtained by appeal should be more extensive or complete than that allowed by bill in equity.”

The remedies provided by Section 4911 R. S. and Section 4915 R. S. have long been considered as “alternative and mutually exclusive” (*Hemphill Co. v. Coe*, App. D. C. 121 F. (2d) 897 (1941) remedies available to the applicant refused a patent in the Patent Office (*Chase v. Coe*, 122 F. (2d) 198, *Jensen v. Lorenz*, 92 F. (2d) 992, *certiorari* denied, 302 U. S. 751, *Bakelite v. Nat'l. Acilint*, 83 F. (2d) 176). This fact is also clearly evidenced by the wording of Section 4911 R. S. which in part reads as follows:

“ If any applicant is dissatisfied with the decision of the Board of Appeals, he may appeal to the United States Court of Customs and Patent Appeals, in which case he waives his right to proceed under Section 4915 of the Revised Statutes.”

Trade-mark cases brought under Section 4915 R. S. are subject to the “same rules of practice and procedure” (*American Steel Foundries v. Robertson*, 262 U. S. 209, *Atkins v. Moore*, 212 U. S. 285) as in patent cases. The Court of

Appeals for the District of Columbia does not deny its jurisdiction in such cases where upon returning to the Patent Office further prosecution may take place in "complying with the requirements of law," as is evidenced by its decision in the case of *Thorne, Neal and Co. v. Cor*, 143 F. (2d) 155, 62 U. S. P. Q. 22, decided after the present case was argued.

The concept that the District Court has no jurisdiction where further proceedings may take place in the Patent Office upon the return of the application is believed to be obvious error. The statutory duty placed upon the Commissioner by the Revised Statutes, Section 4904 (Appendix, p. 2) and Rules 94 and 95 of the Rules of Practice in the United States Patent Office (Appendix, pp. 6, 7) require the Commissioner to exercise the judicial function of determining the existence or non-existence of an interference with respect to the application. In the case in which the applicant obtained the allowance of the claims for the first time in the 4915 action the Commissioner would not have had the opportunity previously to exercise this function. If the Court of Appeals recognizes the duty resting upon the Commissioner then logically it can never take jurisdiction of an action brought under Section 4915 R. S.

It is submitted that the District Court did have jurisdiction of Petitioner's complaint filed under the provisions of Section 4915 R. S. and that the holding to the contrary is inconsistent with the law as laid down by this and other Courts, and in fact inconsistent with prior and concurrent law as laid down by the same Court.

2. The Question of the District Court's Jurisdiction Depends Upon the Construction of Section 4915 R. S. (U. S. C. Title 35, Sec. 63) and Is of Great Public Importance.

The District Court's jurisdiction is based upon Section 4915 R. S. (Appendix, p. 5). The interpretation placed

upon the statute by the Court of Appeals is believed to be original with it as no similar holding could be found.

The great importance of the decision below is also evidenced by the scope of its application, *Line Materials Company v. Coc*, 125 App. D. C.; 62 U. S. P. Q. 120; *Colgate Palmolive-Peet v. Coc*, 125 App. C. C.; 62 U. S. P. Q. 121. The lower Court's view of the limits of the law of the case is well evidenced by the question propounded and the Court's statement relative thereto in the decision. The question was:

"Has the Court under section 4915, R. S., the power to hand down a decree which does not determine the right of an applicant to receive a patent but which only determines that claims which may subsequently be held to be unpatentable by the Patent Office are supported by the application?" (R. 140.)

The statement in the decision was:

"On its own motion this Court raised the question whether Section 4915 R. S. confers jurisdiction on the District Court to enter a decree which does not determine the right of the applicant to receive a patent but which instead directs the examiner to allow claims for the purpose of provoking subsequent interference proceedings. Both parties submitted memoranda of authority supporting the jurisdiction of the District Court in the above situation" (R. 141).

The decision below, if unreversed, will deny to all applicants the right to bring a bill in equity under Section 4915 R. S. in the following eight specified cases contrary to the clear intent of the law:

a. In a case in which the refusal of the patent is upon the grounds of estoppel for failure to bring a motion as provided by Rule 109 (Appendix, p. 8), Rules of Practice of the Patent Office.

Where the applicant's patent is refused *ex parte* upon the grounds of estoppel and where the award of priority, in an interference is upon the grounds of estoppel, the record in a subsequent action brought under Section 4915 R. S. will show this fact and will also show that a subsequent interference may be necessary upon a favorable decision for the complainant. Under the doctrine of the instant case applicants in such cases would be deprived of their right to file the bill in equity under Section 4915 R. S. The Court refers to two such cases (*International Cellucotton Products Co. v. Coe*, 85 F. (2d) 869, *American Cyanamid Co. v. Coe*, 160 F. (2d) 851) in the decision below. Prior to the present decision the Courts have passed upon many such cases under Section 4915 R. S. (see case cited on p. 15).

b. In cases where the claims are copied from the patent and are later rejected.

In the instant case one of the four claims was copied from the Bergholm patent (R. 134) for purposes of interference and, with the other three claims, was refused by the Patent Office. The same situation was present in the concurrently decided case, *Colgate-Palmolive-Pact Co. v. Coe*, 125 App. D. C.; 62 U. S. P. Q. 121, in which the instant case was cited as the law supporting the above proposition "b". As a matter of fact the subsequent interference may never materialize, for the patentee cannot be forced into an interference. He may disclaim, or he may file a reissue application, and omit the copied claim.

c. In any case in which an interference is dissolved upon any grounds.

The doctrine of *Hoover v. Coe* will deny all applicants the right to have the refusal of their patent re-

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viewed by bill in equity under Section 4915 R. S. where the applicant was previously involved in an interference and the interference was dissolved under the governing Patent Office rules upon any grounds whatsoever. The lower Court has so applied the law of *Hoover v. Coe in Line Material et.al. v. Coe*, 125 App. D. C.; 62 U. S. P. Q. 120.

d. In any case in which a party is eliminated from a multi-party interference upon the ground that he is not entitled to make the claim.

In such a case the interference would continue to an award of priority with the eliminated party prosecuting his application *ex parte*. *Gyro Process Co. v. Coe*, 70 App. D. C. 390, 107 F. (2d) 195. Under the doctrine of *Hoover v. Coe* the parties to the interference and the *ex parte* applicant would have no right to a bill in equity under Section 4915 R. S. for, should the eliminated applicant subsequently prove his right to make the interference counts, a second interference would have to be instituted.

e. In the case in which some of an applicant's claims have been allowed.

The Court below, in holding that applicant had no right to a bill in equity under Section 4915 R. S. when only certain of his claims had been refused, in effect held that unless all of the claims were refused there had been "no refusal of a patent" as provided in Section 4915 R. S. This is contrary to a long established practice, *Gyro Process Co. v. Coe*, 107 F. (2d) 195, *Tully v. Robertson*, 19 F. (2d) 954, *Steinmetz v. Allen*, 192 U. S. 543, *Frasch v. Moore*, 211 U. S. 1. Under the doctrine of this case an applicant who has, for example, one narrow claim allowed would be denied the right to file his bill in equity.

f. In a case in which the Board of Interference Examiners made a ruling under Rule 126 (Appendix, p. 11) of the Rules of Practice in the United States Patent Office.

The Board of Interference Examiners may make a recommendation under Rule 126 (Appendix, p. 11) of the Rules of Practice in the Patent Office to the effect that after a judgment of priority consideration should be given to any matter affecting the right of any party to a patent. Application of this recommendation obviously would require further proceedings in the Patent Office after the determination of the issue of priority in an *inter partes* 4915 action.

g. In a case in which the refusal of a patent is upon the grounds that the applicant had previously elected a different invention, or where the patent is refused upon the failure of the applicant to comply with a requirement for division.

In this case the patent would be refused upon the technical grounds and action upon the merits would necessarily follow a reversal of the Patent Office in an action brought under Section 4915 R. S. This holding, if unreversed, would comprise a complete bar to applicant's right to a patent yet under the decision in the instant case the applicant would be given no right to contest the matter under Section 4915 R. S. The lower Court's decision on this point is inconsistent with the decisions of this Court in *Steinmetz v. Allen*, 192 U. S. 543, *Ex parte Frasch*, 192 U. S. 566, *Frasch v. Moore*, 211 U. S. 1.

h. In any case in which an application has been involved in an interference in the Patent Office.

If jurisdiction does not reside with the District Court when further Patent Office prosecution may be necessary then the Courts will never have jurisdic-

tion in a case involving an application which has been involved in an interference in the Patent Office. In such cases Rule 96 (Appendix, p. 7) specifically provides for further proceedings in the Patent Office including the possibility of a further interference.

The decision below can result in the decisions of the Patent Office becoming final and adverse to the applicant in all cases where a bill under Section 4915 R. S. is filed. The Commissioner need only state in his answer that, should the decree be favorable to the applicant, further proceedings in the Patent Office will be necessary. The District Courts would then, under the law of this case, lack jurisdiction under Section 4915 R. S. The 40-day period for appeal under Section 4911 R. S. to the Court of Customs and Patent Appeals would have long since passed. See Rule 149 (Appendix, p. 13) Rules of Practice of the Patent Office and Rule XXV of the Court of Customs and Patent Appeals (Appendix, p. 14). The applicant (as has complainant in this case) would then be deprived of his right to review under Section 4911 R. S. and Section 4915 R. S. and the decision of the Patent Office would be final insofar as applicant was concerned.

The decision of the Court below, as applied in subsequent decisions of that Court, bases jurisdiction of the District Court in a 4915 action upon an indeterminant factor comprising the degree of likelihood of further proceedings in the Patent Office.

In *Colgate-Palmolive-Peet Company v. Coc*, 125 App. D. C., 62 U. S. P. Q. 121, the doctrine of the present case was applied, while in *Minnesota Mining Company v. Coc*, 125 App. D. C., 62 U. S. P. Q. 119, the doctrine was not applied. These cases were decided on the same day. The facts were substantially the same. In each case the record disclosed that a subsequent interference might take place if the decree was in favor of the complainant, and

that the complainant would be the senior party in such interference.

In this case and in the *Colgate* case the doctrine was applied and jurisdiction denied, the Court in effect holding that the possibility of future proceedings was too proximate. In the *Minnesota Mining* case the doctrine was considered and not applied, the Court below holding in effect that the possibility of future proceedings was too remote.

If the decision below is not reversed, the District Courts will have difficulty in deciding when they do and when they do not have jurisdiction. By the same token applicants will never know whether or not to file a bill under Section 4915 R. S. and take the chance of losing the right of review both under Section 4911 R. S. and Section 4915 R. S.

It is submitted that the lower Court's decision is of great importance and raises questions which should be decided by this Court.

3. This Court Has Not Ruled Upon the Question of the District Court's Jurisdiction of an Action Brought Under Section 4915 R. S. in a Case in Which, Following a Decision Favorable to the Complainant, Further Prosecution Might Take Place in the Patent Office, and the Decision of the Court of Appeals for the District of Columbia Has Not Given Proper Effect to the Applicable Decisions of this Court.

No decision by this Court directly deciding the issues raised below could be found. Decisions by this Court which are applicable and with which the decision below is believed to be inconsistent are *Gandy v. Marble*, 122 U. S. 432, referred to on p. 13; *Steinmetz v. Allen*, 192 U. S. 543, referred to on p. 15; *Frash v. Moore*, 211 U. S. 1, referred to on p. 16.

Under the present practice the Commissioner cannot be sued outside the District of Columbia without his consent.

Butterworth v. Hill, 114 U. S. 128; 5 S. Ct. 796; *Hammar v. Robertson*, 6 F. (2d) 460; *Prentiss v. Ellsworth*, Fed. Case 11386, Whart. Dig. 365, *Vermont Farm Mach. Co. v. Marble*, 20 F. 117. Therefore, it is unlikely that the precise question ruled upon by the Court below will be passed upon in a jurisdiction other than the District of Columbia; wherefore this Court should take the case under consideration by the issuance of a writ of *certiorari* to the Court of Appeals for the District of Columbia.

The need for a ruling by this Court upon the questions presented is made more apparent by the confusion which has resulted from the substantially simultaneous decisions of the Court below. In *Thorne, Neale and Co. v. Coe*, 142 F. (2d) 155; 62 U. S. P. Q. 22; decided after the present case was argued and twenty-eight days prior to the decision therein, the Court below failed to apply the law of this case in a trade-mark case. In *Minnesota Mining and Mfg. Co. v. Coe*, F. (2d), 62 U. S. P. Q. 119; decided the same day as the instant case, the Court below in a footnote

(Footnote: "A few of the claims are copied from other applications which were filed later than the original application in this case. It is not clear that the doctrine of *Hoover v. Coe*, (No. 8602, decided this day (62 U. S. P. Q. 115)), applies to these claims because it may be that if they were held to be patentable the record contains enough evidence to show that the plaintiff was prior in time without the necessity of further interference proceedings. It is unnecessary to decide this question because the appeal involves a number of similar claims which were not copied.")

stated that the doctrine of *Hoover v. Coe* was not applicable because of the facts in the *Minnesota Mining Co.* case which it specified and which are on all fours with the facts in the instant case. In the instant case, as in the *Min-*

nesota Mining Co. case, "a few" (one) of the claims were copied from an application (the Bergholm patent) (R. 134), which was filed (R. 137) later than the original Hoover application (R. 112a). In the Hoover case, as in the Minnesota case, "it may be" that "the record contains enough evidence to show that the plaintiff (Hoover) was prior in time without the necessity of further interference proceedings." In the Hoover case as in the Minnesota case "the appeal (a 4915 action in each case) involves a number of similar claims which were not copied."

It is submitted that with this conflict and confusion in the law in the one Court having jurisdiction of *ex parte* 4915 actions the need for clarification is obvious.

4. The Judgment and Opinion of the Court of Appeals Holding the Court Has No Jurisdiction of an Action Brought Under Section 4915 R. S. May Seriously Hinder and Confuse the Administration of the Law, in the Patent Office, Particularly With Respect to Section 4904 R. S.

The administration of the patent law in the Patent Office will be seriously confused and hindered by virtue of the many rules of practice which are inconsistent with the decision of the Court of Appeals, as discussed below.

The Patent Office is the administrative body specifically designated by Congress to administer the Patent Laws insofar as the issuance of patents are concerned, Section 481 R. S. (U. S. C., Title 35, Section 6) (Appendix, p. 1).

There can be no doubt that the administrative rules set up by the administrative body having jurisdiction of the administration of an act of Congress over a long period of time, during which the act was frequently amended with such rules in view, should be virtually conclusive as to the interpretation of the statutes in question. *Dismuke v. U. S.* 297 U. S. 167; *Scott Logan v. Davis*, 233 U. S. 613; *Kern*

River Co. v. U. S., 257 U. S. 147; *U. S. v. State of Minnesota*, 270 U. S. 181; *U. S. v. Jackson et al.*, 280 U. S. 183.

Under the decision below practically all of the rules of the Patent Office relating to the administration of R. S. Sec. 4904 (Appendix, p. 2) will have to be changed if an applicant's rights provided by statute are to be preserved. These rules "have the force and effect of law" (*Ewing v. United States, ex rel. Fowler Car Co.*, 244 U. S. 1), and comprise an authority "under the United States" (*Steinmetz v. Allen*, 192 U. S. 543, 556).

This Court has held that the mere allegation in a petition for writ of certiorari "that the judgment and opinion below might seriously hinder future administration of the law was grave and sufficiently probable to justify issuance of the writ." (*Fed. Trade Comm. v. Amer. Tobacco Co.*, 274 U. S. 543.)

Rules 93, 94, 95 and 96 (Appendix, pp. 5, 6, 7) of the Patent Office require that the counts or claims be patentable to all parties before an interference is instituted. Furthermore Rule 96 provides for the setting up of other interferences after a judgment of priority in a first interference. Rule 63d (Appendix, p. 5) makes provision for rejecting claims copied from a patent in certain cases. Rules 111, 116, 122, 123 and 124 (Appendix, pp. 9, 10, 11) of the Patent Office have to do with motions to dissolve and with the dissolution of interferences. Rule 126 (Appendix, p. 11) has to do with calling the Commissioner's attention to facts, which came to the notice of the board of interference examiners and which would indicate that the claims are unpatentable to either party and provides for further proceedings in the Patent Office in such a case. Rule 130 (Appendix, p. 11) of the Patent Office has to do with the question of raising patentability of the issue to an opponent as a basis for a priority decision only when a motion

had been duly brought. Rule 133 (Appendix, p. 12) provides for appeals to the Board of Appeals and includes the question of division or previous election which do not go to the merits in the sense of novelty, patentability, etc., and the decision of which would not end the prosecution of the case before the Patent Office. Rule 141 (Appendix, p. 12) specifically provides for further proceedings in the Patent Office after a decision by an appellate tribunal.

All of the foregoing rules provide for further proceedings in the Patent Office after the refusal of a patent. Under the decision below, if the District Court is to have jurisdiction further proceedings must not take place in the Patent Office. If an applicant's rights under Sec. 4945 R. S. are to be preserved, under the decision below, those rules must be changed:

It is submitted that the probability of confusion in the administration of the statutes in the Patent Office which will be caused by the decision below is sufficient reason for the Supreme Court to take jurisdiction and to review the decision.

5. The Provision in Section 4915 R. S. of a "Remedy by Bill in Equity" * * * "Whenever a Patent on Application Is Refused by the Board of Appeals or Whenever Any Applicant Is Dissatisfied With the Decision of the Board of Interference Examiners," Provides for Remedies Under Two Separate Conditions.

Section 4915 R. S. (Appendix, p. 3) clearly provides a patent applicant in the United States Patent Office with remedies in two distinct cases: He may file a bill in equity when:

- (1) "a patent on application is refused by the Board of Appeals"
- "or whenever"
- (2) "dissatisfied with the decision of the board of interference examiners."

The decision of the Court below refuses to grant an applicant the remedy of (1) unless (2) is also present in any case where an interference might be set up at a later date. The word "or" is interpreted to mean "and."

The decision below requires that the interference be set up even though the Commissioner is of the opinion that none should exist. Such a holding is clearly inconsistent with the holding of this Court in *Ewing v. Fowler Car Co.* (244 U. S. 1). The Court there said:

"If it could be conceded that there is antagonism between Sec. 4904, and the rules, the former must prevail. *Steinmetz v. Allen*, 192 U. S. 543, 565. But there is no antagonism. The former provides that 'when-ever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending application . . . he shall direct the primary examiner to proceed to determine the question of priority of invention.' The section, therefore, commits to the opinion (judgment) of the Commissioner the effect of an application upon a pending one—whether it will interfere with a pending one; something more, therefore, than the fact of two applications, something more than the mere assertion of a claim. The assertion must be, in the opinion of the Commissioner, an interference with another. And it is this other that is first in regard, not to be questioned except at the instance of the Commissioner by an exercise of judgment upon the circumstances. And there is no defeat of ultimate rights; there may be postponement of their assertion remitted to a suit in equity under Sec. 4918."

The same case is authority for the statement that in the present case the applicant could not mandamus the Commissioner to institute the interference which the lower Court contends must exist if it is to have jurisdiction.

Such holding clearly ignores the express provisions of Section 4904 R. S. (Appendix, p. 2), which reads in part as follows:

"Whenever an application is made for a patent which, *in the opinion of the Commissioner*, would interfere with any pending application, or with an unexpired patent, he * * * shall direct a board of three examiners of interferences to proceed to determine the question of priority of invention." (Italics added.)

It also ignores Rule 94 (Appendix, p. 6) of the Rules of Practice in the United States Patent Office which rules comprise an authority "under the United States" (*Steinmetz v. Allen*, 192 U. S. 543, 556). Rule 94 provides:

"Interferences will be declared between applications by different parties for patent or for reissue when such applications contain claims for substantially the same invention *which are allowable in the application of each party*, and * * * between applications for patent, or for reissue, and unexpired original or re-issued patents, of different parties, when such applications and patents contain claims for substantially the same invention *which are allowable in all of the applications involved*. * * *" (Italics added.)

To arrive at its holding the Court of Appeals must interpret "or" to be "and" and in doing so violates established principles of statutory interpretation.

The Rules of Practice in the United States Patent Office represent the Commissioner's interpretation of the statutes and, he being an administrative officer charged with the duty of administering the law, the interpretations are entitled to great weight and being of long standing, are not lightly to be overturned. *Dismuke v. United States*, 297 U. S. 167; *U. S. v. State of Minn.*, 270 U. S. 181; *U. S. v. Jackson*, 280 U. S. 183; *Kern River v. U. S.*, 257 U. S. 147; *Scott Logan v. W. R. Davis*, 233 U. S. 613; *United States v. Moore*, 95 U. S. 760; *Hastings et al. v. Whitney*,

132 U. S. 357; *United States v. Alabama G. S. R. Co.*, 142 U. S. 615; *Kindred v. Union P. R. Co.*, 225 U. S. 582.

In interpreting any statute in the absence of ambiguity, the ordinary meaning of its words and language control *Maillatd v. Lawrence*, 16 How. 251; *United States v. Willberger*, 5 Wheat. 76; *Ruggles v. Illinois*, 108 U. S. 526; *Putnam v. Longley*, 28 Mass. 487.

It is well settled that conjunctive words are to be construed as disjunctive, and vice versa, when and only when it is necessary to effectuate the obvious intention of the legislature. *Beasley v. Parnell*, 177 Ark. 912, 9 S. W. (2d) 10; *In re Steineruck's Insolvency*, 74 A. 360, 225 Pa. 461; *Weir v. Bauer*, 286 Pa. 936; *State v. Tiffany*, 44 Wash. 602, 87 P. 932; 59 C. J. 986, Sec. 584; *Gar Creek Drainage Dist. v. Wagner*, 256 Ill. 338, 100 N. E. 190, 193; *Aurora Brewing Co. v. Ind. Bd. of Ill.*, 277 Ill. 142, 115 N. E. 207; *Foight v. Indus. Comm.*, 297 Ill. 109, 130 N. E. 470; *State ex rel. Normile v. Cooney*, 100 Mont. 391, 47 P. (2d) 637.

It clearly cannot be contended logically that the word "or" of Section 4915 R. S. must be interpreted as "and" in view of the express provisions of related statutes which are inconsistent with such a view.

Section 4911 R. S. (Appendix, p. 2) provides for appeals to the United States Court of Customs and Patent Appeals in *ex parte* and *inter partes* cases. Parallel to Section 4915 R. S. it provides for relief from decisions of the Board of Appeals and from the board of interference examiners.

As to appeals from the Board of Appeals Section 4911 R. S. states that if an applicant takes such appeal "he waives his rights to proceed under section 4915 of the Revised Statutes." The disjunctive "or" is not used in Section 4911 R. S. The wording of the statute quoted in-

dicates the legislative opinion that the right to proceed under either statute resides in the applicant.

As to appeals from the board of interference examiners to the United States Court of Customs and Patent Appeals, this right is given in a separate sentence and here the opposing adverse party may elect "to have all further proceedings conducted as provided in section 4915 of the Revised Statutes."

It appears, therefore, from the wording of Section 4911 R. S. that appeals to the Court of Customs and Patent Appeals from either the Board of Appeals or from the board of interference examiners might have been made the subject matter of a 4915 action.

The view is further supported when it is recalled that to insist that "or" means "and" in Section 4915 R. S. is to make an applicant's right to a clearly given remedy from an adverse decision of the Board of Appeals dependent entirely upon the "opinion" of the Commissioner as to whether an interference should be declared.

The holding below that the Court cannot give judgment authorizing the Commissioner to issue a patent to applicant containing the claims in issue in the absence of other parties claiming the same invention is inconsistent with Section 4918 R. S. (Appendix, p. 4). That statute clearly provides for the determination of the adverse interests of interfering patents.

It is submitted that the word "or" in Section 4915 R. S. is to be given its usual meaning as a disjunctive in the absence of indication of legislative intent to the contrary and particularly in the presence of legislative intent to that effect.

6. In an Ex Parte Action Brought Under Section 4915 R. S. by an Applicant After Refusal of a Patent by the Board of Appeals, a Third Party Claiming the Same Invention Is Not a Necessary Party Where No Interference Between Applicant and the Third Party Was Instituted by the Patent Office.

The Court below held it "had no jurisdiction over this suit" and gave as a reason that "The party against whom the plaintiff claims priority is not before the court" (R. 142).

The bill of complaint in the District Court (R. 3) did not name any other party defendant than the Commissioner of Patents, nor did it claim priority with respect to any other party save to allege (R. 6, paragraph 15) that the claimed invention of complainant's application was "new and useful and was not known or used by others in this country before Coons' invention thereof," as is required to entitle an applicant to a patent under Section 4886 R. S. (Appendix, p. 1). The Commissioner of Patents' answer (R. 8) did not deny the allegation of the complaint which, under F. R. C. P. 8(d) (Appendix, p. 14), is to be taken as admitted. As the Commissioner is the officer charged by law with the duty (Section 481 R. S.) (Appendix, p. 1) of issuing patents, this admission on the face of the pleadings is entitled to full acceptance.

There had been no interference in the Patent Office and there were no other adverse parties which could properly have been named parties defendant. *Dracket Co. v. Chamberlain Co.*, 10 F. S. 851, affirmed 81 F. (2d) 866; *Coe v. Hobart*, 102 F. (2d) 270; *Fessenden v. G. E.*, 10 F. S. 846. In the latter case the Court said:

"Plaintiff can bring no suit against the defendant in this or any other court because of an attempt to have an interference proceeding followed by the dis-

solution thereof. His only cause of action is against the Commissioner of Patents on the assumption that the dissolution of the interference proceedings, because of assumed lack of disclosure of the invention claimed, is equivalent to a denial of the patent. * * *

The District Court's jurisdiction as to such parties would be under the provisions of the second paragraph of Section 4915 R. S. (Appendix, p. 3) and the decisions deny such jurisdiction of another applicant or patentee in a 4915 action where no interference had been instituted in the Patent Office.

The decision below upon this point is directly contrary to the same Court's decision in the trade-mark case decided after the instant case was argued. *Thorne, Neale and Co. v. Coe*, 143 F. (2d) 155, 62 U. S. P. Q. 22. That trade-mark cases are parallel to patent cases has been mentioned before and has been definitely established. *Atkins v. Moore*, 212 U. S. 285; *American Steel Foundries v. Robertson*, 262 U. S. 209; *Baldwin v. Howard*, 256 U. S. 35.

The requirement that a potential future adverse party be made a party defendant in an *ex parte* 4915 suit, represents a departure from the practice followed in a long line of cases.

In all cases in which the applicant is denied a patent upon the grounds of estoppel to make claims and where a subsequent interference would result should he succeed in a 4915 action the present holding in the lower Court requiring the naming of the potential interferant as a defendant is applicable. Cases evidencing that over a period of many years the Court below has not required the presence of the potential future interferant in such cases are here listed; *International Cellucotton Products Co. v. Coe*, 85 F. (2d) 869, App. D. C. 1936; *Du Pont v. Coe*, 89 F. (2d) 679, App. D. C. 1937; *American Cyanamid v. Coe*,

106 F. (2d) 831, App. D. C. 1939; *American Viscose Corp. v. Coe*, 106 F. (2d) 849, App. D. C. 1939; *Power Patents Co. v. Coe*, 110 F. (2d) 550, App. D. C. 1940; *Bendix Aviation Corp. v. Coe*, 61 U. S. P. Q. 78, D. C. D. C. 1943; *Bates et al. v. Coe*, 40 U. S. P. Q. 220, D. C. D. C.; *Tinnerman Products v. Coe*, 50 F. S. 337, D. C. D. C.; *Gyro Process Co. v. Coe*, 107 F. (2d) 195, 42 U. S. P. Q. 413. The Court of Appeals in the Second Circuit also has taken jurisdiction of such cases. *Gold v. Newton*, 254 F. 824; *Barrett v. Ewing*, 242 F. 506. It is to be presumed that the Court in all of these cases assumed its duty of determining its jurisdiction. *Minnesota v. Hitchcock*, 185 U. S. 373; *Reid v. U. S.*, 241 U. S. 529.

It is submitted that the requirement by the lower Court that a potential future interferant be named as a party defendant in an *ex parte* 4915 action is clear error. Such party is not a necessary party under the decisions and the governing statute.

CONCLUSION.

For the foregoing reasons it is believed that this Court should be moved to grant the writ of certiorari to the end the fundamental questions of patent law here involved may be settled by this Court and the judgment of the Court below reversed.

Respectfully submitted,

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APPENDIX.

Statutes:

SEC. 481. R. S. (U. S. C., title 35, sec. 6.) The Commissioner of Patents, under the direction of the Secretary of Commerce, shall superintend or perform all duties respecting the granting and issuing of patents directed by law; and he shall have charge of all books, records, papers, models, machines, and other things belonging to the Patent Office.

SEC. 486. R. S. (U. S. C., title 35, sec. 31.) Any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvements thereof, or who has invented or discovered and asexually reproduced any distinct and new variety of plant, other than a tuber-propagated plant, not known or used by others in this country, before his invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof or more than one year prior to his application, and not in public use or on sale in this country for more than one year prior to his application, unless the same is proved to have been abandoned, may, upon proceeding had, obtain a patent therefor. [The period is *two years* instead of "one year" where the application was filed prior to Aug. 5, 1940. See Sec. 2 of Act of Aug. 5, 1939, *infra*.]

Act of Aug. 5, 1939, 53 Stat. 1212:

SEC. 2. This Act [amending sections 4886, 4887, 4920, and 4929 of the Revised Statutes (U. S. C., title 35, secs. 31, 62, 69, and 73) by changing "two years" to *one year*] shall take effect one year after its approval and shall apply to all applications for patent filed after it takes effect and to all patents granted on such applications: *Provided, however,* That all applications for patents filed prior to the time this Act takes effect and all patents granted on such applications are to be governed by the statutes in force at the time of approval of this Act as if such statutes had not been amended.

SEC. 4904. R. S. (U. S. C., title 35; sec. 52.) Whenever an application is made for a patent which, in the opinion of the Commission, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be, and shall direct a board of three examiners of interferences to proceed to determine the question of priority of invention. And the Commission may issue a patent to the party who is adjudged the prior inventor. [As to interferences declared prior to Oct. 5, 1939, see Sec. 5 of Act of Aug. 5, 1939, *infra*.]

Act of Aug. 5, 1939, 53 Stat. 1212:

SEC. 5. This Act [amending sections 4904, 4909, 4911, and 4915 of the Revised Statutes (U. S. C., title 35, secs. 52, 57, 59a, and 63)] shall take effect two months after its approval; but it shall not affect interferences then pending, which may be heard and decided and appeals and other proceedings taken under the statutes in force at the time of approval of this Act as if such statutes had not been amended.

SEC. 4911. R. S. (U. S. C., title 35, sec. 59a.) If any applicant is dissatisfied with the decision of the Board of Appeals, he may appeal to the United States Court of Customs and Patent Appeals, in which case he waives his right to proceed under section 4915 of the Revised Statutes. (U. S. C., title 35, sec. 63.) If any party to an interference is dissatisfied with the decision of the board of interference examiners he may appeal to the United States Court of Customs and Patent Appeals, provided that such appeal shall be dismissed if any adverse party to such interference shall within twenty days after the appellant shall have filed notice of appeal according to section 4912 of the Revised Statutes. (U. S. C., title 35, sec. 60), file notice with the Commissioner of Patents that he elects to have all further proceedings conducted as provided in section 4915 of the Revised Statutes. Thereupon the appellant shall have thirty days thereafter within which to file a bill in equity under said section 4915, in default of which the decisions ap-

pealed from shall govern the further proceedings in the case [As to interferences declared prior to Oct. 5, 1939, see sec. 5 of Act of Aug. 5, 1939, printed after R. S. sec. 4904, *ante*.]

SEC. 4915. R. S. (U. S. C., title 35, sec. 63.) Whenever a patent on application is refused by the Board of Appeals or whenever any applicant is dissatisfied with the decision of the board of interference examiners, the applicant, unless appeal has been taken to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided, in which case no action may be brought under this section, may have remedy by bill in equity, if filed within six months after such refusal or decision; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication and otherwise complying with the requirements of law. In all cases where there is no opposing party a copy of the bill shall be served on the commissioner; and all the expenses of the proceedings shall be paid by the applicant, whether the final decision is in his favor or not. In all suits brought hereunder where there are adverse parties the record in the Patent Office shall be admitted in whole or in part, on motion of either party, subject to such terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court may impose, without prejudice, however, to the right of the parties to take further testimony. The testimony and exhibits, or parts thereof, of the record in the Patent Office when admitted shall have the same force and effect as if originally taken and produced in the suit. [As to interferences declared prior to Oct. 5, 1939 see Sec. 5 of Act of

Aug. 5, 1939, printed after R. S. Sec. 4904, *ante.*]

Act of Mar. 3, 1927, 44 Stat. 1394 (U. S. C., title 35, sec. 72a):

And upon the filing of a bill in the District Court of the United States for the District of Columbia wherein remedy is sought under section 4915 or section 4918 of the Revised Statutes (U. S. C., title 35, sec. 63 or sec. 66), without seeking other remedy, if it shall appear that there is an adverse party residing in a foreign country, or adverse parties residing in a plurality of districts not embraced within the same State, the court shall have jurisdiction thereof and writs shall, unless the adverse party or parties voluntarily make appearance, be issued against all of the adverse parties with the force and effect and in the manner set forth in this section (sec. 113 of title 28 U. S. C.): *Provided*, That writs issued against parties residing in foreign countries pursuant to this section may be served by publication or otherwise as the court shall direct.

SEC. 4918. R. S. (U. S. C., title 35, sec. 66.) Whenever there are interfering patents, any person interested in any of them, or in the working of the invention claimed under either of them, may have relief against the interfering patentee, and all parties interested under him, by suit in equity against the owners of the interfering patent; and the court, on notice to adverse parties, and other due proceedings had according to the course of equity, may adjudge and declare either or both the patents void in whole or in part upon any ground, or inoperative, or invalid in any particular part of the United States, according to the interest of the parties in the patent or the invention patented. But no such judgment or adjudication shall affect the right of any person except the parties to the suit and those deriving title under them subsequent to the rendition of such judgment.

Rules of Practice in the United States Patent Office:

63. (d) Applications which appear to interfere with other applications previously considered and found to be allowable, or which it is demanded shall be placed in interference with an unexpired patent or patents.

Where an applicant copies claims from a patent and the examiner is of the opinion that he can make none of these claims, he should state in his action why he can not make the claims and set a time limit, not less than twenty days, for reply. If, after response by the applicant, the rejection is made final, a similar time limit should be set for appeal. Failure to respond or appeal, as the case may be, within the time fixed, will in the absence of a satisfactory showing, be deemed a disclaimer of the invention claimed. (See rule 94.)

93. An interference is a proceeding instituted for the purpose of determining the question of priority of invention between two or more parties claiming substantially the same patentable invention and may be instituted as soon as it is determined that common patentable subject matter is claimed in a plurality of applications or in an application and a patent. In order to ascertain whether any question of priority arises the Commissioner may call upon any junior applicant to state in writing under oath the date and the character of the earliest fact or act, susceptible of proof, which will be relied upon to establish conception of the invention under consideration. The sworn statement filed in compliance with this rule will be retained by the Patent Office separate from the application file and if an interference is declared will be opened simultaneously with the preliminary statement of the party filing the same. In case the junior applicant makes no reply within the time specified, not less than twenty days, the Commissioner will proceed upon the assumption that the said date is the date of the oath attached to the application. The fact that one of the parties has already obtained a patent will not prevent an interference, for, although the

Commissioner has no power to cancel a patent, he may grant another patent for the same invention to a person who proves to be the prior inventor.

94. Interferences will be declared between applications by different parties for patent or for reissue when such applications contain claims for substantially the same invention which are allowable in the application of each party, and interferences will also be declared between applications for patent, or for reissue, and unexpired original or reissued patents, of different parties, when such applications and patents contain claims for substantially the same invention which are allowable in all of the applications involved: *Provided*, That where the filing date of any applicant is subsequent to the filing date of any patentee, the applicant shall file an affidavit that he made the invention in controversy in this country before the filing date of the patentee; and when required the applicant shall file an affidavit setting forth facts showing that he completed the invention in controversy, in this country, before the filing date of the patentee.

Where claims are copied from a patent and the examiner is of the opinion that the applicant can make only some of the claims so copied, he shall notify the applicant to that effect, state why he is of the opinion he cannot make the other claims and state further that the interference will be promptly declared and that the applicant may proceed under rule 109, if he further desires to contest his right to make the claims not included in the declaration of the interference.

Where an applicant presents a claim copied or substantially copied from a patent, he must at the time he presents the claim identify the patent, give the number of the patented claim, and specifically apply the terms of the co. claim to his own disclosure.

No amendment for the first time presenting or asserting a claim which is the same as, or for substantially the same subject matter as, a claim of an issued patent may be made in any application unless such amendment is filed within one year from the date on which said patent was granted.

Parties owning applications or patents which contain conflicting claims will be required to show cause why these claims shall not be eliminated from all but one of the applications or patents of common ownership.

95. Before the declaration of interference it must be determined that there is common patentable subject matter in the cases of the respective parties. The issue must be clearly defined and be patentable to the respective parties, subject to the determination of the question of priority.

In case the subject matter in controversy has been patented to one of the parties but is deemed by the examiner not to be patentable to an applicant, he shall call the case to the attention of the Commissioner.

96. Whenever the claims of two or more applications differ in phraseology, but relate to substantially the same patentable subject matter, the examiner shall suggest to the parties such claims as are necessary to cover the common invention in substantially the same language. The examiner shall send copies of the letter suggesting claims to the applicant and to the assignee, as well as to the attorney or agent of record in each case. The parties to whom the claims are suggested will be required to make those claims within a specified time in order that an interference may be declared. Upon the failure of any applicant to make any claim suggested within the time specified, such failure or refusal shall be taken without further action as a disclaimer of the invention covered by that claim unless the time be extended upon a proper showing. After judgment of priority the application of any party may be

viii.

held for revision and restriction, subject to interference with other applications.

Whenever it shall be found that two or more parties whose interests are in conflict are represented by the same attorney or agent, the examiner shall notify each of said principal parties and also the attorney or agent of this fact.

109. An applicant involved in an interference may, within a time fixed by the examiner of interferences not less than thirty days after the preliminary statements (referred to in rule 110) of the parties have been received and approved, or if a motion to dissolve the interference has been brought by another party, within thirty days from the filing thereof, on motion duly made as provided by rule 153, file an amendment to his application containing any claims which in his opinion should be made the basis of interference between himself and any of the other parties.

Such motion must be accompanied by the proposed amendment, and when in proper form will be set by the examiner of interferences for hearing before the primary examiner. Where a party opposes the admission of such an amendment in view of prior patents or publications, full notice of such patents or publications, applying them to the proposed counts, must be given to all parties at least twenty days prior to the date of hearing. On the admission of such amendment and the adoption of the claims by the other parties within a time specified the primary examiner shall redeclare the interference or shall declare such other interferences as may be necessary to include the said claims. New preliminary statements will be received as to the added claims, but motions for dissolution with regard thereto will not be considered where the questions raised could have been disposed of in connection with the admission of the claims. Amendments to the specification will not be received during the pendency of

the interference without the consent of the Commissioner, except as provided herein and in rule 106.

Any party to an interference may bring a motion to put in interference any claims already in his application or patent which should be made the basis of interference between himself and any of the other parties. Any party to an interference may bring a motion to add or substitute any other application owned by him, as to the existing issue, or to include an application or a patent owned by him, as to claims which should be made the basis of interference between himself and any of the other parties. Such motions are subject to the same conditions and the procedure in connection therewith is the same, so far as applicable, as hereinabove set forth for motions to amend.

111. The preliminary statements shall not be opened to the inspection of the opposing parties until all motions to dissolve under rule 122 and all motions to amend under rule 109 and interlocutory appeals respecting the same have been fully disposed of or the time for filing such motions has expired without such a motion having been filed, and the case is in condition for taking of testimony.

A junior party who fails to file a preliminary statement or a party who alleges no date in his preliminary statement earlier than the filing date of the application or applications of another party shall not have access to the preliminary statement of said party.

If the interference be terminated by dissolution, the preliminary statements will remain sealed.

116. The parties to an interference will be presumed to have made their inventions in the chronological order in which they filed their completed applications for patents clearly disclosing same; and the burden of proof will rest upon the party who shall seek to establish a different state of facts.

The termination of the interference by dissolution under rule 122 without an award of priority shall not disturb this presumption, and a party enjoying the status of a senior party with respect to any subject-matter of his application shall not be deprived of any claim to such subject-matter solely on the ground that such claim was not added to the interference by amendment under rule 109.

122. Motions to dissolve an interference (1) alleging that there has been such informality in declaring the same as will preclude the proper determination of the question of priority of invention, or (2) denying the patentability of an applicant's claim, or (3) denying his right to make the claim, or (4) if the interference involves a design patent or an application, alleging that there is no interference in fact and also motions to shift the burden of proof, should contain a full statement of the ground relied upon and should, if possible, be made within the time fixed by the examiner of interferences, not less than thirty days, after the statements of the parties have been received and approved. Such motions and all motions of a similar character, if in the opinion of the examiner of interferences they be in proper form, will be heard and determined by the primary examiner, due notice of the day of hearing being given by the office to all parties. If in the opinion of the examiner of interferences the motion be not in proper form, or if it be not brought within the time specified and no satisfactory reason be given for the delay, it will not be considered and the parties will be so notified.

At a hearing on a motion to dissolve an interference between an application and a patent, the prior art of record in the patent file shall be referred to for the purpose of construing the issue. The matter raised on a motion to shift the burden of proof may be reviewed at final hearing.

123. Setting a motion brought under the provisions of rule 109 or of rule 122 for hearing will act as a stay of pro-

ceedings pending the determination of the motion. To effect a stay of proceedings in other cases, motion should be made before the tribunal having jurisdiction of the interference, who will, sufficient ground appearing therefor, order a suspension of the interference pending the determination of such motion.

124. No appeal will be permitted from a decision rendered on a motion brought under the provisions of rules 109 and 122.

Appeals may be taken directly to the Commissioner from decisions on such other motions as, in his judgment, should be appealable.

126. The board of interference examiners may, either before or in their decision on the question of priority, direct the attention of the Commissioner to any matter not relating to priority which may have come to their notice, and which, in their opinion, establishes the fact that no interference exists, or that there has been irregularity in declaring the same (rule 122), or which amounts to a statutory bar to the grant of a patent to either of the parties for the claim or claims in interference. The Commissioner may suspend the interference and remand the case to the primary examiner for his consideration of the matters to which attention has been directed. From the decision of the examiner appeal may be taken as in other cases. If the case shall not be so remanded, the primary examiner will, after judgment consider any matter affecting the rights of either party to a patent which may have been called to his attention, unless the same shall have been previously disposed of by the Commissioner.

130. Where the patentability of a claim to an opponent is material to the right of a party to a patent, said party may urge the nonpatentability of the claim to his opponent as a basis for the decision upon priority of invention. A

party shall not be entitled to raise this question, however, unless he has duly presented and prosecuted a motion under rule 122 for dissolution upon this ground or shows good reason why such a motion was not presented and prosecuted.

At final hearing between an applicant and a patent the prior art of record in the patent file shall be referred to for the purpose of construing the issue.

133. Every applicant for a patent, any of the claims of whose application have been twice rejected for the same reasons, upon grounds involving the merits of the invention, such as lack of invention, novelty, or utility, or on the ground of abandonment, public use or sale, inoperativeness of invention, aggregation of elements, incomplete combination of elements, or, when amended, for want of identity with the invention originally disclosed, or because the amendment involves a departure from the invention originally presented; and every applicant who has been twice required to divide his application, and every applicant for the reissue of a patent whose claims have been twice rejected for any of the reasons above enumerated, or on the ground that the original patent is not operative or invalid, or if so inoperative or invalid that the errors which rendered it so did not rise from inadvertence, accident, or mistake, may, upon payment of a fee of \$15, appeal from the decision of the primary examiner to the board of appeals. The appeal must set forth in writing the points of the decision upon which it is taken, and must be signed by the applicant or his duly authorized attorney or agent.

141. After decision by an appellate tribunal the case shall be remanded at once to the primary examiner, subject to the applicant's right of appeal, for such action as will carry into effect the decision, or for such further action as the applicant is entitled to demand.

149. When an appeal is taken to the United States Court of Customs and Patent Appeals, the appellant shall give notice thereof to the Commissioner, and file in the Patent Office, within forty days, exclusive of Sundays and legal holidays in the District of Columbia but including Saturday half holidays, from the date of the decision appealed from, his reasons of appeal specifically set forth in writing: *Provided*, however, that if a petition for rehearing or reconsideration is filed within 20 calendar days after said decision, the notice of appeal may be given and the reasons of appeal filed within 15 calendar days after action on the petition. No petition for rehearing or reconsideration filed more than 20 calendar days after such decision, nor any proceedings on such petition, shall operate to extend the period of 40 days hereinabove provided for appeal.

If an applicant in an *ex parte* case appeals to the U. S. Court of Customs and Patent Appeals he waives his right to proceed under section 4915 R. S. (U. S. C., title 35, sec. 63).

If a defeated party to an interference proceeding appeals to the U. S. Court of Customs and Patent Appeals, and any adverse party to the interference shall, within twenty days after the appellant shall have filed notice of the appeal to the court, file notice with the Commissioner that he elects to have all further proceedings conducted as provided in section 4915 R. S., certified copies of the foregoing papers will be transmitted to the U. S. Court of Customs and Patent Appeals for such action as may be necessary. The notice of election must be served as provided in rule 154 (b). [See rule 153 (a).]

From adverse decisions by the board of appeals in *ex parte* cases and from decisions of the board of interference examiners, the appellant, if an applicant, has the option

of proceeding under section 4915 R. S. instead of appealing directly to the U. S. Court of Customs and Patent Appeals.

Rules of Civil Procedure:

8(d) EFFECT OF FAILURE TO DENY. Averments in a pleading to which a responsive pleading is required, other than those as to the amount of damage, are admitted when not denied in the responsive pleading. Averments in a pleading to which no responsive pleading is required or permitted shall be taken as denied or avoided.

Rules of U. S. Court of Customs and Patent Appeal:

Rule XXV.

1. Any party desiring to appeal to this court from a decision of the Board of Appeals, Board of Interference Examiners or the Commissioner of Patents shall file in the clerk's office a petition, addressed to the court, in which he shall briefly set forth and show that he has complied with the requirements of section 4912 and 4913 of the Revised Statutes of the United States to entitle him to an appeal, and praying that his appeal may be heard upon and for the reasons assigned therefor to the commissioner. Said reasons for appeal, having been filed with the Commissioner of Patents and made a part of the record, shall not be repeated in the petition of appeal. Said petition of appeal and a certified copy of the record in the proceeding shall be filed in this court and the case duly docketed within 40 days (exclusive of Sundays and legal holidays) from the date upon which said reasons for appeal were filed with the Commissioner of Patents: Provided, That the commissioner may for special and sufficient cause extend such time to some definite and fixed date: Provided farther, That in inter partes cases appellant shall, at the time of filing said petition of appeal in this court, or within 10 days

thereafter, serve a copy within 10 days thereafter, serve a copy thereof upon appellee or his counsel.

If said petition of appeal and copy of said record shall not be filed within said period of 40 days, unless such time be extended by the commissioner as heretofore provided, the commissioner, upon such facts being brought to his attention by motion of the appellee in inter partes cases, duly served upon the appellant or his attorney, and upon his own motion in ex parte appeals, may take such further proceedings in the case as may be necessary to dispose of the same as though no notice of appeal had ever been given. Provided, however, That if any adverse party in an interference case shall, within twenty days after appellant shall have filed notice of appeal to this court, file notice with the Commissioner of Patents that he elects to have all further proceedings conducted as provided in section 4915 of the Revised Statutes, certified copies of the notice of appeal and the notice of election shall be transmitted to this court by the Commissioner of Patents for appropriate action according to law.

2. All certified copies of papers and evidence on appeal from the decision of the final appellate tribunal of the Patent Office shall be received by the clerk of this court, and the cases, by titling and number, shall be placed on a separate docket to be designated as the "Patent appeal docket." The clerk shall, under this titling of the case on the docket, make brief entries of all papers filed and of all proceedings had in the case.

3. In making up the transcript of record on appeal it shall be the duty of the Commissioner of Patents to omit the following:

(a) Face and back of file wrappers; formal indorsements on backs of papers.

(b) Printed letterheadings and the like. (Examiners letters and other office letters need show only the date, address, short title, and number of case, body of letter, and signature.)

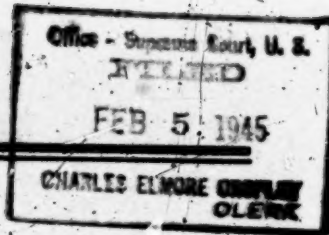
(c) Notices of publication, of hearings, of decisions, of allowance, of receipt of fees, reference slips, interference cards, and the like (except when material to some question raised on the appeal, and then merely a memorandum need be made—e.g., "Memorandum: Notice of allowance mailed to, address, date").

(d) A patent or other instrument once inserted shall not be inserted a second time, but reference made thereto by memorandum if necessary.

(e) Further to reduce the costs of appeals, it shall be permissible for counsel for the respective parties, subject to the approval of the Commissioner of Patents, to agree upon a statement of the facts of the case, setting forth the questions raised on appeal and so much only of the evidence as may be necessary to a decision of such question. Such statement shall be in duplicate signed by counsel for the parties and filed with the Commissioner of Patents. When so filed, one of the duplicates, together with the decisions of the office, shall constitute the record on appeal and shall be certified accordingly.

4. Appeals from decisions of the Board of Appeals, Board of Interference Examiners and the Commissioner of Patents shall be subject to all the rules of this court provided for other cases therein, except where such rules, from the nature of the case, or by reason of special provisions inconsistent therewith, are not applicable.

FILE COPY



IN THE

Supreme Court of the United States

October Term, 1944.

No. 486.

THE HOOVER COMPANY,

Petitioner,

vs.

CONWAY P. COE, Commissioner of Patents,

Respondent.

BRIEF OF PETITIONER.

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Of Counsel.

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IN THE
Supreme Court of The United States

October Term, 1944

No. 486.

THE HOOVER COMPANY,

Petitioner,

vs.

CONWAY P. COE, Commissioner of Patents,
Respondent.

BRIEF OF PETITIONERS.

The opinion of the Court of Appeals for the District of Columbia is reported at 144 F. (2d) 514, 62 U. S. P. Q. 115, and appears herewith in the record (R. 140).

The District Court did not enter an opinion, but its findings of fact and conclusions of law appear in the record (R. 19).

Jurisdiction.

Writ of certiorari issued to the Court of Appeals for the District of Columbia.

The grounds on which the jurisdiction of this Court was invoked follow:

(1) The statute under which jurisdiction is invoked is Section 240 (a) of the Judicial Code, 28 U. S. C. 347, as amended by the Act of February 13, 1925.

(2) The judgment of the United States Court of Appeals for the District of Columbia was entered on July 10, 1944.

(3) The foregoing judgment was entered on appeal from a judgment by the District Court for the District of Columbia in a suit in equity brought under the Revised Statutes, Section 4915, 35 U. S. C. 63, as amended by Act of August 5, 1939, to have remedy from the refusal of the Board of Appeals of the Patent Office to grant a patent to Petitioner as assignee of reissue patent application Serial No. 373,970, filed by Curtis C. Coons.

(4) The real question before this Court is the construction of a United States Statute (R. S. 4915). It has been held by this Court in *American Steel Foundries v. Robertson*, 262 U. S. 209, and *United States ex rel Baldwin Company v. Robertson*, 265 U. S. 168, that this Court does have jurisdiction in such cases.

This Court has taken jurisdiction of *ex parte* 4915 actions without question in the following cases: *Gandy v. Marble*, 122 U. S. 432, and *Butterworth v. Hill*, 114 U. S. 128.

Furthermore, that an *ex parte* 4915 action is judicial in character is evidenced by the following decisions of this Court: *Tutun v. United States*, 270 U. S. 568, 46 S. Ct. 425, *Johannessen v. United States*, 225 U. S. 227, 32 S. Ct. 613, *Butterworth v. Hoe*, 112 U. S. 50, *Frasch v. Moore*, 211 U. S. 1, *Hull v. Commissioner of Patents*, 9 MacA. 90, *United States ex rel Bernardin v. Duell*, 172 U. S. 576. See also a decision by the Sixth Circuit Court of Appeals in *Cleveland Trust Company v. Berry*, 99 F. (2d) 517.

Statement of the Case.

On January 10, 1941, Curtis C. Coons, petitioner's assignor, filed an application for reissue patent in the United States Patent Office of his original patent 2,178,870 which had been granted November 7, 1939, upon an original application filed August 8, 1936. The invention of the application comprises a refrigeration system.

The Examiner in the Patent Office finally rejected Claims 15, 16, 38 and 39 (R. 115), stating that the claims were "rejected as not reading on applicant's disclosure and this rejection is Made Final." Upon appeal the Board of Appeals of the United States Patent Office affirmed the Examiner's decision (R. 131).

Claims 16, 38 and 39, which were finally rejected by the Examiner, originated in the Coons' reissue application. Claim 15 was copied from the patent to Bergholm 2,201,362 (R. 134) for purposes of interference to determine priority of invention.

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The *Bergholm* patent 2,201,362 (R. 134) was filed in the United States Patent Office on November 20, 1937, and issued as a patent on May 21, 1940, being assigned to Servel, Inc., a corporation of Delaware. Bergholm's earliest date in the record is over one year later than petitioner's.

Petitioner filed its complaint (R. 3) in the United States District Court for the District of Columbia under the provisions of Revised Statutes, 4915, U. S. C., Title 35, Section 63 (Appendix, p. 20), praying for the relief provided by Section 4915, R. S. The District Court in a decree (R. 14) dated June 21, 1943, dismissed the complaint, the decision being based upon the merits of petitioner's case. The only question considered by the District Court was the question of whether or not the claims were readable upon the Coons application construction.

Appeal (R. 15) was taken from the decision of the District Court for the District of Columbia to the Court of Appeals for the District of Columbia which, in a decision (R. 140) dated July 10, 1944, affirmed the judgment of the lower Court without touching the merits, the decision being based solely upon the grounds that "the District Court had no jurisdiction over this suit."

Specification of Errors.

The errors which the petitioner urges are that the Court of Appeals for the District of Columbia erred:

1. In affirming the dismissal of Petitioner's Bill of Complaint and upon the grounds that the District Court had no jurisdiction under the provisions of Section 4915 R. S.
2. In holding, contrary to past practice, that Petitioner was not entitled to relief under the provisions of Section

4915 R. S. after having been refused a patent by the Board of Appeals and because he had not established priority of invention over another claiming the same invention, the Patent Office having refused to set up an interference to determine the question of priority after having been requested to do so by Petitioner and in conformance with its long-established practice.

3. In holding, contrary to past practice, that Petitioner is not entitled to relief under Section 4915, R. S. because a third party, who was not an adverse party to Petitioner in the Patent Office, was not made a party defendant to the action in addition to the Commissioner of Patents, there having been a refusal to grant the patent to Petitioner by the Board of Appeals of the Patent Office but no interference or decision by the board of interference examiners.

4. In refusing to decide the case upon its merits and instead dismissing upon the grounds of lack of jurisdiction.

QUESTIONS BEFORE THE COURT.

The questions raised by the decision below involving the construction of the patent laws are:

Question 1.

Does Section 4915 R. S. (U. S. C., Title 35, Sec. 63) convey jurisdiction upon the District Court for the District of Columbia of an action begun by bill in equity by an applicant who has been refused a patent by the Board of Appeals where, if the Court holds for the applicant, further prosecution in the Patent Office may take place in "complying with the requirements of law"? (R. S. 4915 at Appendix, p. 20.)

Question 2.

In Section 4915 R. S. (U.S.C., Title:35, Sec. 63), which provides "Whenever a patent on application is refused by the Board of Appeals or whenever any applicant is dissatisfied with the decision of the board of interference examiners, the applicant . . . may have remedy by bill in equity . . .," does the word "or" mean "and," whereby action by both boards must precede applicant's right to the remedy provided?

Question 3.

In an action brought by an applicant for a patent under Section 4915, R. S. (U.S.C., Title 35, Sec. 63) against the Commissioner of Patents as defendant, and following a refusal by the Board of Appeals to grant the patent, is a third party claiming the same invention a necessary party when not involved in interference with the applicant to determine priority of invention but where an interference may be set up by the Patent Office if the Court holds for the applicant?

SUMMARY OF ARGUMENT.

1. Section 4915 R. S. Conveys Jurisdiction Upon The District Court For The District Of Columbia Of An Action Begun By Bill In Equity By An Applicant Who Has Been Refused A Patent By The Board Of Appeals And The Fact That Further Prosecution May Take Place In The Patent Office In "Complying With The Requirements Of Law," Should The Court Hold For The Applicant, Does Not Deprive The Court Of Its Jurisdiction.

(A. THE DECISION BELOW IS CLEARLY CONTRARY TO THE CONGRESSIONAL PURPOSE IN VIEW OF THE HISTORY OF THE REMEDY NOW PROVIDED BY SECTION 4915 R. S.

B. THE LAW HAS ALWAYS BEEN SO UNDERSTOOD BY THE COURTS AND THIS INTERPRETATION IS CONSISTENT WITH COORDINATE STATUTES.

a. *The Court's Mandate In An R. S. 4915 Suit Does Not Require Commissioner To Ignore "Other Requirements Of The Law."*

b. *The Refusal Of A Patent Upon Any Grounds Is Reviewable Under Section 4915 R. S.*

c. *The Remedy Under Section 4915 R. S. Is Co-Extensive With The Remedy Under Section 4911 R. S.*

d. *The Decisions Cited By The Court Below Do Not Support The Holding.*

C. THE DECISION OF THE COURT OF APPEALS IS INCONSISTENT WITH THE ACTUAL WORKING OF THE PATENT SYSTEM AND WITH THE RULES OF PRACTICE IN THE UNITED STATES PATENT OFFICE.

D. UNDER THE DECISION BELOW IT IS IMPOSSIBLE, FIRST, FOR A COURT EVER TO DETERMINE ITS JURISDICTION CONCLUSIVELY AND SECOND, FOR AN APPLICANT TO DETERMINE WHETHER BY BRINGING AN ACTION UNDER SECTION 4915 R. S. HE MAY NOT EFFECT THE ABANDONMENT OF HIS APPLICATION.

2. The Provision In Section 4915 R. S. Of A "Remedy By Bill In Equity" . . . "Whenever A Patent On Application Is Refused By The Board Of Appeals Or Whenever Any Applicant Is Dissatisfied With The Decision Of The Board Of Interference Examiners," Provides For Remedies Under Two Separate Conditions.

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3. In An Ex Parte Action Brought Under Section 4915 R. S. By An Applicant After Refusal Of A Patent By The Board Of Appeals, A Third Party Claiming The Same Invention Is Not A Necessary Party Where No Interference Between Applicant And The Third Party Was Instituted By The Patent Office.

ARGUMENT.

1. Section 4915 R. S. Conveys Jurisdiction Upon The District Court For The District Of Columbia Of An Action Begun By Bill In Equity By An Applicant Who Has Been Refused A Patent By The Board Of Appeals And The Fact That Further Prosecution May Take Place In The Patent Office In "Complying With The Requirements Of Law," Should The Court Hold For The Applicant, Does Not Deprive The Court Of Its Jurisdiction.

1A. THE DECISION BELOW IS CLEARLY CONTRARY TO THE CONGRESSIONAL PURPOSE IN VIEW OF THE HISTORY OF THE REMEDY NOW PROVIDED BY SECTION 4915 R. S.

The first legislation providing a defeated patent applicant with the right to file a bill in equity was enacted in 1836. The remedy has received a great deal of attention since. Because of the many enactments, and in order to present a clear history, charts are to be found on the pages immediately following which show the remedial steps followed by the patent applicant at various periods.

At the outset it may be well to state that an ex parte case is one in which only the applicant and the Commissioner of

Patents are parties. An inter partes case is one in which an interference has been set up in the Patent Office involving two or more patent applicants, or an applicant and a patentee. Only the Commissioner of Patents and adverse parties to an interference set up in the Patent Office can be made adverse parties in a suit brought under Section 4915 R. S. (Appendix, p. 20) (*Dracket Co. v. Chamberlain Co.*, 10 F. S. 85F, affirmed 81 F. (2d) 866; *Fessenden v. G. E.*, 10 F. S. 846).

While we are here solely interested in the ex parte case, both types of cases have been shown in the charts for their history is closely related. The charts now follow, being arranged chronologically:

CHART 1.

Act of 1836 (Appendix, p. 1)

5 Statutes at Large, 117

Approved July 4, 1836

Repealed July 8, 1870,

16 Statutes at Large,

Chapter 230, Section 111, p. 216

ex parte

inter partes

Sec.

Sec.

7

PATENT OFFICE

8

PATENT OFFICE

Sec.

Sec.

7

APPOINTED BD.
OF EXAMINERS

8

APPOINTED BD.
OF EXAMINERS

Sec. 16

& BILL IN EQUITY

Sec. 8

Comment: Equity suit provided in inter partes cases only.

Sec. 16 (Appendix, p. 4)

"Whenever a patent on application shall have been refused on an adverse decision of a board of examiners, on the ground that the patent applied for would interfere with an unexpired patent . . . may have remedy by bill in equity . . ."

CHART 2.

Act of 1839 (Appendix, p. 5)

5 Statutes at Large, 353

Approved March 3, 1839

Repealed July 8, 1870,

16 Statutes at Large,

(Chapter 230, Section 111, p. 216.

ex parte

inter partes

Sec.

7 of

1836

PATENT OFFICE

Sec.

8 of

1836

PATENT OFFICE

Sec.

11

CHIEF JUSTICE
OF DIST. OF
COLUMBIA

Sec.

11

CHIEF JUSTICE
OF DIST. OF
COLUMBIA

Sec.

10

BILL IN EQUITY

Sec.

10

BILL IN EQUITY

Comment: An appeal in the nature of the appeal now provided by Section 4911 R. S. provided. * * * An equity action possible in both types of cases.

Sec. 10 (Appendix, p. 3)

..... the provisions of the Sixteenth Section of the before-recited act (Act of 1836) shall extend to all cases where patents are refused for any reason whatever, either by the Commissioner of Patents or by the Chief Justice of the District of Columbia." (Parenthetical matter and italics added.)

Act of 1852

10 Statutes at Large, 75 (Walker p. 895),

Approved August 30, 1852

Repealed July 8, 1870,

16 Statutes at Large,

Chapter 230, Section 111, p. 216.

Section 1. *Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled*, That appeals provided for in the eleventh section of the act entitled "An Act in addition to an act to promote the progress of the useful arts, approved March the third, eighteen hundred and thirty-nine, may also be made to either of the assistant judges of the Circuit Court of the District of Columbia, and all the powers, duties and responsibilities imposed by the aforesaid act, and conferred upon the chief judge, are hereby imposed and conferred upon each of the said assistant judges."

CHART 3.

Consolidated Patent Act of 1870 (Appendix, p. 6)

16 Statutes at Large, 198

Approved July 8, 1870

Repealed June 22, 1874

Revised Statutes, Title LXXIV

ex parte		inter partes	
Sec. 41	PATENT OFFICE EXAMINER	Sec. 42	PATENT OFFICE EXAMINER
Sec. 46	BD. OF EXAMINERS IN-CHIEF	Sec. 46	BD. OF EXAMINERS IN-CHIEF
Sec. 47	COMMISSIONER	Sec. 47	COMMISSIONER
Sec. 48	SUPREME COURT OF DIST. OF COLUMBIA		
Sec. 52	BILL IN EQUITY	Sec. 52	BILL IN EQUITY

Comment: Appeal lies when "any of the claims" are rejected and the equity action lies when the patent is refused "for any reason whatever."

Appeals in inter partes cases dropped.

Appeal in ex parte cases now goes to Supreme Court of the District of Columbia.

Sec. 46 (Appendix, p. 7)

every applicant for patent, *any* of the claims of which have been twice rejected *may appeal* to the board of examiners-in-chief *(Italics added.)*

Sec. 48 (Appendix, p. 7)

That if such party, except a party to an interference, is dissatisfied *may appeal to the Supreme Court of the District of Columbia,*

Sec. 52 (Appendix, p. 7)

whenever a patent on application is refused, *for any reason whatever*, either by the Commissioner or by the Supreme Court of the District of Columbia, the applicant may have remedy *by bill in equity.* (Italics added.)

CHART 4.

Revised Statutes in 1874 (Appendix; p. 8)
 Approved June 22, 1874

ex parte

inter partes

PATENT OFFICE
 EXAMINER

PATENT OFFICE
 EXAMINER

Sec. 4909 BD. OF EXAMINERS-CHIEF R. S. Sec. 4909 BD. OF EXAMINERS-CHIEF R. S.

Sec. 4910 COMMISSIONER R. S. Sec. 4910 COMMISSIONER R. S.

Sec. 4911 SUPREME CT. OF DIST. OF COLUMBIA R. S.

Sec. 4915 BILL IN EQUITY R. S. Sec. 4915 BILL IN EQUITY R. S.

Comment: Procedure identical to that under 1870 Act. Wording changed slightly in revision. Equity action lies when patent is "refused" which provision is equal in breadth to the provision of the 1870 Act, that is, "refused, for any reason whatever."

Sec. 4909 (Appendix, p. 8)

"Every applicant for a patent * * * any of the claims of which have been twice rejected, and every party to an interference, may appeal * * * to the board of examiners-in-chief;" (Italics added.)

Sec. 4910 (Appendix, p. 8)

"If such party is dissatisfied * * * may * * * appeal to the Commissioner * * * (Italics added.)"

Sec. 4911 (Appendix, p. 8)

"If such party, except a party to an interference, is dissatisfied * * * may appeal to the Supreme Court of the District of Columbia * * * (Italics added.)"

Sec. 4915 (Appendix, p. 9)

"Whenever a patent on application is refused, either by the Commissioner of Patents or by the Supreme Court of the District of Columbia * * * the applicant may have remedy by bill in equity * * *"

CHART 6.

(Judiciary Act of 1893 (Appendix, p. 9)
Approved February 9, 1893

27 Statutes at Large, page 434, chapter 74

ex parte
PATENT OFFICE
EXAMINER

inter partes
PATENT OFFICE
EXAMINER

Sec. 4909 BD. OF EXAMIN-
R. S. ERS IN CHIEF

Sec. 4909 BD. OF EXAMIN-
R. S. ERS IN CHIEF

Sec. 4910 COMMISSIONER
R. S.

Sec. 4910 COMMISSIONER
R. S.

Sec. 9 CT. OF APPEALS
Act of OF DIST. OF
1893 COLUMBIA

Sec. 9 CT. OF APPEALS
Act of OF DIST. OF
1893 COLUMBIA

Sec. 4915 BILL IN EQUITY
R. S.

Sec. 4915 BILL IN EQUITY
R. S.

Comment: Appeals from decisions of Commissioner are possible in inter partes cases. All appeals are heard by Court of Appeals of the District of Columbia instead of the Supreme Court of the District of Columbia.

Sec. 9, Act of 1893 (Appendix, p. 9)

"That the determination of appeals from the decision of the Commissioner of Patents, now vested in the general term of the Supreme Court of the District of Columbia * * * is hereby vested in the Court of Appeals * * *; and in addition any party aggrieved by a decision of the Commissioner of Patents in any interference case may appeal therefrom to said Court of Appeals."

CHART 7.

Revised Statutes after Act of 1927 (Appendix, p. 9)
(Chapter 273, Secs. 8, 11, 44, Stat. 1336)

Approved January 4, 1927.

The change which the Act of 1927 effected in both ex parte and inter partes is well evidenced by the chart found on page 3 of Report No. 1889, 69th Congress, 2d Session, made by the Committee on Patents with respect to H.R. 13487. That chart is here copied:

(Before Act of 1927)
**PRESENT COURSE OF
PATENT APPEALS**

EXAMINER

**APPEAL TO BOARD OF
EXAMINERS-IN-CHIEF**

APPEAL TO COMMISSIONER OF PATENTS

**APPEAL TO COURT OF
APPEALS, D. C.**

**BILL IN EQUITY
SEC. 4915.**

**APPEAL TO COURT
OF APPEALS**

(After Act of 1927)
**PROPOSED COURSE OF
PATENT APPEALS**

EXAMINER

**APPEAL TO NEW BOARD
OF APPEALS IN
PATENT OFFICE**

**APPEAL TO COURT
OF APPEALS
D. C.** **BILL IN
EQUITY
SEC. 4915**

**APPEAL TO COURT
OF APPEALS**

Comment: The procedure in ex parte and inter partes cases is identical. The present course is that illustrated as existing after the Judiciary Act of 1893. The direct appeal to the Court of Appeals from the Board of Appeals was changed to the Court of Customs and Patent Appeals by the Act of March 2, 1929, c. 488, Sec. 3, 45 Stat. 1476. (Appendix p. 13.)

It is seen that continuously since 1836 the law has provided a remedy by bill in equity to the dissatisfied patent applicant. In 1836 the remedy was limited to inter partes cases but in 1839 ex parte and inter partes cases were placed upon an equal footing and a bill in equity could be filed "where patents are refused for any reason whatever." In the subsequent reenactment in the Consolidated Patent Act of 1870 the same wording was used only to be replaced four years later by the revisers of the statutes by a simpler, shorter wording. The Revised Statutes omitted the words "for any reason whatever" and provided the remedy "Whenever a patent on application is refused." It must be presumed that the revisers of the Statutes recognized the equivalence of the expressions. If a bill can be filed "when-ever" a patent is "refused" that right is not enlarged by adding "for any reason whatever." Section 4915 R. S. (Appendix, p. 20) today reads, and at the time the bill in this case was filed read, "Whenever a patent on application is refused."

It is also important to note that the right of appeal through successive steps to the Supreme Court of the District of Columbia was granted by the Act of 1870, Secs. 46, 47 and 48 (Appendix p. 7) where "any of the claims" of the application were twice rejected. It was not necessary that all the claims be rejected but only that at least one of them be twice, that is finally, rejected. This same provision is found today in Section 4909 R. S. (Appendix p. 18) and petitioner's claims were twice rejected (R. 113) by the Examiner.

From 1839 to 1927 an applicant, having "any" claim twice rejected, could take an ex parte appeal from the Patent Office to a court and thereafter, if still refused a patent containing the desired claim or claims, bring a bill

in equity. The equity suit directly followed the appeal and a careful study of the cases and of the statutes fails to disclose a single indication that an applicant having the right to appeal did not likewise have the right, if unsuccessful in the appeal, to proceed to the next succeeding step, the equity action.

In part 1B of this brief the decisions clearly establishing the equal scope of the appeal and the 4915 action are discussed.

Congress intended the Patent Act of 1927 (Appendix p. 9) to make the appeal under Section 4911 R. S. and the bill in equity under Section 4915 R. S. optional and alternate remedies. The statements found in the reports of the Committees on Patents in the House and in the Senate should be most persuasive.

As illustrated *supra* in Chart 7 prior to the Act of 1927 the remedy by appeal and the remedy by bill in equity were successive. Clearly, when arranged in successive steps the equity action must have had a scope at least equal to the scope of the appeal action or every unsuccessful appeal could not have been carried forward into a 4915 action. By the 1927 Act the appeal and the bill in equity are rearranged into optional, alternate, mutually exclusive remedies. No change in scope of either action was indicated in any way.

The favorable report of the House Committee on Patents, Report No. 1889, 69th Congress, 2d Session, as to H.R. 13487, rendered prior to the adoption of the 1927 Patent Act, reads as follows at page 2:

"The proposed bill has for its object the simplification and reduction of the number of appeals. It provides for the creation of a new Board of Appeals in the Patent Office, consisting of the examiners in chief,

the commissioner and assistant commissioners. Applicants may appeal direct from the examiner to this new board of appeals, thus cutting out one appeal in the Patent Office. *It then gives the option to the losing party to appeal to the Circuit Court of Appeals of the District of Columbia, or to file a bill in equity under section 4915.* If the appeal goes to the Court of Appeals and is defeated, the applicant's right to appeal is ended. If on the other hand a bill in equity, if filed, under section 4915, the losing party has preserved his right to again appeal to the Circuit Court of Appeals.

"It will thus be seen that under the proposed procedure *the defeated party has all the rights and remedies that he had under the old procedure, but the appeals are reduced so that there are but three appeals.*" (Italics supplied).

The favorable report of the Senate Committee on Patents on S. 4812, corresponding to H.R. 13487, was identified as Report No. 1313, 69th Congress, 2d Session. This report, also made prior to the adoption of the Act of 1927, contained a similar indication of intent at page 4 as follows:

"Section 8 rewrites Section 4911 of the Revised Statutes so as to provide for a simplified appeal from the Patent Office. Under present statutes an applicant whose case has been rejected or a losing party in an interference may appeal to the Court of Appeals of the District of Columbia and then if he is dissatisfied he may start proceedings de novo by filing a bill in equity in a United States district court, under Section 4915, and from the decision of that court he may appeal to the court of appeals. This procedure makes for very vexatious delays and the *object of the present bill is to permit one to have the decision of the Patent Office reviewed either by the court of appeals or by filing a bill in equity, but not both.* Therefore section 4911 has been rewritten to provide that an applicant may appeal to the court of appeals, but if he does so he

waives his right to proceed under Section 4915. Nevertheless, in order that the other party may not be deprived from his remedy under section 4915, it provides that he may serve notice upon the one who is taking the appeal to the court of appeals which would result in having the case transferred to the United States district court under section 4915." (Italics supplied).

Both the Senate and the House reports contained charts like Chart 7 *supra*.

The testimony before the Senate Committee on Patents on S. 4812 held December 21, 1926 prior to the adoption of the Patent Act of 1927, clearly brought out that those supporting the bill understood that under the new law the remedies of appeal and bill in equity would be alternate and optional.

The following is found on page 10 of the hearing on S. 4812, December 21, 1926:

Commissioner of Patents Robertson: * * * "So we have struck the happy medium of permitting him to take one of these courses, but not both."

Senator Stewart: * * * "That is the principle of election of remedies."

Commissioner Robertson: "Yes, sir. And the bar seems to be behind that. In fact it is practically unanimous. Mr. Fish, of Boston, who objects to two features of the bill but approves the bill generally, and I think agrees with us that that is a very good provision."

The following appears on page 8 of the report of the hearing:

Senator Shipstead: "Then you can go either to an equity court or a court of law?"

Commissioner Robertson: "One is a straight appeal from the Patent Office to the court, and the other is a proceeding in equity."

Mr. A. C. Paul, then chairman of the American Bar Association committee, in discussing a letter sent by Mr. Fish, distinguished patent lawyer and then president of the Boston Patent Law Association, said: (p. 11).

"This bill changes that so that if they go to the court of appeals they waive the right to file a bill in equity; and if they file a bill in equity, they cannot go to the Court of Appeals, because they have the alternate remedy."

It is believed that the history of the legislation clearly supports the long-accepted view that appeals under Section 4911 R. S. and bills in equity under Section 4915 R. S. are remedies of the same breadth. If the court below was correct in believing that an appeal under Section 4911 R. S. was the proper remedy, then it should have held that the bill in equity filed under Section 4915 R. S. was suitable.

THE LAW HAS ALWAYS BEEN SO UNDERSTOOD BY THE COURTS AND THIS INTERPRETATION IS CONSISTENT WITH COORDINATE STATUTES.

The decision of the court below, written by Justice Thurman Arnold, reverses the law as it has been understood and applied for over one hundred years. In the absence of any compelling necessity that decision does violence to the clear unambiguous language of the statute, ignores the clear implication of coordinate statutes, and creates confusion in the administration of the patent law in the United States Patent Office.

Section 4915 R. S. clearly gives an applicant the right to seek relief from the refusal of a patent by the Patent Office Board of Appeals by filing a bill in equity. *Gandy v. Marble*, 1887, 122 U. S. 432; *U. S. ex el Baldwin v. Robertson*, 265 U. S. 168; *Bakelite Corp. v. Nat'l. Auline, etc. Co.*, 83 F. (2d) 176.

Petitioner was refused a patent containing Claims 15, 16, 38 and 39 and was entitled to bring an action in the District Court for the District of Columbia against the Commissioner of Patents. The Court of Appeals below was of the opinion that the present case was not covered by the statute even though it fell within the precise wording thereof because of certain facts which appeared in the record of the case but *which facts might be true in any case ever brought under the statute*. These facts were that the record showed that further prosecution might be necessary in the Patent Office should the Court's decision be in favor of the applicant.

1Ba. The Court's Mandate In An R. S. 4915 Suit Does Not Require Commissioner To Ignore "Other Requirements of Law."

The statute itself provides that after a favorable decision in the action brought under Sec. 4915 R. S. (Appendix, p. 20) and in which the court "authorizes" the Commissioner of Patents to issue a patent, an applicant is only entitled to a patent upon "filing in the Patent Office a copy of the adjudication and otherwise complying with the requirements of law." The provision "otherwise complying with the requirements of law" clearly envisages the duty residing on the applicant of successfully overcoming any legal barrier raised by the Commissioner to the grant of a patent as "authorized" after the return of the application to the Patent Office; and the Courts have so stated.

In *Gandy v. Marble*, 1887, 122 U. S. 432, this Court said:

"All that the court which takes cognizance of the bill in equity, under Section 4915, is authorized to do is to adjudge whether or not 'The applicant is entitled, according to law, to receive a patent' and after an adjudication in his favor to that effect, the Commis-

sioner is not authorized to issue a patent unless the applicant otherwise complies with the requirements of law."

The same language "otherwise complying with the requirements of law" has been present in the statute since 1874 and prior to that time (1836-1874) the equivalent wording "otherwise complying with the requisitions of law" was used. Accordingly, the construction placed upon the words in *Gandy v. Marble*, *supra*, applies today.

In *Cleveland Trust Company v. Nelson*, D. C. E. D. Mich., 1931, 51 F. (2d) 276, 278, affirmed in *Cleveland Trust Co. v. Berry*, C. C. A. 6, 99 F. (2d) 517, the court said:

"* * *. Granted that the patent will not issue to the successful party until he has complied with the requirements of law, there is nothing in that provision that takes the proceeding outside of the class of cases or controversies. * * *"

In *Philadelphia Storage Battery Co. v. Zenith Radio Corp.*, C. C. A. 7th, (1941), 117 F. (2d) 642, 645, the Court said:

"We do not understand that section 4915 of the Revised Statutes contemplates that the court shall direct the Commissioner to issue a patent. This must be true because there are other matters which the department must decide favorably to Jacke's assignee before a patent can issue to it. The statute which authorizes the issuance of patents must be complied with in every respect, and we have no power under section 4915 to restrict those requirements."

In an action under 4915 R. S. it is not necessary that the court's mandate compel the Commissioner to grant the patent.

In *Monopower v. Coc*, D. C. D. C. 33 F. S. 934, (1940) the court said:

"My conclusion is that, unless, by appropriate proceedings in the Patent Office, it is determined that Roy E. Milliken and Word Milliken have priority of invention with respect to the claims here in controversy, the plaintiffs are entitled, according to law, to receive a patent for the inventions as specified in such claims, and that the plaintiffs are entitled to the relief sought by the complaint herein."

In *Vermont Farm Machinery Co. v. Marble*, 20 F. 117, it was held that the fact that the Commissioner was outside the court's jurisdiction and therefore could not be compelled to perform the court's mandate would not defeat the court's jurisdiction.

In *Pitman v. Coc*, 62 App. D. C. 365, 68 F. (2d) 412, (1933) the Court of Appeals, D. C., said:

"We can see no reason for holding that such a remedy (review of requirement for division) is confined to a review by the appellate court of the decisions of the Patent Office, and is denied in proceedings brought by the applicant for review in a court of equity. It is true that the remedies are diverse; and nevertheless the substantive rights of the applicants, which are the basis alike of the appeal and bill in equity, are identical. There is no reason to believe that Congress intended that any remedy which might be obtained by appeal should be more extensive or complete than that allowed by bill in equity. * * * (Parenthetical matter added.)"

In *Baldwin v. Robertson*, 265 U. S. 168, the action was a bill for an injunction under 4915 R. S. and this court held that the District Court had jurisdiction. Thus the court's mandate under 4915 R. S. does not compel the Commissioner to issue a patent without further action.

It is the usual practice in the Patent Office to consider the "other requirements of the law" when a case is returned to the Patent Office after a favorable decree under

Section 4915 R. S. Examples of this practice are: *Gold v. Newton*, 254 F. 824; *Radlke Patents Corp. v. Coe*, 74 App. D. C. 251; 122 F. (2d) 937; *Tully v. Robertson*, 19 F. (2d) 954. Rule 96, Rules of Practice of the Patent Office (Appendix, p. 25), states:

"After judgment of priority the application of any party may be held for revision and restriction, subject to interference with other applications."

The same is true after a case is allowed *ex parte*. The above rule applies whether the judgment is by the examiner or the Court under Section 4915 R. S. Subsequent Patent Office prosecution could comprise a previously anticipated or newly discovered interference as provided in Section 4904 R. S. (Appendix, p. 17). That subsequent interferences do occur is evidenced by the facts of many cases, see *Gold v. Newton*, 254 F. 824; *Radlke Patent Corp. v. Coe*, 122 F. (2d) 937. Subsequent Patent Office prosecution might also comprise action for the first time upon the merits of an invention, as in a case in which the Board of Appeals refused a patent upon the sole grounds that the applicant could not claim the invention at all, as in *Steinmetz v. Allen*, 192 U. S. 543; *Frasch v. Moore*, 211 U. S. 1, and *Pitman v. Coe*, 68 F. (2d) 412.

The concept that the District Court has no jurisdiction where further proceedings may take place in the Patent Office upon the return of the application is believed to be obvious error. The statutory duty placed upon the Commissioner by the Revised Statutes, Section 4904 (Appendix, p. 17) and Rules 94 and 95 of the Rules of Practice in the United States Patent Office (Appendix, pp. 23, 24,) require the Commissioner to exercise the judicial function (*Ewing v. U. S. ex rel Fowler Car Co.*, 244 U. S. 1) of determining the existence or non-existence of an interference with respect to the application. In the case in which an

applicant obtained the allowance of the claims for the first time in a 4915-action the Commissioner would not have had the opportunity previously to exercise this function, the patentability of the claims to the various parties being a prerequisite for an interference (R. 94, Appendix, p. 23). If the Court of Appeals recognizes the duty resting upon the Commissioner then logically it can never take jurisdiction of an action brought under Section 4915 R. S.

Trade-mark cases brought under Section 4915 R. S. are subject to the "same rules of practice and procedure" (*American Steel Foundries v. Robertson*, 262 U. S. 209; *Atkins v. Moore*, 212 U. S. 285) as in patent cases. The Court of Appeals for the District of Columbia does not deny its jurisdiction in such cases where upon returning to the Patent Office further prosecution may take place in "complying with the requirements of law," as is evidenced by its decision in the case of *Thorne, Neale and Co. v. Cae*, 143 F. (2d) 155, 62 U. S. P. Q. 22, decided after the present case was argued.

If the Patent Office prosecution of an application must have been completed in order properly to bring an action under Section 4915 R. S. then a great number of actions have been brought under Section 4915 R. S. in error, both before and after the Act of 1927 (Appendix, p. 11) in which the appeal and the bill in equity are made alternate remedies. Where the grounds of rejection was one of estoppel, or where claims were copied from a patent for purposes of interference, or where an interference was dissolved and the claims were later rejected on any grounds, or where the record showed that another party was claiming the same invention, further Patent Office prosecution would clearly be necessary and have been heard by the District Courts in error. Examples are: *Barrett v. Ewing*, 242 F. 506, C. C. A.

2nd, 1917; *Gold v. Newton*, 254 F. 824, C. C. A. 2nd, 1918; *International Cellucotton Products Co. v. Coe*, 85 F. (2d) 869, App. D. C. 1936; *Du Pont v. Coe*, 89 F. (2d) 679, App. D. C. 1937; *American Cyanamid v. Coe*, 106 F. (2d) 851, App. D. C. 1939; *American Viscose Corp. v. Coe*, 106 F. (2d) 849, App. D. C. 1939; *Power Patents Co. v. Coe*, 110 F. (2d) 550, App. D. C. 1940; *Bendix Aviation Corp. v. Coe*, 61 U. S. P. Q. 78, D. C. D. C. 1943; *Bates et al v. Coe*, 40 U. S. P. Q. 220, D. C. D. C.; *Tinnerman Products v. Coe*, 50 F. S. 337, D. C. D. C.; *Gyro Process Co. v. Coe*, 107 F. (2d) 195, 42 U. S. P. Q. 413. It is to be presumed that the Courts in these cases assumed the duty which was theirs of determining their own jurisdiction. *Minnesota v. Hitchcock*, 185 U. S. 373; *Reid v. U. S.* 211 U. S. 529.

A detailed discussion of many specific cases in which subsequent prosecution in the Patent Office would necessarily take place after the decision in a 4915 action is set forth hereinafter under part 1 C.

That a decision not going to the merits but instead requiring an applicant to divide his application and claim parts of his invention in separate applications is "final and appealable" was determined by this Court in *Steinmetz v. Allen*, 192 U. S. 543. The Court there said:

"True, a distinction can be made between his ruling and one on the merits, if we regard the merits to mean invention, novelty or the like. But in what situation would an applicant for a patent be? If he yield to the rule he gives up his right of joinder. If he does not yield he will not be heard at all, and may subsequently be regarded as having abandoned his application. See. 4894, Rev. Stats. A ruling having such effect must be considered as final and appealable."

In the *Steinmetz* case Steinmetz was seeking a writ of *mandamus* to compel the Commission to forward his appeal from the Examiner making the requirement of division to the Examiners-in-Chief (now Board of Appeals). This Court's decision was that the Examiner's holding was "final." Clearly an affirmance of the Examiner by the Board of Appeals upon appeal would render the decision no less "final."

1Bb. *The Refusal Of A Patent Upon Any Grounds Is Reviewable Under Section 4915 R. S.*

Revised Statute 4915 (Appendix, p. 20) provides a remedy by bill in equity when a "patent or application is refused" by the Board of Appeals. No limitation is provided as to the grounds of the Board's refusal. Clearly in the performance of its judicial function (*Butterworth v. Hoe*, 112 U. S. 50; *U. S. ex. rel. Bernardin v. Duell*, 172 U. S. 576; *Ex parte Frasch*, 192 U. S. 566; *American Steel Foundries v. Robertson*, 262 U. S. 209; *Cleveland Trust Co. v. Berry*, 99 F. (2d) 517; *Steinmetz v. Allen*, 192 U. S. 543; *Johannessen v. U. S.*, 225 U. S. 227; *Frasch v. Moore*, 211 U. S. 1; the Board can base its decision upon any ground it sees fit, as can a Court in making a decision. The decision is final so far as the applicant is concerned for he is deprived of his patent. It is no less final, from his aspect, merely because subsequent prosecution may be necessary should the decision be reversed. The decision of the lower Court adding limitations as to the grounds upon which the "patent or application is refused" and still bring the refusal within the statute must be considered judicial legislation.

The refusal of a patent upon one ground has the same final effect as the refusal upon another ground and Section 4915 R. S. does not distinguish. Petitioner was re-

refused a patent containing certain claims upon the grounds that they did not read upon his invention (R. 129). Frash, in the case *Frash v. Moore*, 211 U. S. 1, was denied a patent because of his refusal to comply with a requirement of division, there having been no action upon the merits. Frash appealed to the Court of Appeals for the District of Columbia which then had the jurisdiction now residing in the Court of Customs and Patent Appeals under Section 4911 R. S. (U. S. C. Title 35, Sec. 35a) Appendix, p. 19). This Court in dismissing the appeal and writ of error and in denying *certiorari* said:

"... the decision of that Court (in the action under Section 4911 R. S.) may be challenged generally and a refusal of patent may be reviewed and contested by bill (under Section 4915 R. S.) as provided." (Parenthetical matter added.)

1Be. *The Remedy Under Section 4915 R. S. Is Co-extensive With The Remedy Under Section 4911 R. S.*

In *Baldwin Co. v. Robertson*, 265 U. S. 168, 44 Sup. Ct. 508, a trade-mark case to which the provisions of Section 4915 R. S. apply in the same manner as to a patent case, the plaintiff had filed his bill under Section 4915 R. S. seeking an *injunction* to prevent the Commissioner from canceling certain trade-marks. Against jurisdiction it was argued that Section 4915 R. S. did not authorize the action. Mr. Chief Justice Taft said, in rejecting the defendant's contentions:

"The next inquiry is whether, in addition to such appeal and after it proves futile, the applicant is given a *remedy by bill in equity as provided for a defeated applicant for a patent in § 4915, Rev. Stats.* We have in the cases cited given the closing words of § 9 a liberal construction in the view that Congress intended by them to give every remedy in respect to trade marks

that is afforded in proceedings as to patents, and have held that under them a bill of equity is afforded to a defeated applicant for trade mark registration just as to a defeated applicant for a patent. It is not an undue expansion of that construction to hold that the final words were intended to furnish a remedy in equity against the Commissioner in every case in which by § 9 an appeal first lies to the Court of Appeals. This necessarily would give to one defeated by the Commissioner as a party to an application for the cancellation of the registration of a trade-mark, after an unsuccessful appeal to the advisory supervision of the Court of Appeals, a right to resort to an independent bill in equity against the Commissioner to prevent cancellation." (Italics supplied).

As the statute is not to be distinguished in its application to trade-mark and patent cases it is clear that the appeal and the subsequent 4915 action are too extensive.

The case of *Baldwin v. Robertson* should not be left without also emphasizing the scope of the remedy held available under Section 4915 R. S. The bill sought an injunction and not a determination that the plaintiff was entitled to receive a trade-mark registration. The statute provides that if the finding be in favor of the applicant the court "shall authorize the commissioner to issue such patent." There is no express provision here as to the issuance of an injunction and the holding of this Court clearly shows the liberality with which this statute has been interpreted in the past.

The case of *Clements v. Kirby*, C. C. A. 6th, 1921, 274 F. 575, 586, was an *inter partes* action under Section 4915 R. S. and in which the jurisdiction of the Court was in question. The Court said:

"It is well established that the court appealed to under Section 4915 has full jurisdiction to re-examine all matters determined by the Court of Appeals."

That appeal under R. S. 4911 and a bill in equity under R. S. 4915 are alternative remedies since the amendment of 1927 has been determined by the courts.

In *Wettlaufer v. Robins*, (C. C. A. 2) 92 F. (2d) 573, (1937) the court said:

"Thus, for many years, it had been the policy of Congress to permit an applicant who was refused a patent by the departmental tribunals of the Patent Office—and even after review by the Court of Appeals of the District of Columbia—to have his asserted property right to the invention determined de novo by a court of original jurisdiction."

"The purpose of the amendments was to reduce the number of appeals in the Patent Office (35 U. S. C. A. Sec. 7) to require a *defeated applicant to elect between appealing to the Court of Appeals of the District of Columbia and suing under Section 4915* as amended (35 U. S. C. A. Sec. 63), and, when applicant in an interference appealed from the Board of Appeals, to permit his adversary to have the appeal dismissed and further proceedings conducted by bill in equity (35 U. S. C. A. Sec. 59a). Thus *no refused applicant was to be deprived of his right to sue in equity after an adverse decision by the Board of Appeals, except by his own election to appeal to the Court of Appeals of the District of Columbia, or, if such appeal was dismissed at the instance of his adversary, by his own failure to file his bill within thirty days thereafter.*" (Italics supplied.)

In *Chase v. Cor*, 31 F. S. 935 affirmed by the Court of App. D. C., 122 F. (2d) 198, the court said:

"* * * it (the passage of the Act of 1927) is evidence of the intention of Congress to require an election by the party as between the two remedies offered to him: * * * (Parenthetical matter added.)"

Revised Statute, Section 4915 was subsequently amended on March 2, 1929. The Circuit Court of App. 2nd, in *Bake-life Corp. v. Nat'l Aniline & Chemical Co.*, 83 F. (2) 176 said:

"In the subsequent reenactment of the statute; substantially in the same form, this prior judicial construction although rendered by an inferior court is at least persuasive indication of the interpretation adopted by Congress."

In *Pitman v. Coc*, 68 F. (2d) 412, (1933) the Court of App. D. C., said:

" * * * These two remedies lie to different courts. They differ in procedure, the one is an appeal upon the record of the Patent Office, and the other is an original suit in a court of equity. The latter proceeding calls for a trial de novo with all the customary power of an equity court to hear the evidence fully and to make its own findings. Although these two methods of procedure are alternatives, they are nevertheless analogous and are designed to secure essentially the same legal remedy."

" * * * We can see no reason for holding that such a remedy is confined to a review by the appellate court of the decisions of the Patent Office, and is denied in proceedings brought by the applicant for review in a court of equity. It is true that the remedies are diverse; nevertheless the substantive rights of the applicants, which are the basis alike of the appeal and bill in equity, are identical. *There is no reason to believe that Congress intended that any remedy which might be obtained by appeal should be more extensive or complete than that allowed by bill of equity.* It follows that a refusal to grant a patent based upon a controversy arising from an order of division is reviewable by either proceeding. The difference between the two is a difference of procedure rather than a difference of interest. In this view of the case we think that the lower court possessed jurisdiction to

hear and decide the question notwithstanding that the refusal of the patent was based upon an order of division of claims made in the Patent Office." (Italics supplied.)

In *Bakelite Corporation v. National Aniline and Chemical Co.*, (C. C. A. 2) 83 F. (2d) 176, 1936, the court said:

"It cannot be doubted that the statute, as it now reads, means to give alternative remedies to an applicant, to whom a patent has been refused. He may appeal, in which case he waives his right to proceed under section 63 of this title' (35 U. S. C. A. 59a); or he may have his remedy by bill in equity, unless appeal has been taken from the decision of the board of appeals to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided, in which case no action may be brought under this section."

The remedies provided by Section 4911 R. S. and Section 4915 R. S. have, since 1927, been considered as "alternative and mutually exclusive" (*Hemphill Co. v. Coe*, App. D. C. 121 F. (2d) 897 (1941) remedies available to the applicant refused a patent in the Patent Office (*Jensen v. Lorenz*, 92 F. (2d) 992, *certiorari* denied, 302 U. S. 751). This fact is also clearly evidenced by the wording of Section 4911 R. S. which in part reads as follows:

"If any applicant is dissatisfied with the decision of the Board of Appeals, he may appeal to the United States Court of Customs and Patent Appeals, in which case he waives his right to proceed under Section 4915 of the Revised Statutes."

The Patent Office clearly recognizes the equivalence of the remedies as evidenced by Rule 149 (Appendix, p. 31) of the Rules of Practice in the United States Patent Office which provides:

"If an applicant in an ex parte case appeals to the U. S. Court of Customs and Patent Appeals he waives his right to proceed under Section 4915 R. S. (U. S. C. Title 35, Sec. 63)."

"From adverse decisions by the Board of Appeals in ex parte cases and from decisions of the Board of Interference Examiners, the appellant, if an applicant, has the option of proceeding under Section 4915 R. S. instead of appealing directly to the U. S. Court of Customs and Patent Appeals."

The law as laid down in the statutes, in the decisions of the courts, and as deducible from the practice before the courts is in agreement with petitioner's contention that the District Court had jurisdiction. Those decisions and that practice are consistent with the interpretation of Section 4915 R. S. in the light of its history as discussed in part 1A of this brief. As was stated in the "Memorandum for the Commissioner of Patents" (p. 9) prepared by the Solicitor General in reply to petitioners "Petition for a Writ of Certiorari":

"It (the decision below) is admittedly inconsistent with past practice under Rev. Stat. 4915." (Parenthetical matter inserted.)

1Bd. *The Decisions Cited By The Court Below Do Not Support the Holding.*

The Court below said (R. 142):

"Turning now to the cases we find an explicit ruling by the Supreme Court that a proceeding under Section 4915 R. S. cannot select a single issue which affects plaintiff's right to a patent, without determining all the other issues on which that right depends.";

citing *Hill v. Wooster*, 132 U. S. 693.

Actually all that was held in *Hill v. Wooster* was that in an inter parte action under 4915 the question of patent

ability is always present. In *Hill v. Wooster* it appeared that the subject matter of the interference was unpatentable and the Court so held. In *inter partes* 4915 actions the Commissioner is not a necessary party and usually is not a party, and, accordingly, the Court properly protects the public interest by inquiring into the patentability of the subject matter. Should new evidence appear in the case, or should the Court be of the opinion that the issues are unpatentable, clearly it should have the power to so rule and this the Court did in *Hill v. Wooster*.

In an *ex parte* case, however, the Commissioner of Patents is the sole party defendant and there is no reason for the Court to assume that the public interest is not being protected. All reasons which the Commissioner wishes to raise to oppose the applicant's right to a patent, he can raise in his answer and does so except where under the accepted procedure an issue of priority is to be determined by subsequent prosecution in the Patent Office.

Under the law (Section 4904 R. S.) (Appendix, p. 17) the issues must be determined to be patentable to each of the interfering parties before the interference can be contested. The statute in itself is substantially a complete answer to the contention that *Hill v. Wooster* should be interpreted sufficiently broadly as to imply that the issue of priority should be contested before the question of patentability has been determined. To permit the questions of patentability and priority to be raised simultaneously, the question of priority being determined for the first time by the Court in a 4915 action, would be to substitute the Court for the Patent Office which, obviously, is not the intent of the law, the Patent Office being the agency specifically named by Congress to perform those duties.

In *Butterworth v. Hoe*, 112 U. S. 50 (1884), cited by the lower Court in a footnote, this Court merely defined the

nature of the action contemplated by Section 4915, and, in emphasizing the de novo character thereof, distinguished it from an appeal under Section 4911. This case did not touch upon the jurisdictional questions raised in the present case.

The Court below cited *Synthetic Plastics Company v. Ellis-Foster Company*, 78 F. (2d) 847, C. C. A. 3rd, 1935, and *Cherry-Burrell Corporation v. Coe*, 62 U. S. P. Q. 20, as authority for the proposition that the Court had no jurisdiction over intermediate proceedings in the Patent Office.

The *Synthetic Plastics Company Case* was an R. S. 4915 action seeking the review of the granting of a motion to dissolve an interference which the Court said was an interlocutory and not a final order. The order dissolving an interference is not final and appealable even under Section 4911 R. S. and, accordingly, it is not surprising that the Court was held to have no jurisdiction under 4915 R. S.

In the *Cherry-Burrell* case, the Court held that it had no jurisdiction to pass on the patentability of claims which were refused entry by the Patent Office after a decision by the Board of Appeals on other claims. Actually all the Court held was that it had no jurisdiction to pass on the patentability of claims which had not been considered by the Patent Office and therefore not twice rejected, that is, finally refused.

In *Hazeltine Corporation v. White*, 68 F. (2d) 715, C. C. A. 2d, 1934, cited by the Court below as authority for the proposition that the patentee Bergholm was an indispensable party below, does not support that contention. In the *Hazeltine* case, three parties were involved in an interference in the Patent Office and an award of priority was made

to one of them. One of the losers brought an action under R. S. 4915 in the District Court of the Second Circuit while, at the same time, a three-party R. S. 4915 action was pending in the District Court for the District of Columbia. The Court merely held that the third party to the interference was an indispensable party and that it would be futile to decide the case as between the two parties when another case was already pending in which all parties to the controversy were before the Court. It should be noted that in the *Hazeltine* case there had actually been an interference in the Patent Office so that the opposing parties were properly adverse parties under the law as discussed in part 3 of this brief. In the instant case, however, no interference having been set up in the Patent Office, there are no adverse parties other than the Commissioner.

The Court below also cited in a footnote the case of *Smith v. Carter Carburetor Corporation*, 130 F. (2d) 555, C. C. A. 3d, 1942, as supporting the proposition that the rival claimant is an adverse party and that issue of readability may be a most crucial one. That the issue may be crucial is clearly evidenced by the fact that it was grounds upon which the petitioner's claims were rejected by the Patent Office. The fact that the rival claimants were adverse parties in the *Smith v. Carter Carburetor Corporation* case is entirely proper under the law, (see part 3 of this brief) there having been an interference involving these parties in the Patent Office. In the present case there was no interference, the Commissioner having refused to set one up.

1C. THE DECISION OF THE COURT OF APPEALS IS INCONSISTENT WITH THE ACTUAL WORKING OF THE PATENT SYSTEM AND WITH THE RULES OF PRACTICE IN THE UNITED STATES PATENT OFFICE.

The view held by the Court of Appeals as to the reasons for the refusal of a patent is entirely inconsistent with the facts and procedures as they exist in the Patent Office.

Many applications having a simple, straightforward history of prosecution in the Patent Office might, under the lower court's holding, be entitled to the relief of Section 4915 R. S. A great many other applications, however, and often through no intent of the applicant, have more involved prosecutions in the Patent Office and to refuse the statutory relief to these cases is clearly without sound reason. The applicant, if denied his patent, is entitled to the remedy provided regardless of the complexity of the previous prosecution. Eight examples of cases in which the statutory remedy would be denied by the decision below and for no sound reason, are as follows:

a. In a case in which the refusal of the patent is upon the grounds of estoppel for failure to bring a motion as provided by Rule 109 (Appendix, p. 8), Rules of Practice of the Patent Office.

Where the applicant's patent is refused *ex parte* upon the grounds of estoppel and where the award of priority in an interference is upon the grounds of estoppel, the record in a subsequent action brought under Section 4915 R. S. will show this fact and will also show that a subsequent interference may be necessary upon a favorable decision for the complainant. Under the doctrine of the instant case applicants in such cases would be deprived of their right to file the bill in equity under Section 4915 R. S. The Court refers to two such cases (*International Cellulose Products Co. v. Coc*, 85 F. (2d) 869; *American Cyanamid Co. v. Coc*, 106 F. (2d) 851) in the decision below. Prior to the present decision the Courts have passed upon many such cases under Section 4915 R. S.

b. In cases where the claims are copied from a patent and are later rejected.

In the instant case one of the four claims was copied from the Bergholm patent (R. 134) for purposes of interference and, with the other three claims, was refused by the Patent Office. The same situation was present in the concurrently decided case, *Colgate-Palmolive-Peet Co. v. Coc*, 144 F. (2d) 517, 62 U. S. P. Q. 121, in which the instant case was cited as the law supporting the above proposition. As a matter of fact the subsequent interference may never materialize for the patentee cannot be forced into an interference. He may disclaim, or he may file a reissue application, and omit the copied claim.

c. In any case in which an interference is dissolved upon any grounds.

The doctrine of *Hoover v. Coc* as decided below will deny all applicants the right to have the refusal of their patent reviewed by bill in equity under Section 4915 R. S. where the applicant was previously involved in an interference and the interference was dissolved under the governing Patent Office rules upon any grounds whatsoever. The lower Court has so applied the law of *Hoover v. Coc* in *Line Material et al. v. Coc*, 144 F. (2d) 518, 62 U. S. P. Q. 120.

d. In any case in which a party is eliminated from a multi-party interference upon the ground that he is not entitled to make the claim.

In such a case the interference would continue to an award of priority with the eliminated party prosecuting his application *ex parte*. *Gyro Process Co. v.*

Coe, 70 App. D. C. 390, 107 F. (2d) 195. Under the doctrine of *Hoover v. Coe* the parties to the interference and the *ex parte* applicant would have no right to a bill in equity under Section 4915 R. S. for, should the eliminated applicant subsequently prove his right to make the interference counts, a second interference would have to be instituted.

e. In the case in which some of an applicant's claims have been allowed.

The Court below, in holding that applicant had no right to a bill in equity under Section 4915 R. S. when only certain of his claims had been refused, in effect held that unless all of the claims were refused there had been "no refusal of a patent" as provided in Section 4915 R. S. This is contrary to a long established practice, *Gyro Process Co. v. Coe*, 107 F. (2d) 195; *Tully v. Robertson*, 19 F. (2d) 954; *Steinmetz v. Allen*, 192 U. S. 543; *Frasch v. Moore*, 211 U. S. 1. Under the doctrine of this case an applicant who has, for example, one narrow claim allowed would be denied the right to file his bill in equity. A patent with a narrow claim is not the same as a patent with a broad claim. An applicant denied protection to which he is entitled is denied the patent to which he is entitled.

f. In a case in which the Board of Interference Examiners made a recommendation under Rule 126 (Appendix, p. 29) of the Rules of Practice in the United States Patent Office.

The Board of Interference Examiners may make a recommendation under Rule 126 (Appendix, p. 29) of the Rules of Practice in the Patent Office to the effect that after a judgment of priority in an interference, consideration should be given to any matter affecting the right of any party to a patent. Application of this

recommendation obviously would require further proceedings in the Patent Office after the determination of the issue of priority in an *inter partes* 4915 action, and would under the decision below, preclude the right to 4915 relief.

g. In a case in which the refusal of a patent is upon the grounds that the applicant had previously elected a different invention, or where the patent is refused upon the failure of the applicant to comply with a requirement for division.

In this case the patent would be refused upon the technical grounds and action upon the merits would necessarily follow a reversal of the Patent Office in an action brought under Section 4915 R. S. This holding, if unreversed, would comprise a complete bar to applicant's right to a patent yet under the decision in the instant case the applicant would be given no right to contest the matter under Section 4915 R. S. The lower Court's decision on this point is inconsistent with the decisions of this Court in *Steinmetz v. Allen*, 192 U. S. 543, *Ex parte Frasch*, 192 U. S. 566, *Frasch v. Moore*, 211 U. S. 1.

h. In any case in which an application has been involved in an interference in the Patent Office.

If jurisdiction does not reside with the District Court when further Patent Office prosecution may be necessary then the Courts will never have jurisdiction in a case involving an application which has been involved in an interference in the Patent Office. In such cases Rule 96 (Appendix, p. 25) specifically provides for further proceedings in the Patent Office including the possibility of a further interference.

The Commissioner of Patents is the administrative body specifically designated by Congress to administer the Patent Laws insofar as the issuance of patents are concerned; Section 484 R. S. (U. S. C., Title 35, Section 6) (Appendix, p. 16).

There can be no doubt that the administrative rules set up by the administrative body having jurisdiction of the administration of an act of Congress over a long period of time, during which the act was frequently amended with such rules in view, should be virtually conclusive as to the interpretation of the statutes in question. *Dismuke v. U. S.*, 297 U. S. 167; *Scott Logan v. Davis*, 233 U. S. 613; *Kern River Co. v. U. S.*, 257 U. S. 147; *U. S. v. State of Minnesota*, 270 U. S. 181; *U. S. v. Jackson et al.*, 280 U. S. 183; *United States v. Moore*, 95 U. S. 760; *Hastings et al. v. Whitney*, 132 U. S. 357; *United States v. Alabama G. S. R. Co.*, 142 U. S. 615; *Kindred v. Union P. R. Co.*, 225 U. S. 582.

Under the decision below practically all of the rules of the Patent Office relating to the administration of R. S. Sec. 4904 (Appendix, p. 17) will have to be changed if an applicant's rights provided by statute are to be preserved. These rules "have the force and effect of law" (*Ewing v. United States, ex rel. Fowler Car Co.*, 244 U. S. 1), and comprise "an authority under the United States" (*Steinmetz v. Allen*, 192 U. S. 543, 556).

Rules 93, 94, 95 and 96 of the Rules of Practice in the Patent Office (Appendix pp. 22, 23, 24, 25) require that the counts or claims be patentable to all parties before an interference is declared. The Court below in refusing the remedy of Section 4915 R. S. to petitioner said:

"Before plaintiff here is entitled to a patent it must establish priority over the patent from which the claims are copied." (R. 142).

But the Patent Office had refused petitioner's request (R. 6, 115) to set up an interference to determine the question of priority holding that the claimed subject matter was not patentable to petitioner and so, under Rules 93, 94, 95 and 96, that an interference was not proper. (*Ewing v. U. S. ex rel Fowler Car Co.*, 244 U. S. 1, 7).

If in the opinion of the Commissioner, the claims were not patentable to applicant, clearly the Patent Office did not err in refusing to set up the interference for, under Section 4904 R. S. (Appendix p. 17), it is the "opinion of the Commissioner" which determines whether an interference is to be declared. Petitioner's right to those claims was a prerequisite to an interference in the Patent Office yet the Court below demands the impossible, and requires the interference before it will determine petitioner's right to a patent containing those claims.

Rule 63(d) of the Rules of Practice in the United States Patent Office (Appendix p. 22) provides for rejecting claims copied from a patent, as in petitioner's case, and for ex parte appeal from such rejection within a set time limit. The rule also provides that failure to appeal within the set time will be "deemed a disclaimer of the invention claimed." This was petitioner's exact position. His failure to proceed ex parte to a higher tribunal would have effected a permanent bar to his right to a patent containing the subject matter of interest. Conceivably this subject matter is the only matter of real importance in his application. The lower Court views the refusal to applicant of a patent containing such subject matter, even though it is final and appealable, as merely procedural and so not such as to entitle an applicant to his remedy under Section 4915 R. S. Such a view is irreconcilable with the doctrine of *Steinmetz v. Allen*, 192 U. S. 543, discussed *supra*.

Rule 96 of the Rules of Practice (Appendix, p. 24) in the United States Patent Office provides for the setting up of other interferences after a judgment of priority in a first interference. Had petitioner managed to have the interference set up, and had he taken the opposing party before the lower Court, all of which that Court held necessary to its own jurisdiction (R. 142), the fundamental objection raised

by the Court would not have been cured. Upon the return to the Patent Office after a favorable decision petitioner, under the provisions of Rule 96, might have been confronted by still another interference. This second interference he might lose and the patent "authorized" by the Court would never issue. To the lower Court such a result was objectionable in that the mandate of the Court would be ignored (R. 145). When it is remembered, however, that the Statute Section 4915 R. S. specifically provides that an applicant is entitled to a patent after a favorable decision in a 4915 action only upon "otherwise complying with the requirements of the law" the objection raised by the lower Court is more difficult to understand.

Rules 111, 116, 122, 123 and 124 in the United States Patent Office (Appendix pp. 27, 28, 29) relate to motions to dissolve and with the dissolution of interferences. No award of priority is made upon the dissolution of an interference. In many instances a party's right to engage in an interference is denied after the interference has been declared rather than before as in petitioner's own case. An applicant whose application had been in a dissolved interference would, under the doctrine of the decision below, be forever barred from his remedy under Section 4915 R. S. for a favorable decision might necessitate the reinstatement of the dissolved interference.

Rule 126 (Appendix, p. 29) has to do with calling the Commissioner's attention to facts, which came to the notice of the board of interference examiners and which would indicate that the claims are unpatentable to either party and provides for further proceedings in the Patent Office in such a case.

Rule 130 (Appendix, p. 29) of the Patent Office has to do with the question of raising patentability of the issue to

an opponent as a basis for a priority decision only when a motion had been duly brought.

Rule 133 (Appendix, p. 30) provides for appeals to the Board of Appeals and includes the question of division or previous election which do not go to the merits in the sense of novelty, patentability, etc., and the decision of which would not end the prosecution of the case before the Patent Office.

Rule 141 (Appendix, p. 30) specifically provides for further proceedings in the Patent Office after a decision by an appellate tribunal.

And Rule 149 of the Rules in the United States Patent Office (Appendix p. 31), as discussed above, is a clear-cut statement of the understanding of the Commissioner of Patents and of the Patent Office as to the statutory law and with that understanding the decision below is irreconcilable. The rule reads in part:

"From adverse decisions by the board of appeals in ex parte cases and from decisions of the board of interference examiners, the appellant, if an applicant, has the option of proceeding under Section 4915 R. S. instead of appealing directly to the U. S. Court of Customs and Patent Appeals."

All of the foregoing rules are inconsistent with the decision below and are consistent with the concept of further proceedings in the Patent Office after a favorable decision in a suit brought under Section 4915 R. S. Under the decision below, if the District Court is to have jurisdiction further proceedings must not take place in the Patent Office. If an applicant's rights under Section 4915 R. S. are to be preserved, under the decision below those rules must be changed.

The Commissioner of Patents has the duty of issuing valid patents to the true inventors, (Sec. 4886 R. S., Appendix p. 17). No decision by a court can force him to issue an invalid patent unless the issues raised by his refusal to grant the patent are res adjudicata. The statute leaves it to the opinion of the Commissioner as to when interferences should be declared. (Sec. 4904 R. S., Appendix p. 17) Rule 94 of the Rules of Practice (Appendix p. 23) clearly establishes that in the "opinion" of the Commissioner no interference should be set up until the claims to the same invention "are allowable in all the applications involved." It follows then, that whenever claims are rejected and a patent refused there may be a potential interference which has never been indicated. Clearly an applicant's right to the relief of Section 4915 R. S. particularly in view of the history thereof and in view of the decisions of the courts, should not be made to depend upon incidental mention of the existence of a future interference when it is an indisputable fact that such an interference is a possibility in every case.

An interference is a costly time-consuming procedure. To require every patentee to defend his right to claims against all comers, whether having any color of right there to or not, is clearly not desirable from the standpoint of the patentee or the Patent Office. Orderly procedure clearly cries out against the decision below.

1D. UNDER THE DECISION BELOW IT IS IMPOSSIBLE, FIRST, FOR A COURT EVER TO DETERMINE ITS JURISDICTION CONCLUSIVELY, AND SECOND, FOR AN APPLICANT TO DETERMINE WHETHER BY BRINGING AN ACTION UNDER SECTION 4915 R. S. HE MAY NOT EFFECT THE ABANDONMENT OF HIS APPLICATION.

The decision of the Court below, as applied in subsequent decisions of that Court, bases jurisdiction of the

District Court in a 4915 action upon an indeterminant factor comprising the degree of likelihood of further proceedings in the Patent Office.

In *Colgate-Palmolive-Peet Company v. Coe*, 144 F. (2d) 517, 62 U. S. P. Q. 121, the doctrine of the present case was applied, while in *Minnesota Mining Company v. Coe*, 62 U. S. P. Q. 119, the doctrine was not applied. These cases were decided on the same day. The facts were substantially the same. In each case the record disclosed that a subsequent interference might take place if the decree was in favor of the complainant, and that the complainant would be the senior party in such interference.

In the present case and in the *Colgate* case the doctrine was applied and jurisdiction denied, the Court below in effect holding that the possibility of future proceedings was too proximate. In the *Minnesota Mining* case the doctrine was considered and not applied, the Court below holding in effect that the possibility of future proceedings was too remote.

If the decision below is not reversed, the District Courts will have difficulty in deciding when it does and when it does not have jurisdiction. By the same token applicants will never know whether or not to file a bill under Section 4915 R. S. and take the chance of losing the right of review both under Section 4911 R. S. and Section 4915 R. S.

The only circumstance in which a court could be sure that its determination of its jurisdiction in a 4915 action is well based, under the decision below, is the case in which it positively appears in the record that subsequent prosecution will take place in the Patent Office. Then the court would know, under the decision below, that it had no jurisdiction. In every other circumstance the court in determining its jurisdiction would be confounded by the knowledge

that upon the return of the application to the Patent Office further prosecution might ensue. As examples of subsequent prosecution which may arise in any case:

1. The application returns to the Patent Office and the Commissioner is "of the opinion" that it should be placed in an interference. He sets this interference up under Section 4904 R. S. The opposing application might have been filed after the filing of the 4915 action. The future interference could not have been foreseen in such a case.

2. The application returns to the Patent Office and the Commissioner discovers anticipatory art, previously unknown, which completely negatives the applicant's right to a patent under the statutes even though he was successful in the 4915 action. Under the law (Section 4886 R. S.) (Appendix p. 16) the Commissioner cannot issue a patent to one not entitled to it and accordingly he must ignore the mandate of the court.

Just as the court could never be sure of its jurisdiction so the applicant refused a patent could never be certain that if he filed his bill in equity under Section 4915 R. S. he would not be abandoning his application and possibly all rights to a patent.

Under the decision the decisions of the Patent Office can become final and adverse to the applicant in all cases where a bill under Section 4915 R. S. is filed. The Commissioner need only state in his answer that, should the decree be favorable to the applicant, further proceedings in the Patent Office will be necessary. The District Courts would then, under the law of this case, lack jurisdiction. The 40-day period for appeal under Section 4911 R. S. to the Court of Customs and Patent Appeals would have long since passed. See Rule 149 (Appendix p. 31) Rules of Practice

of the Patent Office and Rule XXV of the Court of Customs and Patent Appeals (Appendix, p. 32). The applicant (as has petitioner in this case) would then be deprived of his right to review under Section 4911 R. S. and the decision of the Patent Office would be final insofar as applicant was concerned.

It would appear reasonable to assume that the remedy provided by Section 4915 R. S. will become a hollow shell without substance if the decision below remains the law. For the reasons above suggested applicants would fear to file their bill in equity. Clearly a surprising ending for an action which has had the color and the history of Revised Statute 4915.

2. The Provision In Section 4915 R. S. Of A "Remedy By Bill In Equity" . . . "Whenever A Patent On Application Is Refused By The Board Of Appeals Or Whenever Any Applicant Is Dissatisfied With The Decision Of The Board Of Interference Examiners," Provides For Remedies Under Two Separate Conditions.

Section 4915 R. S. Appendix, p. 32, clearly provides a patent applicant in the United States Patent Office with remedies in two distinct cases. He may file a bill in equity:

(1) "Whenever a patent on application is refused by the Board of Appeals"

"or"

(2) "Whenever . . . dissatisfied with the decision of the board of interference examiners."

The decision of the Court below refuses to grant an applicant the remedy of (1) unless (2) is also present in any case where an interference might be set up at a later date. The word "or" is interpreted to mean "and."

The decision below requires that the interference be set up even though the Commissioner is of the opinion that none should exist. Such a holding is clearly inconsistent with the holding of this Court in *Ewing v. Fowler Car Co.* (244 U. S. 1). The Court there said:

"If it could be conceded that there is antagonism between Sec. 4904, and the rules, the former must prevail. *Steinmetz v. Allen*, 192 U. S. 543, 565. But there is no antagonism. The former provides that 'when-ever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending application. * * * he shall direct the primary examiner to proceed to determine the question of priority of invention.' The section, therefore, commits to the opinion (judgment) of the Commissioner the effect of an application upon a pending one—whether it will interfere with a pending one; something more, therefore, than the fact of two applications, something more than the mere assertion of a claim. The assertion must be, in the opinion of the Commissioner, an interference with another. And it is this other that is first in regard, not to be questioned except at the instance of the Commissioner by an exercise of judgment upon the circumstances. And there is no defeat of ultimate rights; there may be postponement of their assertion remitted to a suit in equity under Sec. 4918."

The same case is authority for the statement that in the present case the applicant could not mandamus the Commissioner to institute the interference which the lower Court contends must exist if it is to have jurisdiction.

The holding below clearly ignores the express provisions of Section 4904 R. S. (Appendix, p. 17), which reads in part as follows:

"Whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending application, or with an un-

expired patent, he * * * shall direct a board of three examiners of interferences to proceed to determine the question of priority of invention." (Italics added.)

It also ignores Rule 94 (Appendix, p. 23) of the Rules of Practice in the United States Patent Office which rules comprise an authority "under the United States" (*Steinmetz v. Allen*, 192 U. S. 543, 556). Rule 94 provides:

"Interferences will be declared between applications by different parties for patent or for reissue when such applications contain claims for substantially the same invention *which are allowable in the application of each party*, and * * * between applications for patent, or for reissue, and unexpired original or re-issued patents, of different parties, when such applications and patents contain claims for substantially the same invention *which are allowable in all of the applications involved*; * * * " (Italics added.)

To arrive at its holding the Court of Appeals must interpret "or" to be "and" and in doing so violates established principles of statutory interpretation.

In interpreting any statute in the absence of ambiguity, the ordinary meaning of its words and language control. *Maillard v. Lawrence*, 16 How. 251; *United States v. Wiltberger*, 5 Wheat. 76; *Ruggles v. Illinois*, 408 U. S. 526; *Putman v. Longley*, 28 Mass. 487.

It is well settled that conjunctive words are to be construed as disjunctive, and vice versa, when and only when it is necessary to effectuate the obvious intention of the legislature. *Beasley v. Parnell*, 177 Ark. 912, 9 S. W. (2d) 10; *In re Steinruck's Insolvency*, 74 A. 360, 225 Pa. 461; *Weir v. Bauer*, 286 Pa. 936; *State v. Tiffany*, 44 Wash. 602, 87 P. 932; 59 C. J. 986, Sec. 584; *Gar Creek Drainage Dist. v. Wagner*, 256 Ill. 338, 100 N. E. 190, 193; *Aurora*

Brewing Co. v. Ind. Bd. of Ill., 277 Ill. 142, 115 N. E. 207; *Voight v. Indus. Comm.*, 297 Ill. 109, 130 N. E. 470; *State ex rel. Normile v. Cooney*, 100 Mont. 391, 47 P. (2d) 637.

If any question remains as to the fact that the word "or" is used in its disjunctive sense in Section 4915 R. S. it is believed that the history of the remedy, see part 1A *supra*, will readily dispel the doubt. By the Act of 1836 (Chart 1) the remedy was available only in inter parte cases. By the law of 1839 it was made available when the patent was "refused for any reason whatever". That provision was subsequently contracted in the Revised Statutes of 1894 to a shorter "refused", the meaning remaining as before.

It is believed that the holding in the decision below that the court could have no jurisdiction because petitioner had not contested priority of invention with Bergholm was clearly error. Petitioner had been finally refused the claims and therefore a patent containing those claims, the patent he sought, had been refused. No more was needed to give jurisdiction under Section 4915 R. S.

3. In An Ex Parte Action Brought Under Section 4915 R. S. By An Applicant After Refusal Of A Patent By The Board Of Appeals, A Third Party Claiming The Same Invention Is Not A Necessary Party Where No Interference Between Applicant And The Third Party Was Instituted By The Patent Office.

The Court below held it "had no jurisdiction over this suit" and gave as a reason that "The party against whom the plaintiff claims priority is not before the court" (R. 142).

The bill of complaint in the District Court (R.3) did not name any other party defendant than the Commissioner of Patents, nor did it claim priority with respect to any

other party save to allege (R. 6, paragraph 15) that the claimed invention of complainant's application was "new and useful and was not known or used by others in this country before Coons' invention thereof," as is required to entitle an applicant to a patent under Section 4886 R. S. (Appendix, p. 16). The Commissioner of Patents' answer (R. 8) did not deny the allegation of the complaint which, under F. R. C. P. 8(d) (Appendix, p. 32), was to be taken as admitted. As the Commissioner is the officer charged by law with the duty (Section 481 R. S.) (Appendix, p. 16) of issuing patents, this admission on the face of the pleadings was entitled to full acceptance.

There had been no interference in the Patent Office and there were no other adverse parties which could properly have been named parties defendant. *Druck H Co. v. Chamberlain Co.*, 10 F. S. 851, affirmed 81 F. (2d) 866; *Coe v. Hobart*, 102 F. (2d) 270; *Fessenden v. W. E.*, 10 F. S. 846. In the latter case the Court said:

"Plaintiff can bring no suit against the defendant in this or any other court because of an attempt to have an interference proceeding followed by the dissolution thereof. His only cause of action is against the Commissioner of Patents on the assumption that the dissolution of the interference proceedings, because of assumed lack of disclosure of the invention claimed, is equivalent to a denial of the patent. * * *

Coe v. Hobart, 102 F. (2d) 270, was a 4915 action in which the Court of Appeals, D. C., said:

"Those cases hold that when an interference proceeding is terminated without a decision concerning priority, the situation is the same as if there had been no interference proceeding; the rival claimant is not an adverse party within the meaning of Section 4915, since there was no ruling that the trade-marks be-

longed to it, and one claimant may not sue the other under Section 4915, but must sue the Commissioner of Patents."

In *United States ex. rel. The Fowler Car Company v. Ewing*, 244 U. S. 1, this court said:

"Before the declaration of an interference all preliminary questions must be settled by the Primary Examiner, * * *"

The District Court's jurisdiction as to such parties would be under the provisions of the second paragraph of Section 4915 R. S. (Appendix, p. 20) and the decisions deny such jurisdiction of another applicant or patentee in a 4915 action where no interference had been instituted in the Patent Office.

The decision below upon this point is directly contrary to the same court's decision in the trade-mark case decided after the instant case was argued. *Thorne, Neale and Co. v. Coc*, 143 F. (2d) 155, 62 U. S. P. Q. 22. That trade-mark cases are parallel to patent cases has been mentioned before and has been definitely established. *Atkins v. Moore*, 212 U. S. 285; *American Steel Foundries v. Robertson*, 262 U. S. 209; *U. S. ex rel Baldwin v. Robertson*, 265 U. S. 168.

The holding below that the Court cannot give judgment authorizing the Commissioner to issue a patent to applicant containing the claims in issue in the absence of other parties claiming the same invention is inconsistent with Section 4918 R. S. (Appendix, p. 21). That statute clearly provides for the determination of the adverse interests of interfering patents.

The requirement that a potential future adverse party be made a party defendant in an *ex parte* 4915 suit, represents a departure from the practice followed in a long line of cases. In all cases in which the applicant is denied a pat-

ent upon the grounds of estoppel to make claims and where a subsequent interference would result should he succeed in a 1915 action the present holding in the lower Court requiring the naming of the potential interferant as a defendant is applicable. Cases evidencing that over a period of many years the Court below has not required the presence of the potential future interferant in such cases are here listed: *International Cellucotton Products Co. v. Coc*, 85 F. (2d) 869, App. D. C. 1936; *Du Pont v. Coc*, 89 F. (2d) 679, App. D. C. 1937; *American Cyanamid v. Coc*, 106 F. (2d) 851, App. D. C. 1939; *American Viscose Corp. v. Coc*, 106 F. (2d) 849, App. D. C. 1939; *Power Patents Co. v. Coc*, 110 F. (2d) 550, App. D. C. 1940; *Bendix Aviation Corp. v. Coc*, 61 U. S. P. Q. 78, D. C. D. C. 1943; *Bates et al. v. Coc*, 40 U. S. P. Q. 220, D. C. D. C.; *Tinnerman Products v. Coc*, 50 F. S. 337, D. C. D. C.; *Gyro Process Co. v. Coc*, 107 F. (2d) 195, 42 U. S. P. Q. 413. The Court of Appeals in the Second Circuit also has taken jurisdiction of such cases. *Gold v. Newton*, 254 F. 824; *Barrett v. Facing*, 242 F. 506. It is to be presumed that the Court in all of these cases assumed its duty of determining its jurisdiction. *Minnesota v. Hitchcock*, 185 U. S. 373; *Reid v. U. S.*, 211 U. S. 529.

Orderly procedure is inconsistent with the requirement that a patentee or an applicant having claims to an invention should be placed under the burden of defending every action involving such claims against adverse parties having no possible right thereto. The present procedure requiring an applicant to establish his right to claims before inviting the interference is consistent with such procedure.

CONCLUSIONS.

It is believed to be clear that the decision below represents a denial of a right which has been unquestioned for over one hundred years, the right of an applicant for a

patent to bring suit in a court of equity when refused a patent containing the protection to which he believed himself entitled. That right is provided today by Section 4915 R. S.

There appears to be no compelling reason at this time to overturn a statutory interpretation which has controlled for so long a period of time. Were the established interpretation and practice truly violative of the language and the spirit of the Statute the decision below could be more readily accepted. Instead it is the new interpretation which ignores the history of the Statute, the ordinary and long-accepted meaning of the language used, the effect of related statutes, the established rules and practice in the United States Patent Office, the fact that subsequent prosecution in the Patent Office is a possibility in every case, and finally the impossibility of any court or any applicant ever determining accurately the question of jurisdiction in a 4915 action under the doctrine of the decision.

The Memorandum for the Commissioner of Patents, prepared by the Solicitor General and other able attorneys, aptly stated the weak basis for the decision below, saying:

"The Court found reasons of policy to support its conclusion." (p. 5).

What policy was it which compelled the conclusion in view of the obviously objectionable features thereof? As understood that policy is deducible from the following statement by the Court (R. 142):

"The idea that a court of equity should interfere with the proceedings of an administrative tribunal by a trial de novo at a stage when no decision on the merits can be given is contrary to the fundamental concept of equity jurisdiction."

This "policy" and the decision are inconsistent with the holding of this Court in *Steinmetz v. Al n*, 192 U. S. 543.

in which the requirement of the Examiner that the applicant divide his application was held to be "final and appealable." This Court there said (page 556):

"True, a distinction can be made between his ruling and one on the merits, if we regard the merits to mean invention, novelty or the like. But in what situation would an applicant for a patent be? If he yield to the rule he gives up his right of joinder. If he does not yield he will not be heard at all, and may subsequently be regarded as having abandoned his application. Section 4894, Rev. Stat. A ruling having such effect must be considered as final and appealable."

The Examiner's holding in *Steinmetz v. Allen* did not conclude the Patent Office prosecution. It did not in petitioner's case. In each case the holding raises a bar to the applicant getting the patent to which he feels himself entitled and so is "final and appealable."

Also unfortunate for the "policy" and for the decision below are the forcible statements made by this Court in *United States v. Duell*, 172 U. S. 576, in which it was held that Congress could provide for judicial interference with an action of the Patent Office and that the power to do so could not be successfully questioned as being an encroachment upon the judicial department. This Court said:

"Since, under the Constitution, Congress has power 'to promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries,' and to make all laws which shall be necessary and proper for carrying that expressed power into execution, it follows that Congress may provide such instrumentalities in respect of securing to inventors the exclusive right to their discoveries as in its judgment will be best calculated to effect that object."

"* * * The nature of the thing to be done being judicial, Congress had power to provide for judicial

interference through a special tribunal, *United States v. Coc*, 155 U. S. 76; and a *fortiori* existing courts of competent jurisdiction might be availed of."

The "policy" and the decision are based upon a fundamental misconception that the prosecution before the Patent Office must be complete before the court can have jurisdiction. The Statute giving the district court jurisdiction gives direct recognition to the fact that subsequent Patent Office prosecution may occur when it states:

"And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication *and otherwise complying with the requirements of law*". (Section 4915 R. S., (Appendix, p. 20). (Italics supplied).

Further prosecution in the Patent Office is possible and actually probable in every case arising under Section 4915 R. S. Related statutes and the Rules of Practice in the United States Patent Office make subsequent prosecution a definite likelihood in every case.

The decision below is vulnerable to the criticism that it renders the right provided by Revised Statute 4915 a sterile, hollow shell. A suit properly brought could be rendered improper merely by the Commissioner stating in his answer that should the complainant-applicant prevail subsequent proceedings, newly recognized, would be necessary in the Patent Office. As the alternate right to appeal under Section 4911 R. S. expires in forty days (Appendix, pp. 19, 31, 32) after the final decision in the Patent Office that remedy would have been lost, probably before the bill was filed and certainly before the answer. The applicant's application would be lost, the district court ruling that it had no jurisdiction, and with it the applicant's right to a patent. No one would dare to bring suit under Section 4915 R. S.

It is clear that Section 4915 R. S. expressly provides for relief in two types of cases, ex parte and inter parte. The wording of the Statute supports this statement, as does the history of the equitable remedy. To require, as does the decision below, that an interference be contested before one of the parties has established his right to be a party to the interference, is clearly inconsistent with orderly procedure and places an unnecessary burden upon the Patent Office, upon all applicants and upon interfering patentees. To require, in order to vest jurisdiction in the district court under Section 4915 R. S., that the patent be refused not only ex parte, that is, by the Board of Appeals, but also inter partes, that is, by the board of interference examiners, is to refuse to accept the clear meaning of the language of the Statute and is also a refusal to give weight to the practical aspects of the situation; to wit, that an application is never simultaneously before the Board of Appeals and the board of interference examiners.

The requirement of the decision below that Patent Office prosecution be completed before the 4915 action be brought makes it possible for the Examiner to deprive the applicant of his right ever to contest his right to a patent except on a single, narrow claim. The Examiner could accomplish this by twice rejecting all of the claims except the narrowest upon which final decision would be delayed. Section 4909 R. S. provides an appeal when "any of the claims * * * have been twice rejected." Applicant's right to the narrowest would not have been determined and, as further prosecution would be required to make the determination, an action under Section 4915 R. S. could not properly be brought under the decision below and the applicant would be forced to rely upon the appeal provided by Section 4911 R. S. Upon the return of the case to the Patent Office the applicant's right

to the remaining narrow claim would be determined and, from an adverse holding upon this narrow claim, applicant would have the right to bring a 4915 action under the decision below. If the rule of *Chase v. Coe*, 122 F. (2d) 198, App. D. C., (1941) is applied, then even the right to contest this narrow claim by a 4915 action would be lost, the case having once been the subject matter of an appeal under 4911 R. S.

It was obvious, however, that the equitable remedy would not have been available to applicant when the determination of his right to the important phases of the invention was at stake and, instead, would have been restricted to the determination of his right to the narrowest of the claims. It is difficult to believe that Congress had such an intention in enacting Section 4915 R. S. The problem confronting petitioner in the present case is no different from that confronting applicant in the hypothetical case proposed. (R. 113).

This Court said, in the case of *Armstrong Paint and Varnish Works v. Nu-Enamel Corporation et al*, 305 U. S. 315, 59 S. Ct. 191, 200:

"This Court has had several occasions within the last few years to construe statutes in which conflicts between reasonable intention and literal meaning occurred. We have refused to nullify statutes, however hard or unexpected the particular effect, where unambiguous language called for a logical and sensible result. Any other course would be properly condemned as judicial legislation. However, to construe statutes so as to avoid results glaringly absurd, has long been a judicial function. Where, as here, the language is susceptible of a construction which preserves the usefulness of the section, the judicial duty rests upon this Court to give expression to the intendment of the law."

The only point of tangency between the Patent Office and the Constitutional courts comprises the suit in equity provided by Section 4915 R. S. If this remedy is destroyed, and the decision of the court below effectively destroys it, there will not hereafter be any opportunity for Constitutional courts to bring their views and opinions to bear directly upon the Patent Office and its views of substantive and adjective patent law. The appeal provided by Section 4911 R. S. to the Court of Customs and Patent Appeals cannot be appealed to this court, (*Postum v. California Fig Nut Co.*, 272 U. S. 693 (1927); *Baldwin v. Howard*, 256 U. S. 35, 44 S. Ct. 508, (1921)) the Court of Customs and Patent Appeals being an administrative tribunal.

The desirability of influencing the Patent Office and its practices by contact with courts of general law is believed to be very clear. Courts of limited jurisdiction tend to become narrow and technical in their views and holdings and if the 4915 remedy is eliminated, the tempering influence which has been so beneficial in the past will no longer be present.

Section 4915 R. S. and its predecessors giving the same remedy in substantially the same language have been interpreted in accordance with petitioner's contentions, as indicated by the unvaried practice, since 1839. No case supporting the position of the court below was noted. In *Dismuke v. United States*, 297 U. S. 167, 56 Sup. Ct. 400, 404 the Court stated relative to a statutory interpretation which had stood for a period of fifteen years:

"A construction of such long standing is not lightly to be overturned."

In short, the decision below comprises an undesirable departure entirely unwarranted in the absence of compell-

ing necessity which, if it exists, remains entirely unindicated. For this and other reasons set forth herein this Court is respectfully urged to reverse the decision below and to render such other relief as is deemed proper.

Respectfully submitted,

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APPENDIX.

APPENDIX.

The Patent Act of 1836.

SECTION 7. *And be it further enacted*, That on the filing of any such application, description, and specification, and the payment of the duty hereinafter provided, the Commissioner shall make, or cause to be made, an examination of the alleged new invention or discovery; and if, on any such examination, it shall not appear to the Commissioner that the same had been invented or discovered by any other person in this country prior to the alleged invention or discovery thereof by the applicant, or that it had been patented or described in any printed publication in this or any foreign country, or had been in public use or on sale with the applicant's consent or allowance prior to the application, if the Commissioner shall deem it to be sufficiently useful and important, it shall be his duty to issue a patent therefor. But whenever, on such examination, it shall appear to the Commissioner that the applicant was not the original and first inventor, or discoverer thereof, or that any part of that which is claimed as new had before been invented or discovered, or patented, or described in any printed publication in this or any foreign country, as aforesaid, or that the description is defective and insufficient, he shall notify the applicant thereof, giving him, briefly, such information and references as may be useful in judging of the propriety of renewing his application, or of altering his specification, to embrace only that part of the invention or discovery which is new. In every such case, if the applicant shall elect to withdraw his application, relinquishing his claim to the model, he shall be entitled to receive back twenty dollars.

part of the duty required by this act, on filing a notice in writing of such election in the Patent Office, a copy of which, certified by the Commissioner, shall be a sufficient warrant to the treasurer for paying back to the said applicant the said sum of twenty dollars. But if the applicant in such case shall persist in his claims for a patent, with or without any alteration in his specification, he shall be required to make oath or affirmation anew, in manner as aforesaid. And if the specification and claim shall not have been so modified as, in the opinion of the Commissioner, shall entitle the applicant to a patent, he may, on appeal, and upon request in writing, have the decision of a board of examiners, to be composed of three disinterested persons, who shall be appointed for that purpose by the Secretary of State, one of whom at least, to be selected, if practicable and convenient, for his knowledge and skill in the particular art, manufacture, or branch of science to which the alleged invention appertains; who shall be under oath or affirmation for the faithful and impartial performance of the duty imposed upon them by said appointment. Said board shall be furnished with a certificate in writing of the opinion and decision of the Commissioner, stating the particular grounds of his objection, and the part or parts of the invention which he considers as not entitled to be patented. And the said board shall give reasonable notice to the applicant, as well as to the Commissioner, of the time and place of their meeting, that they may have an opportunity of furnishing them with such facts and evidence as they may deem necessary to a just decision; and it shall be the duty of the Commissioner to furnish to the board of examiners such information as he may possess relative to the matter under their consideration. And on an examination and consideration of the matter by such board, it shall be in their power, or the majority of them, to reverse the decision of the Commissioner, either in whole or in part, and their opinion being certified to the Commissioner, he shall be governed thereby.

in the further proceedings to be had on such application: *Provided however*, That before a board shall be instituted in any such case, the applicant shall pay to the credit of the treasury, as provided in the ninth section of this act, the sum of twenty-five dollars, and each of said persons so appointed shall be entitled to receive for his services in each case a sum not exceeding ten dollars, to be determined and paid by the Commissioner out of any moneys in his hands, which shall be in full compensation to the persons who may be so appointed, for their examination and certificate as aforesaid.

SECTION 8. *And be it further enacted*, That whenever an application shall be made for a patent which, in the opinion of the Commissioner, would interfere with any other patent for which an application may be pending, or with any unexpired patent which shall have been granted, it shall be the duty of the Commissioner to give notice thereof to such applicants, or patentees, as the case may be; and if either shall be dissatisfied with the decision of the Commissioner on the question of priority of right or invention, on a hearing thereof, he may appeal from such decision; on the like terms and conditions as are provided in the preceding section of this act; and the like proceedings shall be had, to determine which or whether either of the applicants is entitled to receive a patent as prayed for. But nothing in this act contained shall be construed to deprive an original and true inventor of the right to a patent for his invention, by reason of his having previously taken out letters patent therefor in a foreign country, and the same having been published, at any time within six months next preceding the filing of his specification and drawings. And whenever the applicant shall request it, the patent shall take date from the time of the filing of the specification and drawings, not however exceeding six months prior to

the actual issuing of the patent; and on like request, and the payment of the duty herein required, by any applicant, his specification and drawings shall be filed in the secret archives of the office until he shall furnish the model and the patent to be issued, not exceeding the term of one year, the applicant being entitled to notice of interfering applications.

SECTION 16: *And be it further enacted*, That whenever there shall be two interfering patents, or whenever a patent on application shall have been refused on an adverse decision of a board of examiners, on the ground that the patent applied for would interfere with an unexpired patent previously granted, any person interested in any such patent, either by assignment or otherwise, in the one case, and any such applicant in the other case, may have remedy by bill in equity; and the court having cognizance thereof, on notice to adverse parties, and other due proceedings had, may adjudge and declare either the patents void in the whole or in part, or inoperative or invalid in any particular part or portion of the United States, according to the interest which the parties to such suit may possess in the patent or the inventions patented, and may also adjudge that such applicant is entitled, according to the principles and provisions of this act, to have and receive a patent for his invention, as specified in his claim, or for any part thereof, as the fact of priority of right or invention shall in any such case be made to appear. And such adjudication, if it be in favor of the right of such applicant, shall authorize the Commissioner to issue such patent, on his filing a copy of the adjudication, and otherwise complying with the requisitions of this act. *Provided however*, That no such judgment or adjudication shall affect the rights of any person except the parties to the action and those deriving title from, or under them subsequent to the rendition of such judgment.

The Patent Act of 1839.

SECTION 10. *And be it further enacted*, That the provisions of the sixteenth section of the before-recited act shall extend to all cases where patents are refused for any reason whatever, either by the Commissioner of Patents or by the Chief Justice of the District of Columbia, upon appeals from the decision of said Commissioner, as well as where the same shall have been refused on account of, or by reason of, interference with a previously existing patent; and in all cases where there is no opposing party, a copy of the bill shall be served upon the Commissioner of Patents, when the whole of the expenses of the proceeding shall be paid by the applicant; whether the final decision shall be in his favor or otherwise.

SECTION 11. *And be it further enacted*, That in all cases where an appeal is now allowed by law from the decision of the Commissioner of Patents to a board of examiners, provided for in the seventh section of the act to which this is additional, the party, instead thereof, shall have a right to appeal to the Chief Justice of the district court of the United States for the District of Columbia, by giving notice thereof to the Commissioner, and filing in the Patent Office, within such time as the Commissioner shall appoint, his reasons of appeal specifically set forth in writing, and also paying into the Patent Office, to the credit of the patent fund, the sum of twenty-five dollars. And it shall be the duty of said Chief Justice, on petition, to hear and determine all such appeals, and to revise such decisions in a summary way, on the evidence produced before the Commissioner, at such early and convenient time as he may appoint, first notifying the Commissioner of the time and place of hearing, whose duty it shall be to give notice thereof to all parties who appear to be interested therein, in such manner as said judge shall prescribe. The Commissioner shall also lay before the said judge all the original papers

and evidence in the case, together with the grounds of his decision, fully set forth in writing, touching all the points involved by the reasons of appeal, to which the revision shall be confined. And at the request of any party interested, or at the desire of the judge, the Commissioner and the examiners in the Patent Office may be examined under oath, in explanation of the principles of the machine or other thing for which a patent, in such case is prayed for. And it shall be the duty of said judge, after a hearing of any such case, to return all the papers to the Commissioner, with a certificate of his proceedings and decision, which shall be entered of record in the Patent Office; and such decision, so certified, shall govern the further proceedings of the Commissioner in such case: *Provided however*, That no opinion or decision of the judge in any such case shall preclude any person interested in favor or against the validity of any patent, which has been or may, hereafter be granted from the right to contest the same in any judicial court, in any action in which its validity may come in question.

• **The Consolidated Patent Act of 1870.**

SECTION 41. *And be it further enacted*, That whenever, on examination, any claim for a patent is rejected for any reason whatever, the commissioner shall notify the applicant thereof, giving him briefly the reasons for such rejection, together with such information and references as may be useful in judging of the propriety of renewing his application or of altering his specification; and if, after receiving such notice, the applicant shall persist in his claim for a patent, with or without altering his specifications, the commissioner shall order a re-examination of the case.

SECTION 42. *And be it further enacted*, That whenever an application is made for a patent which, in the opinion of the commissioner, would interfere with any pending application, or with any unexpired patent, he shall give notice

thereof to the applicants, or applicant and patentee, as the case may be, and shall direct the primary examiner to proceed to determine the question of priority of invention. And the commissioner may issue a patent to the party who shall be adjudged the prior inventor, unless the adverse party shall appeal from the decision of the primary examiner, or of the board of examiners-in-chief, as the case may be, within such time, not less than twenty days, as the commissioner shall prescribe.

SECTION 46. *And be it further enacted*, That every applicant for a patent or the reissue of a patent, any of the claims of which have been twice rejected, and every party to an interference, may appeal from the decision of the primary examiner, or of the examiner in charge of interference[s], in such case to the board of examiners-in-chief, having once paid the fee for such appeal provided by law.

SECTION 47. *And be it further enacted*, That if such party is dissatisfied with the decision of the examiners-in-chief, he may, on payment of the duty required by law, appeal to the commissioner in person.

SECTION 48. *And be it further enacted*, That if such party, except a party to an interference, is dissatisfied with the decision of the commissioner, he may appeal to the Supreme Court of the District of Columbia, sitting in banc.

SECTION 52. *And be it further enacted*, That whenever a patent on application is refused, for any reason whatever, either by the commissioner or by the Supreme Court of the District of Columbia upon appeal from the commissioner,

the applicant may have remedy by bill in equity; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim, or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent, on the applicant filing in the Patent Office a copy of the adjudication, and otherwise complying with the requisitions of law. And in all cases where there is no opposing party a copy of the bill shall be served on the commissioner, and all the expenses of the proceeding shall be paid by the applicant, whether the final decision is in his favor or not.

The Revised Statutes in 1874.

SECTION 4909. Every applicant for a patent or for the reissue of a patent, any of the claims of which have been twice rejected, and every party to an interference, may appeal from the decision of the primary examiner, or of the examiner in charge of interferences in such case, to the board of examiners-in-chief; having once paid the fee for such appeal.

SECTION 4910. If such party is dissatisfied with the decision of the examiners-in-chief, he may, on payment of the fee prescribed, appeal to the Commissioner in person.

SECTION 4911. If such party, except a party to an interference, is dissatisfied with the decision of the Commissioner, he may appeal to the Supreme Court of the District of Columbia, sitting in banc.

SECTION 4915. Whenever a patent on application is refused, either by the Commissioner of Patents or by the Supreme Court of the District of Columbia upon appeal from the Commissioner, the applicant may have remedy by bill in equity; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim, or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the Commissioner to issue such patent on the applicant filing in the Patent-Office a copy of the adjudication, and otherwise complying with the requirements of law. In all cases, where there is no opposing party, a copy of the bill shall be served on the Commissioner; and all the expenses of the proceeding shall be paid by the applicant, whether the final decision is in his favor or not.

The Judiciary Act of 1893.

SECTION 9. That the determination of appeals from the decision of the Commissioner of Patents, now vested in the general term of the Supreme Court of the District of Columbia, in pursuance of the provisions of section seven hundred and eighty of the Revised Statutes of the United States, relating to the District of Columbia, shall hereafter be and the same is hereby vested in the Court of Appeals created by this act; and in addition, any party aggrieved by a decision of the Commissioner of Patents in any interference case may appeal therefrom to said Court of Appeals.

APPROVED February 9, 1893.

The Revised Statutes After the Patent Act of March 2, 1927.

SEC. 4509. Every applicant for a patent or for the re-issue of a patent, any of the claims of which have been twice rejected, and every party to an interference, may appeal from the decision of the primary examiner, or of the examiner in charge of interferences in such case, to the Board of Appeals; having once paid the fee for such appeal.

Act of Feb. 9, 1893:

Be it enacted, etc., That there shall be, and there is hereby, established in the District of Columbia a court, to be known as the Court of Appeals of the District of Columbia, which shall consist of one chief justice and two associate justices, who shall be appointed by the President, by and with the advice and consent of the Senate, and shall hold office during good behavior.

SEC. 4911. If any applicant is dissatisfied with the decision of the Board of Appeals, he may appeal to the Court of Appeals of the District of Columbia, in which case he waives his right to proceed under section 4915 of the Revised Statutes. If any party to an interference is dissatisfied with the decision of the Board of Appeals, he may appeal to the Court of Appeals of the District of Columbia, provided that such appeal shall be dismissed if any adverse party to such interference shall within twenty days after the appellant shall have filed notice of appeal according to section 4912 of the Revised Statutes, file notice with the Commissioner of Patents that he elects to have all further proceedings conducted as provided in section 4915 of the Revised Statutes. Thereupon the appellant shall have thirty days thereafter within which to file a bill in equity under said section 4915, in default of which the decisions appealed from shall govern the further proceedings in the case. If the appellant shall file such bill within said thirty days and shall file due proof thereof with the Commissioner of Patents, the issue of a patent to the party awarded priority by said Board of Appeals shall be withheld pending the final determination of said proceeding under said section 4915.

Act of Mar. 2, 1927, 44 Stat. L., 1335:

SEC. 15. That this act shall take effect two months after its approval; but it shall not affect appeals then pending and heard before the examiners in chief or pending before

the Commissioner of Patents or in the Court of Appeals of the District of Columbia, and that in all cases in which the time for appeal from a decision of the examiners in chief or of the Commissioner of Patents or for amendment or renewal of application had not expired at the time this act takes effect, appeals and other proceedings may be taken under the statutes in force at the time of approval of this act as if such statutes had not been amended or repealed.

SEC. 4915. Whenever a patent on application is refused by the Commissioner of Patents, the applicant, unless appeal has been taken from the decision of the Board of Appeals to the Court of Appeals of the District of Columbia, and such appeal is pending or has been decided, in which case no action may be brought under this section, may have remedy by bill in equity, if filed within six months after such refusal; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent on the applicant filing in the Patent office a copy of the adjudication and otherwise complying with the requirements of law. In all cases where there is no opposing party a copy of the bill shall be served on the commissioner; and all the expenses of the proceedings shall be paid by the applicant, whether the final decision is in his favor or not. In all suits brought hereunder where there are adverse parties the record in the Patent Office shall be admitted in whole or in part, on motion of either party, subject to such terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court may impose, without prejudice, however, to the right

of the parties to take further testimony. The testimony and exhibits, or parts thereof, of the record in the Patent Office when admitted shall have the same force and effect as if originally taken and produced in the suit.

Act of Mar. 3, 1927, 44 Stat. L., 1394:

And upon the filing of a bill in the Supreme Court of the District of Columbia wherein remedy is sought under section 4915 or section 4918 of the Revised Statutes, without seeking other remedy, if it shall appear that there is an adverse party residing in a foreign country, or adverse parties residing in a plurality of districts not embraced within the same State, the court shall have jurisdiction thereof and writs shall, unless the adverse party or parties voluntarily make appearance, be issued against all of the adverse parties with the force and effect and in the manner set forth in this section: *Provided*, That writs issued against parties residing in foreign countries pursuant to this section may be served by publication or otherwise as the court shall direct.

The Revised Statutes After the Patent Act of March 2, 1929.

SEC. 4909. (U. S. C., title 35, sec. 57.) Every applicant for a patent or for the reissue of a patent, any of the claims of which have been twice rejected, and every party to an interference, may appeal from the decision of the primary examiner, or of the examiner in charge of interferences in such case, to the Board of Appeals; having once paid the fee for such appeal.

Act of Mar. 3, 1911 (Judicial Code):

SEC. 188. (U. S. C., title 28, sec. 301.) There shall be a United States Court of Customs and Patent Appeals, which shall consist of a presiding judge and four associate judges, each of whom shall be appointed by the President by and with the advice and consent of the Senate, and shall receive a salary of twelve thousand five hundred dollars a year. The

presiding judge shall be so designated in the order of appointment and in the commission issued to him by the President; and the associate judges shall have precedence according to the date of their commissions. Any three members of said court shall constitute a quorum, and the concurrence of three members shall be necessary to any decision thereof. In case of a vacancy or of the temporary inability, or disqualification for any reason, of one or two of the judges of said court, the President may, upon the request of the presiding judge of said court, designate any qualified United States circuit or district judge or judges to act in his or their place; and such circuit or district judges shall be duly qualified to so act.

Act of May, 2, 1929, 45 Stat. L. 1476:

SEC. 2. (U. S. C., title 28, sec. 309a.) (a) The jurisdiction vested prior to April 1, 1929, in the Court of Appeals of the District of Columbia in respect of appeals from the Patent Office in patent and trade-mark cases is vested in the United States Court of Customs and Patent Appeals.

(d) Nothing contained in this section shall be construed as affecting in any way the jurisdiction of the Court of Appeals of the District of Columbia in equity cases.

Revised Statutes, Title LX:

SEC. 4911. (U. S. C., title 35, sec. 59a.) If any applicant is dissatisfied with the decision of the Board of Appeals, he may appeal to the United States Court of Customs and Patent Appeals, in which case he waives his right to proceed under section 4915 of the Revised Statutes. (U. S. C., title 35, sec. 63.) If any party to an interference is dissatisfied with the decision of the Board of Appeals, he may appeal to the United States Court of Customs and Patent Appeals, provided that such appeal shall be dismissed if any

adverse party to such interference shall within twenty days after the appellant shall have filed notice of appeal according to section 4912 of the Revised Statutes (U. S. C., title 35, sec. 60), file notice with the Commissioner of Patents that he elects to have all further proceedings conducted as provided in section 4915 of the Revised Statutes. Thereupon the appellant shall have thirty days thereafter within which to file a bill in equity under said section 4915, in default of which the decisions appealed from shall govern the further proceedings in the case. If the appellant shall file such bill within said thirty days and shall file due proof thereof with the Commissioner of Patents, the issue of a patent to the party awarded priority by said Board of Appeals shall be withheld pending the final determination of said proceeding under said section 4915.

Act of Mar. 2, 1927, 44 Stat. L. 1335:

SEC. 15. That this act shall take effect two months after its approval; but it shall not affect appeals then pending and heard before the examiners in chief or pending before the Commissioner of Patents or in the Court of Appeals of the District of Columbia, and that in all cases in which the time for appeal from a decision of the examiners in chief or of the Commissioner of Patents, or for amendment or renewal of application had not expired at the time this act takes effect, appeals and other proceedings may be taken under the statutes in force at the time of approval of this act as if such statutes had not been amended or repealed.

SEC. 4915 (U. S. C., title 35, sec. 63.) Whenever a patent on application is refused by the Commissioner of Patents, the applicant, unless appeal has been taken from the decision of the Board of Appeals to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided, in which case no action may be brought

under this section, may have remedy by bill in equity, if filed within six months after such refusal; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant; shall authorize the commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication and otherwise complying with the requirements of law. In all cases where there is no opposing party a copy of the bill shall be served on the commissioner; and all the expenses of the proceedings shall be paid by the applicant, whether the final decision is in his favor or not. In all suits brought hereunder where there are adverse parties the record in the Patent Office shall be admitted in whole or in part, on motion of either party, subject to such terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court may impose, without prejudice, however, to the right of the parties to take further testimony. The testimony and exhibits, or parts thereof, of the record in the Patent Office when admitted shall have the same force and effect as if originally taken and produced in the suit.

Act of March 3, 1927, 44 Stat. L. 1394: (U. S. C., title 35, sec. 72a.)

And upon the filing of a bill in the Supreme Court of the District of Columbia wherein remedy is sought under section 4915 or section 4918 of the Revised Statutes, (U. S. C., title 35, sec. 63 or sec. 66) without seeking other remedy, if it shall appear that there is an adverse party residing in a foreign country, or adverse parties residing in a plurality of districts not embraced within the same State, the court shall have jurisdiction thereof and writs shall unless the

adverse party or parties voluntarily make appearance, be issued against all of the adverse parties with the force and effect and in the manner set forth in this section (sec. 113 of title 28, U. S. C.): *Provided*, That writs issued against parties residing in foreign countries pursuant to this section may be served by publication or otherwise as the court shall direct.

The Revised Statutes in 1941 and Today.

SEC. 481. R. S. (U. S. C., title 35, sec. 6.) The Commissioner of Patents, under the direction of the Secretary of Commerce, shall superintend or perform all duties respecting the granting and issuing of patents directed by law; and he shall have charge of all books, records, papers, models, machines, and other things belonging to the Patent Office.

SEC. 4886. R. S. (U. S. C., title 35, sec. 31.) Any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvements thereof, or who has invented or discovered and asexually reproduced any distinct and new variety of plant, other than a tuber-propagated plant, not known or used by others in this country, before his invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof or more than one year prior to his application, and not in public use or on sale in this country for more than one year prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law, and other due proceeding had, obtain a patent therefor. [The period is *two years* instead of "one year" where the application was filed prior to Aug. 5, 1940. See Sec. 2 of Act of Aug. 5, 1939; *infra*.]

Act of Aug. 5, 1939, 53 Stat. 1212:

SEC. 2. This Act [amending sections 4886, 4887, 4920, and 4929 of the Revised Statutes (U. S. C., title 35, secs. 31, 62, 69, and 73) by changing "two years" to *one year*] shall take effect one year after its approval and shall apply to all applications for patent filed after it takes effect and to all patents granted on such applications; *Provided, however,* That all applications for patents filed prior to the time this Act takes effect and all patents granted on such applications are to be governed by the statutes in force at the time of approval of this Act as if such statutes had not been amended.

ii.

SEC. 4904. R. S. (U. S. C., title 35; sec. 52). Whenever an application is made for a patent which, in the opinion of the Commission, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be, and shall direct a board of three examiners of interferences to proceed to determine the question of priority of invention. And the Commissioner may issue a patent to the party who is adjudged the prior inventor. [As to interferences declared prior to Oct. 5, 1939, see Sec. 5 of Act of Aug. 5, 1939, *infra*.]

Act of Aug. 5, 1939, 53 Stat. 1212:

SEC. 5. This Act [amending sections 4904, 4909, 4911, and 4915 of the Revised Statutes (U. S. C., title 35, secs. 52, 57, 59a, and 63)] shall take effect two months after its approval; but it shall not affect interferences then pending, which may be heard and decided and appeals and other proceedings taken under the statutes in force at the time of approval of this Act as if such statutes had not been amended.

SEC. 4909. R. S. (U. S. C., title 35, sec. 57.) Every applicant for a patent or for the reissue of a patent, any of the claims of which have been twice rejected, may appeal from the decision of the primary examiner to the Board of Appeals, having once paid the fee for such appeal. [As to interferences declared prior to Oct. 5, 1939, see Sec. 5 of Act of Aug. 5, 1939, printed after R. S. Sec. 4904, *ante*.]

Act of Mar. 2, 1929, 45 Stat. 1176:

SEC. 2. (U. S. C., title 28, sec. 309a.) (a) The jurisdiction vested prior to April 1, 1929, in the Court of Appeals of the District of Columbia in respect of appeals from the Patent Office in patent and trade-mark cases is vested in the United States Court of Customs and Patent Appeals.

(d) Nothing contained in this section shall be construed as affecting in any way the jurisdiction of the U. S. Court of Appeals for the District of Columbia in equity cases.

SEC. 3. (U. S. C., title 28, sec. 312.) The opinion of the Court of Customs and Patent Appeals in every case on appeal from the decision of the Patent Office shall be rendered in writing, and shall be filed in such case as part of the record thereof, and a certified copy of said opinion shall be sent to the Commissioner of Patents and shall be entered of record in the Patent Office.

SEC. 4911. R. S. (U. S. C., title 35, sec. 59a.) If any applicant is dissatisfied with the decision of the Board of Appeals, he may appeal to the United States Court of Customs and Patent Appeals, in which case he waives his right to proceed under section 4915 of the Revised Statutes. (U. S. C., title 35, sec. 63.) If any party to an interference is dissatisfied with the decision of the board of interference examiners he may appeal to the United States Court of Customs and Patent Appeals, provided that such appeal shall be dismissed if any adverse party to such interference shall within twenty days after the appellant shall have filed notice of appeal according to section 4912 of the Revised Statutes. (U. S. C., title 35, sec. 60), file notice with the Commissioner of Patents that he elects to have all further proceedings conducted as provided in section 4915 of the Revised Statutes. Thereupon the appellant shall have thirty days thereafter within which to file a bill in equity under said section 4915, in default of which the decisions appealed from shall govern the further proceedings in the case [As to interferences declared prior to Oct. 5, 1939, see sec. 5 of Act of Aug. 5, 1939, printed after R. S. sec. 4904, *ante*.]

SEC. 4914. R. S. (U. S. C., title 35, sec. 62.) The court, on petition, shall hear and determine such appeal, and revise the decision appealed from in a summary way, on the evidence produced before the commissioner at such early and convenient time as the court may appoint; and the revision shall be confined to the points set forth in the reasons of appeal. After hearing the case the court shall return to the commissioner a certificate of its proceedings and decision, which shall be entered of record in the Patent Office, and shall govern the further proceedings in the case. But no

opinion or decision of the court in any such case shall preclude any person interested from the right to contest the validity of such patent in any court wherein the same may be called in question.

SEC. 4915. R. S. (U. S. C., title 35, sec. 63.) Whenever a patent on application is refused by the Board of Appeals or whenever any applicant is dissatisfied with the decision of the board of interference examiners, the applicant, unless appeal has been taken to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided, in which case no action may be brought under this section, may have remedy by bill in equity, if filed within six months after such refusal or decision; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication and otherwise complying with the requirements of law. In all cases where there is no opposing party a copy of the bill shall be served on the commissioner; and all the expenses of the proceedings shall be paid by the applicant, whether the final decision is in his favor or not. In all suits brought hereunder where there are adverse parties the record in the Patent Office shall be admitted in whole or in part, on motion of either party, subject to such terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court may impose, without prejudice, however, to the right of the parties to take further testimony. The testimony and exhibits, or parts thereof, of the record in the Patent Office

when admitted shall have the same force and effect as if originally taken and produced in the suit. [As to interferences declared prior to Oct. 5, 1939 see Sec. 5 of Act of Aug. 5, 1939, printed after R. S. Sec. 4904, *ante*.]

Act of March 3, 1927, 44 Stat. 1394 (U. S. C., title 35, sec. 720):

And upon the filing of a bill in the District Court of the United States for the District of Columbia wherein remedy is sought under section 4915 or section 4918 of the Revised Statutes (U. S. C., title 35, sec. 63 or sec. 66), without seeking other remedy, if it shall appear that there is an adverse party residing in a foreign country, or adverse parties residing in a plurality of districts not embraced within the same State, the court shall have jurisdiction thereof and writs shall, unless the adverse party or parties voluntarily make appearance, be issued against all of the adverse parties with the force and effect and in the manner set forth in this section (sec. 113 of title 28 U. S. C.): *Provided*, That writs issued against parties residing in foreign countries pursuant to this section may be served by publication or otherwise as the court shall direct.

Sec. 4918. R. S. (U. S. C., title 35, sec. 66.) Whenever there are interfering patents, any person interested in any one of them, or in the working of the invention claimed under either of them, may have relief against the interfering patentee, and all parties interested under him, by suit in equity against the owners of the interfering patent; and the court, on notice to adverse parties, and other due proceedings had according to the course of equity, may adjudge and declare either or both the patents void in whole or in part upon any ground, or inoperative, or invalid in

any particular part of the United States, according to the interest of the parties in the patent or the invention patented. But no such judgment or adjudication shall affect the right of any person except the parties to the suit and those deriving title under them subsequent to the rendition of such judgment.

Rules of Practice in the United States Patent Office:

63. (d) Applications which appear to interfere with other applications previously considered and found to be allowable, or which it is demanded shall be placed in interference with an unexpired patent or patents.

Where an applicant copies claims from a patent and the examiner is of the opinion that he can make none of these claims, he should state in his action why he can not make the claims and set a time limit, not less than twenty days, for reply. If, after response by the applicant, the rejection is made final, a similar time limit should be set for appeal. Failure to respond or appeal, as the case may be, within the time fixed, will in the absence of a satisfactory showing, be deemed a disclaimer of the invention claimed. (See rule 94.)

93. An interference is a proceeding instituted for the purpose of determining the question of priority of invention between two or more parties claiming substantially the same patentable invention and may be instituted as soon as it is determined that common patentable subject-matter is claimed in a plurality of applications or in an application and a patent. In order to ascertain whether any question of priority arises the Commissioner may call upon any junior applicant to state in writing under oath the date and the character of the earliest fact or act, susceptible

of proof, which will be relied upon to establish conception of the invention under consideration. The sworn statement filed in compliance with this rule will be retained by the Patent Office separate from the application file and if an interference is declared will be opened simultaneously with the preliminary statement of the party filing the same. In case the junior applicant makes no reply within the time specified, not less than twenty days, the Commissioner will proceed upon the assumption that the said date is the date of the oath attached to the application. The fact that one of the parties has already obtained a patent will not prevent an interference, for, although the Commissioner has no power to cancel a patent, he may grant another patent for the same invention to a person who proves to be the prior inventor.

94. Interferences will be declared between applications by different parties for patent or for reissue when such applications contain claims for substantially the same invention which are allowable in the application of each party, and interferences will also be declared between applications for patent, or for reissue, and unexpired original or issued patents, of different parties, when such applications and patents contain claims for substantially the same invention which are allowable in all of the applications involved: *Provided*, That where the filing date of any applicant is subsequent to the filing date of any patentee, the applicant shall file an affidavit that he made the invention in controversy in this country before the filing date of the patentee; and when required the applicant shall file an affidavit setting forth facts showing that he completed the invention in controversy, in this country, before the filing date of the patentee.

Where claims are copied from a patent and the examiner is of the opinion that the applicant can make only some of the claims so copied, he shall notify the applicant to that effect, state why he is of the opinion he cannot make the other claims and state further that the interference will be promptly declared and that the applicant may proceed under rule 109, if he further desires to contest his right to make the claims not included in the declaration of the interference.

Where an applicant presents a claim copied or substantially copied from a patent, he must at the time he presents the claim identify the patent, give the number of the patented claim, and specifically apply the terms of the copied claim to his own disclosure.

No amendment for the first time presenting or asserting a claim which is the same as, or for substantially the same subject matter as, a claim of an issued patent may be made in any application unless such amendment is filed within one year from the date on which said patent was granted.

Parties owning applications or patents which contain conflicting claims will be required to show cause why these claims shall not be eliminated from all but one of the applications or patents of common ownership.

95. Before the declaration of interference it must be determined that there is common patentable subject matter in the cases of the respective parties. The issue must be clearly defined and be patentable to the respective parties, subject to the determination of the question of priority.

In case the subject matter in controversy has been patented to one of the parties but is deemed by the examiner not to be patentable to an applicant, he shall call the case to the attention of the Commissioner.

96. Whenever the claims of two or more applications differ in phraseology, but relate to substantially the same patentable subject matter, the examiner shall suggest to the parties such claims as are necessary to cover the common invention in substantially the same language. The examiner shall send copies of the letter suggesting claims to the applicant and to the assignee, as well as to the attorney or agent of record in each case. The parties to whom the claims are suggested will be required to make those claims within a specified time in order that an interference may be declared. Upon the failure of any applicant to make any claim suggested within the time specified, such failure or refusal shall be taken without further action as a disclaimer of the invention covered by the claim unless the time be extended upon a proper showing. After judgment of priority the application of any party may be held for revision and restriction, subject to interference with other applications.

Whenever it shall be found that two or more parties whose interests are in conflict are represented by the same attorney or agent, the examiner shall notify each of said principal parties and also the attorney or agent of this fact.

109. An applicant involved in an interference may, within a time fixed by the examiner of interferences not less than thirty days after the preliminary statements (referred to in rule 110) of the parties have been received and approved, or if a motion to dissolve the interference has been brought by another party, within thirty days from the filing thereof, on motion duly made as provided by rule 153, file an amendment to his application containing any claims which in his opinion should be made the basis of interference between himself and any of the other parties.

Such motion must be accompanied by the proposed amendment, and when in proper form will be set by the examiner of interferences for hearing before the primary examiner. Where a party opposes the admission of such an amendment in view of prior patents or publications, full notice of such patents or publications, applying them to the proposed counts, must be given to all parties at least twenty days prior to the date of hearing. On the admission of such amendment and the adoption of the claims by the other parties within a time specified the primary examiner shall redeclare the interference or shall declare such other interferences as may be necessary to include the said claims. New preliminary statements will be received as to the added claims, but motions for dissolution with regard thereto will not be considered where the questions raised could have been disposed of in connection with the admission of the claims. Amendments to the specification will not be received during the pendency of the interference without the consent of the Commissioner, except as provided herein and in rule 106.

Any party to an interference may bring a motion to put in interference any claims already in his application or patent which should be made the basis of interference between himself and any of the other parties. Any party to an interference may bring a motion to add or substitute any other application owned by him, as to the existing issue, or to include an application or a patent owned by him, as to claims which should be made the basis of interference between himself and any of the other parties. Such motions are subject to the same conditions and the procedure in connection therewith is the same, so far as applicable, as hereinabove set forth for motions to amend.

111. The preliminary statements shall not be opened to the inspection of the opposing parties until all motions to dissolve under rule 122 and all motions to amend under rule 109 and interlocutory appeals respecting the same have been finally disposed of or the time for filing such motions has expired without such a motion having been filed, and the case is in condition for taking of testimony.

A junior party who fails to file a preliminary statement or a party who alleges no date in his preliminary statement earlier than the filing date of the application or applications of another party shall not have access to the preliminary statement of said party.

If the interference be terminated by dissolution, the preliminary statements will remain sealed.

116. The parties to an interference will be presumed to have made their inventions in the chronological order in which they filed their completed applications for patents clearly disclosing same; and the burden of proof will rest upon the party who shall seek to establish a different state of facts.

The termination of the interference by dissolution under rule 122 without an award of priority shall not disturb this presumption, and a party enjoying the status of a senior party with respect to any subject-matter of his application shall not be deprived of any claim to such subject-matter solely on the ground that such claim was not added to the interference by amendment under rule 109.

122. Motions to dissolve an interference (1) alleging that there has been such informality in declaring the same as will preclude the proper determination of the question of priority of invention, or (2) denying the patentability

of an applicant's claim, or (3) denying his right to make the claim, or (4) if the interference involves a design patent or an application, alleging that there is no interference in fact and also motions to shift the burden of proof, should contain a full statement of the ground relied upon and should, if possible, be made within the time fixed by the examiner of interferences, not less than thirty days, after the statements of the parties have been received and approved. Such motions and all motions of a similar character, if in the opinion of the examiner of interferences they be in proper form, will be heard and determined by the primary examiner, due notice of the day of hearing being given by the office to all parties. If in the opinion of the examiner of interferences the motion be not in proper form, or if it be not brought within the time specified and no satisfactory reason be given for the delay, it will not be considered and the parties will be so notified.

At a hearing on a motion to dissolve an interference between an application and a patent, the prior art of record in the patent file shall be referred to for the purpose of construing the issue. The matter raised on a motion to shift the burden of proof may be reviewed at final hearing.

123. Setting a motion brought under the provisions of rule 109 or of rule 122 for hearing will act as a stay of proceedings pending the determination of the motion. To effect a stay of proceedings in other cases, motion should be made before the tribunal having jurisdiction of the interference, who will, sufficient grounds appearing therefor, order a suspension of the interference pending the determination of such motion.

124. No appeal will be permitted from a decision rendered on a motion brought under the provisions of rules 109 and 122.

Appeals may be taken directly to the Commissioner from decisions on such other motions as, in his judgment, should be appealable.

126. The board of interference examiners may, either before or in their decision on the question of priority, direct the attention of the Commissioner to any matter not relating to priority which may have come to their notice, and which, in their opinion, establishes the fact that no interference exists, or that there has been irregularity in declaring the same (rule 122), or which amounts to a statutory bar to the grant of a patent to either of the parties for the claim or claims in interference. The Commissioner may suspend the interference and remand the case to the primary examiner for his consideration of the matters to which attention has been directed. From the decision of the examiner appeal may be taken as in other cases. If the case shall not be so remanded, the primary examiner will, after judgment consider any matter affecting the rights of either party to a patent which may have been called to his attention, unless the same shall have been previously disposed of by the Commissioner.

130. Where the patentability of a claim to an opponent is material to the right of a party to a patent, said party may urge the nonpatentability of the claim to his opponent as a basis for the decision upon priority of invention. A party shall not be entitled to raise this question, however, unless he has duly presented and prosecuted a motion under

rule 122 for dissolution upon this ground or shows good reason why such a motion was not presented and prosecuted.

At final hearing between an application and a patent the prior art of record in the patent file shall be referred to for the purpose of construing the issue.

133. Every applicant for a patent, any of the claims of whose application have been twice rejected for the same reasons, upon grounds involving merits of the invention, such as lack of invention, novelty, or utility, or on the ground of abandonment, public use or sale, inoperativeness of invention, aggregation of elements, incomplete combination of elements, or, when amended, for want of identity with the invention originally disclosed, or because the amendment involves a departure from the invention originally presented; and every applicant who has been twice required to divide his application, and every applicant for the reissue of a patent whose claims have been twice rejected for any of the reasons above enumerated, or on the ground that the original patent is not operative or invalid, or if so inoperative or invalid that the errors which rendered it so did not rise from inadvertence, accident, or mistake, may, upon payment of a fee of \$15, appeal from the decision of the primary examiner to the board of appeals. The appeal must set forth in writing the points of the decision upon which it is taken, and must be signed by the applicant or his duly authorized attorney or agent.

141. After decision by an appellate tribunal the case shall be remanded at once to the primary examiner, subject to the applicant's right of appeal, for such action as will carry into effect the decision, or for such further action as the applicant is entitled to demand.

449. When an appeal is taken to the United States Court of Customs and Patent Appeals, the appellant shall give notice thereof to the Commissioner, and file in the Patent Office, within forty days, exclusive of Sundays and legal holidays in the District of Columbia but including Saturday half holidays, from the date of the decision appealed from, his reasons of appeal specifically set forth in writing; *Provided*, however, that if a petition for rehearing or reconsideration is filed within 20 calendar days after said decision, the notice of appeal may be given and the reasons of appeal filed within 15 calendar days after action on the petition. No petition for rehearing or reconsideration filed more than 20 calendar days after such decision, nor any proceedings on such petition, shall operate to extend the period of 40 days hereinabove provided for appeal.

If an applicant in an *ex parte* case appeals to the U. S. Court of Customs and Patent Appeals he waives his right to proceed under section 4915 R. S. (U. S. C., title 35, sec. 63).

If a defeated party to an interference proceeding appeals to the U. S. Court of Customs and Patent Appeals, and any adverse party to the interference shall, within twenty days after the appellant shall have filed notice of the appeal to the court, file notice with the Commissioner that he elects to have all further proceedings conducted as provided in section 4915 R. S., certified copies of the foregoing papers will be transmitted to the U. S. Court of Customs and Patent Appeals for such action as may be necessary. The notice of election must be served as provided in rule 154 (b). [See rule 153 (a).]

From adverse decisions by the board of appeals in *ex parte* cases and from decisions of the board of interference examiners, the appellant, if an applicant, has the option of proceeding under section 4915 R. S. instead of appealing directly to the U. S. Court of Customs and Patent Appeals.

Rules of Civil Procedure:

8(d) EFFECT OF FAILURE TO DENY. Averments in a pleading to which a responsive pleading is required, other than those as to the amount of damage, are admitted when not denied in the responsive pleading. Averments in a pleading to which no responsive pleading is required or permitted shall be taken as denied or avoided.

Rules of U. S. Court of Customs and Patent Appeal: Rule XXV.

1. Any party desiring to appeal to this court from a decision of the Board of Appeals, Board of Interference Examiners or the Commissioner of Patents shall file in the clerk's office a petition, addressed to the court, in which he shall briefly set forth and show that he has complied with the requirements of section 4912 and 4913 of the Revised Statutes of the United States to entitle him to an appeal, and praying that his appeal may be heard upon and for the reasons assigned therefor to the commissioner. Said reasons for appeal, having been filed with the Commissioner of Patents and made a part of the record, shall not be repeated in the petition of appeal. Said petition

of appeal and a certified copy of the record in the proceedings shall be filed in this court and the case duly docketed within 40 days (exclusive of Sundays and legal holidays) from the date upon which said reasons for appeal were filed with the Commissioner of Patents: *Provided*, That the commissioner may for special and sufficient cause extend such time to some definite and fixed date: *Provided, further*, That in inter partes cases appellant shall, at the time of filing said petition of appeal in this court, or within 10 days thereafter, serve a copy thereof upon appellee or his counsel.

If said petition of appeal and copy of said record shall not be filed within said period of 40 days, unless such time be extended by the commissioner as heretofore provided, the commissioner, upon such facts being brought to his attention by motion of the appellee in inter partes cases, duly served upon the appellant or his attorney, and upon his own motion in ex parte appeals, may take such further proceedings in the case as may be necessary to dispose of the same as though no notice of appeal had ever been given. *Provided, however*, That if any adverse party in an interference case shall, within twenty days after appellant shall have filed notice of appeal to this court, file notice with the Commissioner of Patents that he elects to have all further proceedings conducted as provided in section 4915 of the Revised Statutes, certified copies of the notice of appeal and the notice of election shall be transmitted to this court by the Commissioner of Patents for appropriate action according to law.

2. All certified copies of papers and evidence on appeal from the decision of the final appellate tribunal of the Patent Office shall be received by the clerk of this court.

and the cases, by titling and number, shall be placed on a separate docket to be designated as the "Patent appeal docket." The clerk shall, under this titling of the case on the docket, make brief entries of all papers filed and of all proceedings had in the case.

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In the Supreme Court of the United States

OCTOBER TERM, 1944

No. 486

THE HOOVER COMPANY, PETITIONER

v.

CONWAY P. COE, COMMISSIONER OF PATENTS

ON PETITION FOR WRIT OF CERTIORARI TO THE UNITED
STATES COURT OF APPEALS FOR THE DISTRICT OF
COLUMBIA

MEMORANDUM FOR THE COMMISSIONER OF PATENTS.

OPINION BELOW

The District Court of the United States for the District of Columbia did not render an opinion. The opinion of the United States Court of Appeals for the District of Columbia (R. 140-146) is not yet officially reported.

JURISDICTION

The judgment of the District Court was entered on June 21, 1943 (R. 14). The judgment of the Court of Appeals was entered on July 10, 1944 (R. 147). The petition for a writ of certiorari was filed on September 20, 1944. The

jurisdiction of this Court is invoked under Section 240 (a) of the Judicial Code, as amended by the Act of February 13, 1925.

QUESTION PRESENTED

Whether the United States District Court for the District of Columbia has jurisdiction under Rev. Stat. 4915 (35 U. S. C. 63) over a suit to compel the Commissioner of Patents to allow certain claims which had been rejected by the Patent Office, where the court, if it reversed the Patent Office, could not then order issuance of a patent, since further proceedings in the Patent Office would still be required.

STATUTES AND REGULATION INVOLVED

The relevant portions of the statutes and regulation involved are set forth in the Appendix, pp. 10-14, *infra*.

STATEMENT

United States Patent No. 2,178,870 was granted to C. C. Coons, petitioner's assignor, on November 7, 1939, covering improvements in a refrigerating system (R. 3-4, 8). On January 10, 1941, he applied for reissuance of the patent, presenting a number of claims copied or substantially copied from several later patents in order to provoke an interference (R. 4-6, 113-115). On March 28, 1941, the Primary Examiner allowed sixteen of the claims as "patentable" and "readable" upon the Coons application, and declared the reissue

application to be in interference with two of the patents (Ullstrand, No. 2,215,674, and Anderson, No. 2,203,074) from which the claims had been taken (R. 113-115). However, the Primary Examiner rejected "as not reading on applicant's disclosure" eight claims taken from the Bergholm patent, No. 2,201,362 granted May 21, 1940 (R. 117-128).

Four of these rejected claims were appealed to the Board of Appeals, which affirmed the Primary Examiner (R. 129-133). Thereafter, petitioner as assignee brought suit against the Commissioner of Patents under Section 4915 of the Revised Statutes (35 U. S. C. 63) in the United States District Court for the District of Columbia, to direct the Commissioner to allow the four rejected claims for purposes of an interference proceeding (R. 3-7). After receiving in evidence the record before the Patent Office and additional evidence on behalf of petitioner (R. 24-82), the District Court entered findings of fact and conclusions of law on June 21, 1943, dismissing the complaint on the ground that the appealed claims were not readable on the applicant's disclosure (R. 10-14).

On appeal, the United States Court of Appeals for the District of Columbia, on its own motion, raised the question "whether Section 4915 R. S. confers jurisdiction on the District Court to enter a decree which does not determine the right of the

applicant to receive a patent but which instead directs the examiner to allow claims for the purpose of provoking subsequent interference proceedings" (R. 141). Following the submission of memoranda by both parties in support of the jurisdiction of the District Court (R. 141), the court below held that the District Court lacked jurisdiction over the suit and affirmed the judgment dismissing the complaint (R. 147).

DISCUSSION

Revised Statutes 4915 affords a "remedy by bill in equity" to any applicant who has been refused "a patent on application," and provides that "the court having cognizance thereof * * * *may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim, or for any part thereof, as the facts in the case may appear.*" (See Appendix, pp. 11-12, *infra*.) The section further provides that

such adjudication, if it be in favor of the right of the applicant, shall authorize the Commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication, and *otherwise complying with the requirements of law.* [Italics supplied.]

The court below held that the first of the above provisions limited the jurisdiction of the district courts to situations in which an adjudication could

be made that the applicant is entitled to a patent. The court then concluded that such an adjudication could not be made here, since a reversal of the Patent Office in the instant case would not entitle petitioner to receive a patent for the claims until priority over Bergholm was determined in the ensuing interference proceedings before the Patent Office—an issue not determinable upon the record before the court. Petitioner argues that the second portion of Section 4915, quoted above shows that the Patent Office need not issue a patent unless, by fulfilling all other requisites of patentability, the applicant is “otherwise complying with the requirements of law”.

The court found reasons of policy to support its conclusion. Noting that the case is “in substance not a suit on the merits but an appeal from the refusal of the Patent Office to take preliminary steps which would lead to interference proceedings,” the court condemned as “contrary to the fundamental concept of equity jurisdiction” the notion “that a court of equity should interfere with the proceedings of an administrative tribunal by a trial de novo at a stage when no decision on the merits can be given” (R. 142). The appropriate remedy, the court indicated, was an appeal to the United States Court of Customs and Patent Appeals under Rev. Stat. 4911, “to correct an administrative ruling of the Patent Office for

error appearing on the Patent Office record" (R. 142).¹

Although there are judicial statements which may be regarded as supporting the decision below (cf. *Hill v. Wooster*, 132 U. S. 693, 698), the practice of the courts has been to the contrary. Prior decisions generally seem to assume that Section 4915 is not limited to cases in which all possible proceedings in the Patent Office have been completed. The courts have repeatedly, and generally without challenge, taken jurisdiction under Rev. Stat. 4915 even where the record revealed that the rejected claims, if allowed, would still have to run the gauntlet of further proceedings in the Patent Office to determine invention or priority. *Pitman v. Coe*, 68 F. (2d) 412 (App. D. C.) (rejection of claims for improper joinder); *International Cellucotton Products Co. v. Coe*, 85 F. (2d) 869 (App. D. C.) (rejection on grounds of estoppel); *American Cyanamid Co. v. Coe*, 106 F. (2d) 851 (App. D. C.) (same); *Power Patents Co. v. Coe*, 110 F. (2d) 550 (App. D. C.) (claims rejected because not supported by disclosure in application); *Tully v. Robertson*, 19 F. (2d) 954 (D. Md.) (same); *Monopower Corp. v. Coe*, 33 F.

¹ In this case, petitioner's right to this alternative remedy may be doubtful since petitioner's time for appeal to the United States Court of Customs and Patent Appeals expired before the present suit was instituted. Rev. Stat. 4912; Rule 149, Rules of Practice in the Patent Office (September 1, 1943), p. 41 (R. 131-133). See Appendix, pp. 10-11, 13-14, *infra*.

Supp. 934 (D. C.) (same); *Booth Fisheries Corp. v. Coe*, 114 F. (2d) 462 (App. D. C.), certiorari denied, 311 U. S. 691; (same; need for further proceedings shown in record but not reflected in court's opinion); *Forward Process Co. v. Coe*, 116 F. (2d) 946 (App. D. C.) (same). The courts have likewise entertained suits against the Commissioner under Rev. Stat. 4915 to review rejection of a claim for want of invention (*American Steel and Wire Co. v. Coe*, 105 F. (2d) 17 (App. D. C.); *Abercrombie v. Coe*, 119 F. (2d) 458 (App. D. C.); *General Motors Corp. v. Coe*, 120 F. (2d) (736) (App. D. C.); *Hydraulic Press Corp. v. Coe*, 124 F. (2d) 521 (App. D. C.); *Minnesota Mining & Manufacturing Co. v. Coe*, 125 F. (2d) 198 (App. D. C.)), even though the court's favorable ruling on patentability may be and in some instances has been followed by further proceedings in the Patent Office which deprive the applicant of a patent on the claims which the Court had allowed. *Radtke Patents Corp. v. Coe*, 122 F. (2d) 937 (App. D. C.), certiorari denied, *sub nom American Tri-Ergon Corp. v. Radtke Patents Corp.*, 314 U. S. 695; *Poulsen v. Coe*, 119 F. (2d) 188 (App. D. C.); *Poulsen v. McDowell*, 142 F. (2d) 267 (C. C. P. A.).²

² Apparently the only other instance of the refusal of jurisdiction under Rev. Stat. 4915 is *Shoemaker v. Robertson*, 54 F. (2d) 456 (App. D. C.), which declined to review the re-

The court below recognized (R. 145) that in two earlier cases where the question had not been raised, it had accepted jurisdiction of a Rev. Stat. 4915 proceeding to test the rejection by the Patent Office of claims which, like those here involved, had been copied from other patents or applications to provoke interference proceedings (*International Cellucotton Products Co. v. Coe*, 85 F. (2d) 869; *American Cyanamid Co. v. Coe*, 106 F. (2d) 851). But the court below pointed out that, despite the mandate of the court directing the issuance of a patent to plaintiff, an interference proceeding had been instituted in each case, and it regarded this as an illustration of the inappropriateness of a "declaratory judgment" by a court of equity "on a record which compels the Patent Office to ignore the terms of that judgment" (R. 146).³

usal of the Patent Office to consider an application not complying with certain formal requisites (the required number of signatures).

³ While statements in the opinion of the court below seem to bar a suit under Rev. Stat. 4915 in any case where subsequent proceedings might be necessary in the Patent Office (see R. 142), the facts in the instant case and other decisions of the court below on the same day suggest that Rev. Stat. 4915 is only inapplicable where the record affirmatively shows that further proceedings in the Patent Office (such as an interference) are necessary. *Line Material Co. v. Coe*, App. D. C. No. 8491, decided July 10, 1944; *The Colgate-Palmolive-Peet Co. v. Coe*, App. D. C. No. 8508, decided July 10, 1944. See also *Monsanto Chemical Co. v. Coe*, App. D. C. No. 8472, footnote 2, decided June 26, 1944.

The decision below presents an important jurisdictional question affecting judicial review of Patent Office rulings through a trial *de novo* in a federal district court, as opposed to an appeal to the United States Court of Customs and Patent Appeals under Rev. Stat. 4911 on the record before the Patent Office. It is admittedly inconsistent with past practice under Rev. Stat. 4915. For these reasons, we do not oppose the petition for a writ of certiorari.

Respectfully submitted.

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OCTOBER 1944.

* If a writ of certiorari should be granted, this Court may desire treatment of the question whether review of intermediate Patent Office rulings or *ex parte* proceedings under 4915 would entail the imposition of non-judicial functions upon the courts of the District of Columbia and thereby preclude ultimate review by this Court. Cf. *Postum Cereal Co. v. California Fig Nut Co.*, 272 U. S. 693, 699; *Frasch v. Moore*, 211 U. S. 1, 9-10.

APPENDIX

I

STATUTES INVOLVED

1. Sections 4911-4915 R. S., as amended (35 U. S. C. 59a-63), provide as follows:

SEC. 4911. If any applicant is dissatisfied with the decision of the board of appeals, he may appeal to the United States Court of Customs and Patent Appeals, in which case he waives his right to proceed under section 4915 of the Revised Statutes. (U. S. C., title 35, sec. 63). If any party to an interference is dissatisfied with the decision of the board of interference examiners, he may appeal to the United States Court of Customs and Patent Appeals, provided that such appeal shall be dismissed if any adverse party to such interference shall within twenty days after the appellant shall have filed notice of appeal according to section 4912 of the Revised Statutes (U. S. C., title 35, sec. 60), file notice with the Commissioner of Patents that he elects to have all further proceedings conducted as provided in section 4915 of the Revised Statutes. Thereupon the appellant shall have thirty days thereafter within which to file a bill in equity under said section 4915, in default of which the decisions appealed from shall govern the further proceedings in the case.

SEC. 4912. When an appeal is taken to the United States Court of Customs and

Patent Appeals, the appellant shall give notice thereof to the commissioner, and file in the Patent Office, within such time as the commissioner shall appoint, his reasons of appeal, specifically set forth in writing.

SEC. 4913. The court shall, before hearing such appeal, give notice to the commissioner of the time and place of the hearing, and on receiving such notice the commissioner shall give notice of such time and place in such manner as the court may prescribe, to all parties who appear to be interested therein. The party appealing shall lay before the court certified copies of all the original papers and evidence in the case, and the commissioner shall furnish the court with the grounds of his decision, fully set forth in writing, touching all the points involved by the reasons of appeal.

SEC. 4914. The court, on petition, shall hear and determine such appeal, and revise the decision appealed from in a summary way, on the evidence produced before the commissioner, at such early and convenient time as the court may appoint; and the revision shall be confined to the points set forth in the reasons of appeal. After hearing the case the court shall return to the commissioner a certificate of its proceedings and decision, which shall be entered of record in the Patent Office, and shall govern the further proceedings in the case. But no opinion or decision of the court in any such case shall preclude any person interested from the right to contest the validity of such patent in any court wherein the same may be called in question.

SEC. 4915. Whenever a patent on application is refused by the Board of Appeals or whenever any applicant is dissatisfied with

the decision of the board of interference examiners, the applicant, unless appeal has been taken to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided, in which case no action may be brought under this section, may have remedy by bill in equity, if filed within six months after such refusal or decision; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication and otherwise complying with the requirements of law. In all cases where there is no opposing party a copy of the bill shall be served on the commissioner; and all the expenses of the proceedings shall be paid by the applicant, whether the final decision is in his favor or not. In all suits brought hereunder where there are adverse parties the record in the Patent Office shall be admitted in whole or in part, on motion of either party, subject to such terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court may impose, without prejudice, however, to the right of the parties to take further testimony. The testimony and exhibits, or parts thereof, of the record in the Patent Office when admitted shall have the same force and effect as if originally taken and produced in the suit.

2. The Act of March 3, 1927, as amended (44 Stat. 1394, 35 U. S. C. 72a), provides as follows:

Upon the filing of a bill in the district court of the United States for the District of Columbia wherein remedy is sought under section 63 or section 66 of this title, without seeking other remedy, if it shall appear that there is an adverse party residing in a foreign country, or adverse parties residing in a plurality of districts not embraced within the same State, the court shall have jurisdiction thereof and writs shall, unless the adverse party or parties voluntarily make appearance, be issued against all of the adverse parties with the force and effect and in the manner set forth in section 113 of Title 28; provided that writs issued against parties residing in foreign countries pursuant to this section may be served by publication or otherwise as the court shall direct.

II

REGULATION INVOLVED

Rule 149 of the Rules of Practice in the United States Patent Office provides, in part, as follows:

149. When an appeal is taken to the United States Court of Customs and Patent Appeals, the appellant shall give notice thereof to the Commissioner, and file in the Patent Office, within 40 days, exclusive of Sundays and legal holidays in the District of Columbia but including Saturday half holidays, from the date of the decision appealed from, his reasons of appeal specifically set forth in writing; *Provided*, however, That if a petition for rehearing or

reconsideration is filed within 20 calendar days after said decision, the notice of appeal may be given and the reasons of appeal filed within 15 calendar days after action on the petition. No petition for rehearing or reconsideration filed more than 20 calendar days after such decision, nor any proceedings on such petition, shall operate to extend the period of 40 days hereinabove provided for appeal. * * *

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In the Supreme Court of the United States

OCTOBER TERM, 1944

No. 486

THE HOOVER COMPANY, PETITIONER

v.

CONWAY P. COE, COMMISSIONER OF PATENTS

ON WRIT OF CERTIORARI TO THE UNITED STATES COURT
OF APPEALS FOR THE DISTRICT OF COLUMBIA

BRIEF FOR THE RESPONDENT

OPINIONS BELOW

The District Court of the United States for the District of Columbia did not render an opinion. The opinion of the United States Court of Appeals for the District of Columbia (R. 140-146) is reported at 144 F. (2d) 514.

JURISDICTION

The judgment of the District Court was entered on June 21, 1943 (R. 14). The judgment of the Court of Appeals was entered on July 10, 1944 (R. 147). The petition for a writ of certiorari was filed on September 20, 1944, and granted on

November 6, 1944. The jurisdiction of this Court rests upon Section 240 (a) of the Judicial Code, as amended by the Act of February 13, 1925.

QUESTION PRESENTED

Whether the United States District Court for the District of Columbia has jurisdiction under Rev. Stat. 4915 (35 U. S. C. 63) over a suit by an applicant for reissue of a patent to compel the Commissioner of Patents to allow certain claims which had been rejected by the United States Patent Office as unpatentable to that applicant; where further proceedings in the Patent Office to determine priority of invention would be required if the court disagreed with the Patent Office as to the rejection.

STATUTES AND REGULATIONS INVOLVED

The relevant portions of the statutes and regulations involved are set forth in Appendix A, pp. 40-65, *infra*.

STATEMENT

On an application filed August 8, 1936 (R. 88-112), United States Patent No. 2,178,870 was granted to C. C. Coons, petitioner's assignor, on November 7, 1939, covering improvements in a refrigerating system (R. 3-4, 8). On January 10, 1941, Coons applied to the Patent Office for reissuance of the patent, presenting a number of claims copied or substantially copied from several later patents in order to provoke "interferences" there-

with and a contest as to priority (R. 4-6, 8, 113-115).¹ On March 28, 1941, the Primary Examiner in the Patent Office allowed sixteen of the claims as "patentable" and "readable" upon the original Coons application, and declared the reissue application to be in interference with two of the later patents from which the sixteen claims had been taken (Ullstrand No. 2,215,674, and Anderson No. 2,203,074; R. 113-115). However, the Primary Examiner rejected "as not reading on applicant's disclosure" eight claims taken from the Bergholm patent No. 2,201,362, which had been granted May 21, 1940 (R. 117-128) on an application filed November 20, 1937 (R. 137).

Four of these rejected claims were appealed to the Board of Appeals of the Patent Office, which affirmed the Primary Examiner (R. 129-133). Thereafter, petitioner, as Coons' assignee, brought suit against the Commissioner of Patents under Section 4915 of the Revised Statutes (35 U. S. C. 63) in the United States District Court for the District of Columbia, to compel the Commissioner to allow the four appealed claims for purposes of an interference proceed-

¹ Rule 94 of the Patent Office provides in part:

"94. * * * interferences will * * * be declared between applications for patent, or for reissue, and unexpired original or reissued patents, of different parties, when such applications and patents contain claims for substantially the same invention which are allowable in all of the applications involved: * * *." See Appendix A, *infra*, pp. 60-62.

ing with the Bergholm patent (R. 3-7). After receiving in evidence the record before the Patent Office and additional evidence on behalf of petitioner (R. 24-82), the District Court entered findings of fact and conclusions of law, and on June 21, 1943, dismissed the complaint on the ground that the appealed claims were not "readable on" (*i. e.*, did not accurately describe) the disclosure in the Coons application (R. 10-14).

On appeal, the Court of Appeals, on its own motion, raised the question "whether Section 4915 R. S. confers jurisdiction on the District Court to enter a decree which does not determine the right of the applicant to receive a patent but which instead directs the examiner to allow claims for the purpose of provoking subsequent interference proceedings" (R. 141). Following the submission of memoranda by both parties in support of the jurisdiction of the District Court (R. 141), the court below held that the District Court lacked jurisdiction over the suit and affirmed the judgment dismissing the complaint (R. 147).

SUMMARY OF ARGUMENT

Rev. Stat. 4915 provides that upon a refusal of a patent a bill in equity may be filed and the court "may adjudge that such applicant is entitled, according to law, to receive a patent for his invention * * *. And such adjudication, if it be in favor of the right of the applicant,

shall authorize the commissioner to issue such patent on the applicant * * * otherwise complying with the requirements of law." This language literally can be construed either as meaning that the court may adjudge only that an applicant is finally entitled to a patent without further proceedings in the Patent Office apart from complying with formal conditions, or that the court may authorize the Commissioner of Patents to issue the patent when the applicant has fully satisfied all other legal requirements. In our view the latter interpretation rather than the one adopted below is correct.

This is indicated by the legislative history of the provision. When the section was revised in other respects in 1927 the attention of Congress was called to a decision in which a court had taken jurisdiction under circumstances comparable to those at bar. And it appears definitely that Congress intended Rev. Stat. 4915 to be coextensive with Rev. Stat. 4911, which provides for review in the Court of Customs and Patent Appeals, so that an applicant could have alternative remedies but not both. The court below conceded that the present case could have been brought under Rev. Stat. 4911. Furthermore, prior to the present case, the Court of Appeals and other courts had without question frequently taken jurisdiction of cases in which further proceed-

ings in the Patent Office would be necessary if the decision of the Patent Office was reversed, so that the unchallenged practice can be said to represent an understanding of the law on the part of the bar and of the courts.

The order of the Patent Office in this case was not interlocutory; it finally disposed of the applicant's claims in issue. It is analogous to the granting of a motion to dismiss a suit in court, which is a final, appealable order. The fact that further proceedings may be necessary on reversal would not seem to justify a refusal to take jurisdiction any more in the one situation than the other.

ARGUMENT

THE DISTRICT COURT HAD JURISDICTION TO REVIEW THE RULING OF THE PATENT OFFICE

Section 4915 of the Revised Statutes, which petitioner invoked as the basis of the District Court's jurisdiction, provides in part:

Whenever a patent on application is refused by the Board of Appeals or whenever any applicant is dissatisfied with the decision of the board of interference examiners, the applicant, unless appeal has been taken to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided, in which case no action may be brought under this section, may have remedy by bill in equity, if filed within six months after such

refusal or decision; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication and otherwise complying with the requirements of law. In all cases where there is no opposing party a copy of the bill shall be served on the commissioner; and all the expenses of the proceedings shall be paid by the applicant; whether the final decision is in his favor or not. * * *

The court below held that the jurisdiction of the District Court under Rev. Stat. 4915 is limited to situations in which, if the court disagrees with the Patent Office action, a decree can be entered directing that a patent issue to the applicant without further proceedings in the Patent Office. The court concluded that such a decree could not be made in the instant case since a reversal of the Patent Office would not entitle petitioner to receive a patent for the claims in issue until priority over Bergholm was determined in the ensuing interference proceedings before the Patent Office—an issue not determinable upon the record before the

court (R. 142). Despite somewhat broader statements in the court's opinion (see R. 142), other decisions rendered by the court on the same day² indicate that it intended to hold Rev. Stat. 4915 inapplicable only where the record affirmatively shows that further proceedings in the Patent Office will be necessary following an adjudication favorable to the applicant. In such a situation the remedy of the applicant, according to the court below, is by an appeal to the United States Court of Customs and Patent Appeals under Rev. Stat. 4911 (R. 146).³

The precise question presented here has apparently never before been raised or decided. While the ruling below finds some support in the statutory language, it is inconsistent with the legislative materials and with the unchallenged acceptance of jurisdiction by the Federal courts for many years in situations identical with or similar to that presented at bar. And, whatever considerations of policy may be adduced in support

² *Line Material Co. v. Coe*, 144 F. (2d) 518 (App. D. C.); *Colgate-Palmolive Peet Co. v. Coe*, 144 F. (2d) 517 (App. D. C.). See also *Monsanto Chemical Co. v. Coe*, 145 F. (2d) 18 (App. D. C.), footnote 2. Cf. *Minnesota Mining & Manufacturing Co. v. Coe*, 145 F. (2d) 25 (App. D. C.), footnote 2, certiorari denied, January 15, 1945.

³ In this case, petitioner's right to this alternative remedy may be doubtful, since petitioner's time for appeal to the United States Court of Customs and Patent Appeals expired before the present suit was instituted. Rev. Stat. 4912; Rule 149, Rules of the Patent Office (R. 131-133). See Appendix A, *infra*, pp. 56, 63-64.

of the jurisdictional line drawn below between District Court and Court of Customs and Patent Appeals, they are matters for Congressional rather than judicial consideration, since the present statutory scheme seems to contemplate substantially coextensive jurisdiction in each court.

A. THE STATUTORY LANGUAGE

For its conclusion that Rev. Stat. 4915 does not apply here, the court below relied upon the provision therein that the court "may adjudge that such applicant is entitled, according to law, to receive a patent." This language, considered alone, could be read to cover only those cases in which the court, at the conclusion of the judicial proceedings, can direct that a patent be issued—*i. e.*, where no other major issue remains for consideration in the Patent Office. Some support for this construction may be derived from a comparison of Rev. Stat. 4915 with the language of Rev. Stat. 4911 governing the appeal to the Court of Customs and Patent Appeals.

While the two sections provide in substantially identical language for review of the decision of the board of interference examiners, Rev. Stat. 4915 is otherwise confined to situations in which "a patent on application is refused,"⁴ whereas Rev.

⁴ Compliance with this requirement is in no way hampered by the fact that the petitioner here seeks the allowance of claims in a reissue application (a patent already having been granted for claims in the Coons original application). Re-

Stat. 4911 is available to "any applicant" who "is dissatisfied with the decision of the board of appeals." Rev. Stat. 4915 also speaks of an adjudication that the applicant is entitled to a patent, whereas when there is an appeal to the Court of Customs and Patent Appeals under Rev. Stat. 4911, the decision of the court "shall govern the further proceedings in the case." Rev. Stat. 4914; see Appendix A, *infra*, pp. 56-57. This language clearly contemplates review of Patent Office proceedings at intermediate stages, with "further proceedings" in the Patent Office to follow the decision of the Court of Customs and Patent Appeals; whereas it may be argued that the cognate provision in Rev. Stat. 4915 that the judicial decision, if in favor of the applicant, "shall authorize the commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication, and otherwise com-

issue of a patent is authorized by Rev. Stat. 4916 (35 U. S. C. § 64) "Whenever any patent is wholly or partly inoperative or invalid, by reason of a defective or insufficient specification, or by reason of the patentee claiming as his own invention or discovery more than he had a right to claim as new, if the error has arisen by inadvertence, accident, or mistake, and without any fraudulent or deceptive intention * * *." See Appendix A, *infra*, pp. 57-59. The examination of the claims in a reissue application (apart from questions arising from the prior pendency of the subject matter, such as delay and estoppel) is the same as if the claims were in an original application. *In Re Briede*, 27 App. D. C. 298, 303-306. And the remedy by bill in equity under Rev. Stat. 4915 has been regarded as equally applicable to reissue applications. Cf. Rev. Stat. 4909; see Appendix A, *infra*, p. 55.

plying with the requirements of law" refers to such procedural matters as the payment of ~~fees~~^{FINAL} fees (Patent Office Rules 164 and 167; see Appendix A, *infra*, pp. 64-67), and not matters of substance, such as establishing priority of invention. See *Cleveland Trust Co. v. Nelson*, 51 F. (2d) 276, 279 (D. Mich.).⁵ In *Butterworth v. Hoe*, 112 U. S. 50, 61, this Court described the Rev. Stat. 4915 suit as "a proceeding in a court of the United States having original equity jurisdiction under the patent laws, according to the ordinary course of equity practice and procedure. It is not a technical appeal from the Patent Office, like that authorized in § 4911, confined to the case as made in the record of that office, but is prepared and heard upon all competent evidence adduced and upon the whole merits."⁶

⁵ But cf. *Gandy v. Marble*, 122 U. S. 432, 440, where this Court said that "The decision of the court on a bill in equity becomes, equally with the judgment * * * on a direct appeal under § 4911, the decision of the Patent Office, and is to govern the action of the Commissioner." Cf. also *Cleveland Trust Co. v. Berry*, 99 F. (2d) 517, 521 (C. C. A. 6).

⁶ Whereas a suit in equity under Rev. Stat. 4915 is a *de novo* proceeding in which evidence—documentary and testimonial—may be introduced, an appeal to the Court of Customs and Patent Appeals under Rev. Stat. 4911 is decided solely upon the Patent Office record, which in so-called "ex parte" cases (where the issue is solely between the applicant and the Patent Office) consists only of documentary evidence and affidavits, and cannot include oral testimony. Rev. Stat. 4911; Rule 76 of Patent Office; see Appendix A, *infra*, pp. 55, 59.

However, the statutory language does not demand such an interpretation. And the historical development of Rev. Stat. 4915 leaves no doubt that Congress intended it to be available whenever a substantive ruling by the Patent Office resulted in the denial of a patent in whole or in part, and that this remedy was to be coextensive with that provided by Rev. Stat. 4911, at least where, as here, the subject matter is susceptible of judicial determination by bill in equity. The legislative intention finds room for acceptance in the provision that the Court shall "authorize" the commissioner to issue a patent upon compliance with the "requirements of law" if the decision favors the applicant. This may easily be read as not imposing a mandatory obligation upon the commissioner, and as permitting inquiry into such "requirements" as whether the applicant can establish his prior right to the claims if an interference is declared. Cf. *Philadelphia Storage Battery Co. v. Zenith Radio Corp.*, 117 F. (2d) 642, 645 (C. C. A. 7).

B. LEGISLATIVE HISTORY

There is considerable evidence in the legislative history of Rev. Stat. 4915 to indicate that (1) Rev. Stat. 4915 was intended to cover a case such as that at bar, in which claims copied to provoke an interference were rejected for want of support in the applicant's disclosure, and (2) Rev. Stats. 4911 and 4915 were intended to be coextensive remedies.

(1) The bill in equity under Rev. Stat. 4915 and the appeal to the Court of Customs and Patent Appeals under Rev. Stat. 4911 are now alternative remedies; invocation of one precludes resort to the other. (See Rev. Stats. 4911, 4915). But prior to 1927, these remedies were successive rather than alternative, and an unsuccessful appeal under Rev. Stat. 4911 was a condition precedent to a bill in equity under Rev. Stat. 4915. See Appendix A, pp. 48-49, *infra*; *Kirk v. Commissioner of Patents* (1886) C. D. 440 (Sup. Ct. D. C.); *Fekete v. Robertson*, 17 F. (2d) 335 (App. D. C.); *Cooper v. Robertson*, 38 F. (2d) 852 (D. Md.). The jurisdiction over appeals under Rev. Stat. 4911 now exercised by the Court of Customs and Patent Appeals was then vested in the United States Court of Appeals for the District of Columbia. See Appendix A, pp. 49-50, *infra*. And while jurisdiction over suits in equity under Rev. Stat. 4915 was not (and is not) limited to any particular United States District Court, as a practical matter a suit against the Commissioner of Patents would lie only in the District of Columbia, where he could always be found, unless he consented to be sued in another district. *Butterworth v. Hill*, 114 U. S. 128. Thus, in the usual case prior to 1927, the Rev. Stat. 4915 suit would eventually come before the same court of appeals that had already adversely disposed of the applicant's appeal under Rev. Stat. 4911. Dissatisfaction with this situation was a major considera-

tion leading to the 1927 Act, which made the two procedures alternative.

To illustrate the alleged futility of a second appeal to the same court of appeals, reference was made to *Dilg v. Moore*, 34 App. D. C. 106, at the hearings on one of the earlier bills before the House Committee on Patents.⁷ In that case, claims copied from an outstanding patent in order to provoke an interference were rejected by the Patent Office exactly as in the instant case. Following an unsuccessful appeal under Rev. Stat. 4911 to the Court of Appeals for the District of Columbia, the applicant brought a suit in equity under Rev. Stat. 4915 in the Supreme (now the District) Court for the District of Columbia. In affirming a judgment adverse to the applicant, the Court of Appeals stated (34 App. D. C. at 109):

We are unable to discover wherein the position of appellant has been improved since his last appearance in this court. At that time, his right to make these claims was carefully considered, and we find no reason to change or revise the opinion then given.

While the point here at issue was not mentioned, the reference to *Dilg v. Moore* as an example of a ruling reviewable under Rev. Stat. 4915, indicates at least the understanding that such a situation could be made the subject of a suit in equity even

⁷ Hearings, House Committee on Patents, on H. R. 6252 and H. R. 7087 (69th Cong., 1st Sess.), pp. 25, 46-52.

though the action was one in which further proceedings would be necessary before any patent could be issued, and no one present at the hearing challenged this tacit assumption. That this assumption must have been fairly general may be gathered from the fact that prior to the 1927 Act (which, as we shall show later, reenacted Rev. Stat. 4915 without modifying its language of coverage, see pp. 22-25, *infra*), the courts had assumed jurisdiction without question under Rev. Stat. 4915 of Patent Office rulings which, if reversed by the court, would not preclude further proceedings in the Patent Office. Thus, in *Gold v. Newton*, 254 Fed. 824 (C. C. A. 2), a decree in favor of the applicant in a Rev. Stat. 4915 suit on the issue of priority was held not to require the Commissioner to issue the patent if he thereafter discovered a new reference anticipating the applicant's claims. And in *Potter v. Dixon*, 19 Fed. Cas. 1145, 1146 (S. D. N. Y.), where it was held that a decree for the applicant, in an appeal from an award of priority by the Patent Office,

* See also Report of the Investigation of the United States Patent Office made by the President's Commission on Economy and Efficiency, December 1942, H. Doc. No. 1110 (62d Cong., 3d Sess.), pp. 207-208.

"There appears to be an idea quite generally accepted in this country that a citizen is entitled to have any question of fact or of law finally decided by the judicial branch of the Government. So far as decisions in patent matters are concerned, the policy of allowing every question decided in the Patent Office to be reviewed in a court, is one that has existed from the beginning of the patent system."

did not require the issuance of a patent if the applicant failed to prevail in a subsequent interference proceeding with a different outstanding patent, the court said that the same effect would be given to the decree "if the proceedings had taken place in a suit at law or in equity."

(2) The evolution of Rev. Stats. 4911 and 4915 in their present form indicate a congressional intention that they should be coextensive in their scope. Rev. Stat. 4915 finds its origin in the Patent Act of 1836,⁹ which gave an applicant, aggrieved by a ruling of the Commissioner of Patents, a right of appeal to a "board of examiners * * * appointed for that purpose by the Secretary of State." Sec. 7 of Act of July 4, 1836 (5 Stat. 119-120. See Appendix A,

⁹ Act of July 4, 1836, 5 Stat. 117 *et seq.*; see Appendix A, *infra*, pp. 40-43. Prior to 1836, no provision was made for judicial review of the grant or denial of patents. Under the first patent statute (Act of April 10, 1790, 1 Stat. 109), entrusting the granting of patents on application to a board consisting of the Secretary of State, the Secretary of War, and the Attorney General, proposals for appeals had been rejected (see 22 Journ. Pat. Off. Soc., pp. 269-270, 358), and there was no review even though the board refused patents for want of novelty or of utility and importance. Sen. Doc. No. 338 (24th Cong., 1st Sess.), p. 2. Under the Patent Act of 1793 (Act of February 21, 1793, 1 Stat. 318), administered by a superintendent of patents under the Secretary of State but subject to revision by the Attorney General, there was little need for judicial review, since the Act, as construed, merely provided for a registration system, under which patents were granted to anyone who fulfilled the formal requirements, without examination into novelty or usefulness. Sen. Doc. No. 338 (24th Cong., 1st Sess.), p. 2.

p. 41, *infra*). Section 16 of the same Act provided in part that:

whenever a patent on application shall have been refused on an adverse decision of a board of examiners, on the ground that the patent applied for would interfere with an unexpired patent previously granted, * * * any such applicant * * * may have remedy by bill in equity; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, * * * may * * * adjudge that such applicant is entitled, according to the principles and provisions of this act, to have and receive a patent for his invention, as specified in his claim, or for any part thereof, as the fact of priority of right or invention shall in any such case be made to appear. And such adjudication, if it be in favor of the right of such applicant, shall authorize the Commissioner to issue such patent, on his filing a copy of the adjudication, and otherwise complying with the requisitions of this act. * * *

This made provision for a bill in equity only where the application was rejected on account of an interference with an outstanding patent. Section 8 of the Act of March 3, 1837 (5 Stat. 191, see Appendix A, p. 43, *infra*) extended this remedy to an applicant "for any addition of a newly-discovered improvement to be made to an existing patent" or for "correction and re-issue" of

a patent. Two years later the remedy by bill in equity was further extended by Section 10 of the Patent Act of 1839

to all cases where patents are refused for any reason whatever, either by the Commissioner of Patents or by the chief justice of the District of Columbia, upon appeals from the decision of said Commissioner, as well as where the same shall have been refused on account of, or by reason of interference with a previously existing patent * * *. [5 Stat. 353; see Appendix A; *infra*, p. 44].¹⁰

The patent laws were revised, consolidated, and amended by the Patent Act of 1870, which

¹⁰ Section 11 of the 1839 Act substituted for the appeal to a "board of examiners" an appeal to the Chief Justice of the District Court of the United States for the District of Columbia, who might "revise" the decisions of the Commissioner of Patents "in a summary way, on the evidence produced before the Commissioner," and his decision upon certification to the Commissioner, was to "govern the further proceedings of the Commissioner in such case." But the "decision of the Judge in any such case" was not to preclude contesting the validity of any patent "in any judicial court" (see Appendix A, pp. 44-46, *infra*).

By the Act of August 30, 1852 (10 Stat. 75. See Appendix A, p. 46, *infra*), the appeal might "also be made to either of the assistant judges of the Circuit Court of the District of Columbia." When, on March 3, 1863, the Circuit Court was replaced by the Supreme Court of the District of Columbia consisting of a Chief Justice and three Associate Justices, the individual justices of the new court succeeded to the jurisdiction to hear appeals from the Patent Office even though the Act creating the court did not mention appeals from the Commissioner of Patents. Act of March 3, 1863 (12 Stat. 762).

provided (Sec. 46) that in *ex parte* cases "every applicant for a patent or the reissue of a patent, any of the claims of which have been twice rejected" by the Commissioner could appeal to the Supreme Court of the District of Columbia, sitting in banc (thus replacing the earlier appeal to the individual judges; see footnote 10, *supra*, p. 18).¹¹ The court was "to revise the decision appealed from in a summary way, on the evidence produced before the commissioner" and the "certificate of its proceedings and decision," when returned to, and recorded in the Patent Office, was to "govern the further proceedings in the case" (Sec. 50). See Appendix A, *infra*, pp. 46-47.

Section 52 of the 1870 Act provided in part that:

whenever a patent on application is refused, *for any reason whatever*, either by the commissioner or by the supreme court

¹¹ As passed by the House, the bill eliminated the appeal, while retaining the remedy by bill in equity, H. R. No. 1714; Cong. Globe (41st Cong., 2d Sess.), p. 4820, the purpose being to remove defects inherent in the appellate procedure since 1852. Congressman Jenckes, of the House Committee on Patents, in presenting the bill before the House, referred to the "judges sitting separately and each deciding according to his own notions of the scientific part of any case which happened to come up, and, what was equally bad if not worse, according to his own views of the law in each particular case. There was no concert between them, no consultation, no deference to each other's opinions; and this led to different decisions in the same class of cases." Cong. Globe (41st Cong., 2d Sess.), pp. 2679-2683.

of the District of Columbia upon appeal from the commissioner, the applicant may have remedy by bill in equity; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent, on the applicant filing in the patent office a copy of the adjudication, and otherwise complying with the requisitions of law. [16 Stat. 198; see Appendix A, *infra*, pp. 47-48.], [Italics supplied.]

Contrary to the literal terms of this section permitting a bill in equity following an adverse decision of the Commissioner of Patents, an appeal from the decision of the Commissioner to the Supreme Court of the District of Columbia was required in *ex parte* cases, before an equity suit would lie. *Kirk v. Commissioner of Patents* (1886) C. D. 440 (Sup. Ct. D. C.), and cases cited *supra*, p. 13.

The language of the 1870 Act was substantially the same, insofar as here relevant, as the present Rev. Stat. 4915, except for the phrase "for any reason whatever." Three years later, when Section 52 of the 1870 Act became Section 4915 of

the Revised Statutes of 1873,¹² the phrase "for any reason whatever" (italicized *supra*) was deleted. No express reference to this change is found in the legislative history, but from the announced general purpose of the revision not "to attempt any change whatever in the existing law" except "mere changes of phraseology not affecting the meaning of the law", it would appear that no change in meaning was intended.¹³

¹² At the same time, Sections 48-51 of the 1870 Act providing for appeal from the Patent Office to the Supreme Court of the District of Columbia became Sections 4911-4914 of the Revised Statutes.

¹³ In reporting H. R. No. 1215 (43rd Cong., 1st Sess.), which ultimately became the Revised Statutes of 1873, the spokesman for the Committee on Revision of the Laws stated to the House:

"The committee have decided that in their judgment it was not advisable to attempt any change whatever in the existing law. By the original law of 1866, under which the commissioners were appointed, they were authorized to make changes to some extent, of which liberty they availed themselves—probably not to any greater extent than they were warranted in doing by the law under which they were appointed. But the Committee on Revision of the Laws at the last Congress came to the conclusion that within the limited time that could be allowed for the work in this House, it would be utterly impossible to carry the measure through, if it was understood that it contained new legislation. Therefore the committee, when they employed Mr. Durant to go over this work, directed him, in every case where he found that new legislation had been inserted by the commissioners, to strike out such modifications of the existing law. This, of course, did not refer to mere changes of phraseology not affecting the meaning of the law; but he was directed, wherever the meaning of the law had been changed, to strike out such changes. Mr. Durant has in the main done this.

It is reasonable to believe that the phrase "for any reason whatever"—which was highly significant when it first appeared in the Patent Act of 1839 (extending the remedy by bill in equity beyond the refusal of patents on account of interference with an outstanding patent)—appeared to the revisers as a redundancy when it followed the clause "whenever a patent on application is refused."

Except for the transfer in 1893 of the appellate jurisdiction of the Supreme Court of the District to the newly created United States Court of Appeals for the District of Columbia (Judiciary Act of 1893, 27 Stat. 434, 436; see Appendix A, *infra*, p. 49), and the reinstatement of the appeal in interference cases, which had been abolished in 1870, the provisions for appeal and bill in equity contained in the Revised Statutes continued in effect until 1927. However, at various times, proposals were advanced for reducing the number of appeals both within the Patent Office and to

* * * the work has been presented with such changes and amendments as we find necessary to make that it will be an exact transcript, an exact reflex, of the existing statute law of the United States—that there shall be nothing omitted and nothing changed." 2 Cong. Rec. 646; see also pp. 647-648. Some changes, later made in evening sessions on the floor of the House, have no pertinence here. See 2 Cong. Rec., pp. 829, 849-58, 995-1001, 1027, 1031, 1206, 1215, 1249-54, 1414-17, 1460-62, 1611-20, 1657-62, 1789-95, 1819-1825, 1968-76, 2005-2013, 2251-2255, 2709-14. On the Senate floor, it was noted that the bill included the revision of the patent laws that had "passed Congress already," i. e., in 1870. 2 Cong. Rec. 4285.

the courts. After the 1893-Act, the sequence of appeals from the Examiner in *ex parte* cases was as follows: Board of Examiners-in-Chief; Commissioner of Patents; appeal to Court of Appeals of the District of Columbia; suit in equity in the District Supreme Court; appeal to the Court of Appeals. Thus, as noted earlier (p. 13), an unsuccessful appeal to the Court of Appeals for the District of Columbia under Rev. Stat. 4911 could be followed by a Rev. Stat. 4915 suit in the Supreme Court of the District of Columbia and an appeal therefrom to the same Court of Appeals.

In the hearings on the bills which became the Act of March 2, 1927 (44 Stat. 1335 *et seq.*), proposals were made to Congress to eliminate either the appeal or the bill in equity. Elimination of the appeal was recommended by the Report of Committee on Patent Office Procedure submitted to the Secretary of Commerce, April 15, 1926. A similar recommendation was made by the Patent Section of the American Bar Association and embodied in H. R. 7087 (69th Cong., 1st Sess.). The Commissioner of Patents favored elimination of the bill in equity, but retention of the appeal. Hearings, House Committee on Patents, on H. R. 6252 and H. R. 7087 (69th Cong., 1st Sess.) p. 82; Hearings, House Committee on Patents, on H. R. 7563 and H. R. 13487 (69th Cong., 2d Sess.) pp. 8, 14; Hearings, Senate Com-

mittee on Patents, on S. 4812 (69th Cong., 2d Sess.) p. 15.

The resulting Act of 1927 eliminated neither remedy, but permitted the applicant "to have the decision of the Patent Office reviewed either by the court of appeals or by filing a bill in equity, but not both." S. Rep. No. 1313 (69th Cong., 2d Sess.) p. 4; H. Rep. No. 1889 (69th Cong., 2d Sess.) pp. 2-3.¹³ No change appears to have been intended in the kind of rulings to which these remedies were to be applicable. Thus the House Report stated (p. 3) that "under the proposed procedure the defeated party has all the rights and remedies that he had under the old procedure, but the appeals are reduced so that there are but three appeals." A major reason for retention of the bill in equity appears to have been the fact that it permitted the applicant to adduce oral testimony, whereas the appeal under Rev. Stat. 4911 was confined to the record before the Patent Office, which in *ex parte* cases under

¹³ Thereafter, the remedy by bill in equity, rarely used prior to 1927, was resorted to with greater frequency. Hearings, House Committee on Patents, on H. R. 6252 and H. R. 7087 (69th Cong., 1st Sess.), pp. 17, 71, 73; Federico, *Evolution of Patent Office Appeals* (1940), 22 Journ. Pat. Off. Soc. 920, 940-941. A study of the Patent Office for the last ten years reveals that *ex parte* cases in the Court of Customs and Patent Appeals (which succeeded the Court of Appeals in Rev. Stat. 4911 cases in 1929) declined from 114 in 1934 to 70 in 1944, whereas Rev. Stat. 4915 cases increased from 24 in 1934 to 57 in 1944 (71 in 1943). See Appendix B, p. 66, *infra*.

the Rules of the Patent Office could not (and cannot now) include oral testimony.¹⁴ The Act of March 2, 1929 (45 Stat. 1475; see Appendix A, *infra*, pp. 52-53) transferring to the Court of Customs and Patent Appeals jurisdiction over appeals from the Patent Office, had no effect upon the scope of Rev. Stats. 4911 and 4915, for the only purpose of the Act was to reduce the burden of work on the Court of Appeals,¹⁵ and it expressly disclaimed any intention to affect "in any way the jurisdiction of the Court of Appeals of the District of Columbia in equity cases." Cf. *Sinko Tool & Manufacturing Co. v. Automatic Devices Corp.*, 136 F. (2d) 186 (C. C. A. 2).¹⁶

The foregoing materials show, we believe, that Congress intended Rev. Stat. 4915 and Rev. Stat. 4911 to be coextensive. Since 1829, when the remedy by bill in equity was extended to the

¹⁴ Hearings, House Committee on Patents, on H. R. 6252 and H. R. 7087 (69th Cong., 1st Sess.), pp. 21-22; Hearings, House Committee on Patents, on H. R. 7563 and H. R. 13487 (69th Cong., 2d Sess.), p. 11; Hearings, Senate Committee on Patents, on S. 4812 (69th Cong., 2d Sess.), p. 15.

¹⁵ Hearings, House Committee on the Judiciary, on H. R. 6687 (70th Cong., 1st Sess.) *passim*; cf. Hearings, House Committee on Patents, on H. R. 7563 and H. R. 13487 (69th Cong., 2d Sess.), p. 31; Hearings, House Committee on Patents on H. R. 6252 and H. R. 7087 (69th Cong., 1st Sess.), p. 79.

¹⁶ The Act of August 5, 1939 (53 Stat. 1212) modified Rev. Stats. 4911 and 4915 only insofar as necessary to conform their wording to the provisions reducing the number of appeals within the Patent Office in interference cases. See Appendix A, *infra*, pp. 53-54.

refusal of a patent "for any reason whatever," the chief difference between the two remedies (other than the kind of tribunals involved) has been the summary review provided by the appeal, on the record before the Patent Office, as against the trial *de novo* in the equity suit, where new evidence may be introduced and oral testimony taken; but their coverage was seemingly the same, since they were successive remedies. Both in 1870 and 1927 when Congress reexamined and re-enacted these remedies, the emphasis was upon whether one or the other should be eliminated. There is absent any suggestion that Rev. Stat. 4915 would have a narrower application than Rev. Stat. 4911, or that the former would apply only to those cases where the court could direct that a patent should issue without further proceedings in the Patent Office. As already noted, the contrary inference is to be gathered from the reference in the 1927 hearings to the case of *Dilig v. Moore*, in which the Court of Appeals reviewed in a Rev. Stat. 4915 suit the right of an applicant to make a claim copied from an outstanding patent. See also *Gandy v. Marble*, 122 U. S. 432, 440, in which this Court said that "The decision of the court on a bill in equity becomes, equally with the judgment * * * on a direct appeal under § 4911, the decision of the Patent Office, and is to govern the action of the Commissioner." Cf. *Cleveland Trust Co. v. Berry*, 99 F. (2d) 517, 521.

C. JUDICIAL PRACTICE

1. While the decision below appears to be the first in which the question has been raised whether Rev. Stat. 4915 confers jurisdiction in the situation here involved, there are a number of earlier cases in which the court below and other Federal courts exercised jurisdiction without question in the identical circumstances. In the following cases, suits in equity under Rev. Stat. 4915 were heard and determined to review the rejection by the Patent Office of claims which the record showed had been copied from an outstanding patent in order to provoke an interference, and which were disallowed in the Patent Office for want of support in the applicant's disclosure: *Dilg v. Moore*, 34 App. D. C. 106 (three claims in a divisional application); *Power Patents Co. v. Coe*, 110 F. (2d) 550 (App. D. C.) (eight claims in a divisional application); *Tully v. Robertson*, 19 F. (2d) 954 (D. Md.) (several claims in an original application and a continuation-in-part application); *Monopower Corp. v. Coe*, 33 F. Supp. 934 (D. D. C.) (nine claims in an original application); *Forward Process Co. v. Coe*, 116 F. (2d) 946 (App. D. C.) (one claim in an original application). In *E. I. Du Pont De Nemours & Co. v. Coe*, 89 F. (2d) 679 (App. D. C.), claims in a reissue application, copied from another pending application in order to provoke an interference, had been rejected by

the Patent Office on the ground that the applicant was estopped to assert them under Rule 109 of the Patent Office, (see, Appendix A, p. 62, *infra*), and the court below affirmed this action on the merits in a Rev. Stat. 4915 suit. And, in *Booth Fisheries Corp. v. Coe*, 114 F. (2d) 462 (App. D. C.) certiorari denied, 311 U. S. 691, where the court affirmed on the merits a refusal to grant a reissue patent which was to include claims copied from outstanding patents, the record showed that an adjudication favorable to the applicant would have required further proceedings in the Patent Office.

In other cases, the courts have exercised without question jurisdiction to review other kinds of rulings by the Patent Office, even though the record before the court disclosed that further proceedings in the Patent Office would be necessary following an adjudication favorable to the applicant. Thus, in *International Cellucotton Products Co. v. Coe*, 85 F. (2d) 869, and *American Cyanamid Co. v. Coe*, 106 F. (2d) 851, the court below reversed a ruling by the Patent Office (which the District Court had affirmed) disallowing certain claims of an original application on which an interference was sought, on grounds of estoppel under Rule 109 of the Patent Office. On the remand to the Patent Office, the issue of priority was of course open for consideration, and in fact the desired interference was declared in the *Cellucotton* case.

Patented File, Thompson Patent No. 2,134,459."

Even where the controversy in the Patent Office merely involves a requirement of division, the court below has accepted jurisdiction under Rev. Stat. 4915. In *Pitman v. Coe*, 68 F. (2d) 412 (App. D. C.), a Patent Office ruling required division of a renewal application into two applications, and in a Rev. Stat. 4915 suit to test that ruling, the court's jurisdiction was questioned, the contention being made that the remedy lay in the Court of Customs and Patent Appeals. Although the ruling assailed merely required two applications instead of one, the court below held that there was jurisdiction, saying (at p. 414): "There is no reason to believe that Congress intended that any remedy which might be obtained by appeal should be more extensive or complete than that allowed by bill in equity. * * * The difference between the two is a difference of procedure rather than a difference of interest."

Where the record does not show that further proceedings will be required in the Patent Office, e. g., where the sole question presented is one of invention, the court below has not hesitated to entertain suits against the Commissioner under

¹⁷ The doctrine of the *Cellucotton* case was applied by the District Court of the District of Columbia in *Youngstown Sheet and Tube Co. v. Coe*, Civil Action No. 5460, decided April 8, 1941 (unreported) and thereafter an interference proceeding was instituted in the Patent Office on the same claims in issue in the Rev. Stat. 4915 suit. Patented Files, Adams Patents, Nos. 2,335,894, and 2,335,895.

Rev. Stat. 4915. *American Steel and Wire Co. v. Coe*, 105 F. (2d) 17 (App. D. C.); *Abercrombie v. Coe*, 119 F. (2d) 458 (App. D. C.); *General Motors Corp. v. Coe*, 120 F. (2d) 736 (App. D. C.); *Hydraulic Press Corp. v. Coe*, 124 F. (2d) 521 (App. D. C.); *Minnesota Mining & Manufacturing Co. v. Coe*, 125 F. (2d) 198 (App. D. C.) This is true, even though the court's favorable ruling on patentability may be followed by interference proceedings in the Patent Office which deprive the applicant of a patent, because of want of priority, on the very claims which the court had allowed. *Radtke Patents Corp. v. Coe*, 122 F. (2d) 937 (App. D. C.), certiorari denied, *sub nom. American Tri-Ergon Corp. v. Radtke Patents Corp.*, 314 U. S. 695; *Poulsen v. McDowell*, 142 F. (2d) 267 (C. C. P. A.). And conversely, where an applicant has been successful in a Rev. Stat. 4915 proceeding on the issue of priority, there has been no challenge by the courts to the right of the Patent Office subsequently to disallow the same claims for want of invention over a newly discovered reference. *Gold v. Newton*, 254 Fed. 824 (C. C. A. 2). Cf. *Potter v. Dixon*, 19 Fed. Cas. 1145, (C. C. S. D. N. Y.). Such has been the consistent administrative practice in the Patent Office. Following an adjudication in favor of an applicant in a suit under Rev. Stat. 4915, based either upon patentability or priority, the Patent Office has felt free to disallow the claims in issue on account of a newly discovered

reference, or of want of priority over newly discovered patents or applications. See letter from Commissioner of Patents, Appendix C, *infra*, p. 67.

The court below relied upon *Hill v. Wooster*, 132 U. S. 693, to support the proposition that "A proceeding under Section 4915 R. S. cannot select a single issue which affects plaintiff's right to a patent, without determining all the other issues on which that right depends." But, in that case, involving a contest over priority where the Patent Office had failed to inquire into the question of invention, this Court merely held that it would refuse an adjudication in favor of the applicant, unless the applicant showed to the Court that the alleged invention for which a patent was sought in fact constituted an invention. The case did not purport to decide what Patent Office rulings were reviewable under Rev. Stat. 4915. Similarly, *Radtke Patents Corporation v. Coe*, 122 F. (2d) 937 (App. D. C.), certiorari denied, 314 U. S. 695, upon which the court below also relied, merely held that upon review of a Patent Office ruling on priority, the court would also inquire into the question of invention.

2. The question of jurisdiction under Rev. Stat. 4915 has been raised in a number of situations involving procedural rulings. In most of them jurisdiction has been denied, but the Court of Customs and Patent Appeals has likewise de-

clined jurisdiction under Rev. Stat. 4911 in such situations. And a distinction has in several cases been expressly noted between a procedural ruling and one which denies a patent "on the merits."

In *Butterworth v. Hoe*, 112 U. S. 50, 68, holding that the Secretary of the Interior lacked authority to reverse a decision by the Commissioner of Patents to issue a patent, this Court stated: "The remedy by bill in equity under § 4915 is not appropriate, because it applies only when the Commissioner decides to reject an application for a patent, on the ground that the applicant is not, on its merits, entitled to it." Thus, in *Shoemaker v. Robertson*, 54 F. (2d) 456 (App. D. C.), the refusal to consider an application lacking the required number of signatures was held unreviewable under Rev. Stat. 4915; on the authority of the above-cited dictum in *Butterworth v. Hoe*. A like reason has been advanced for denying review of the refusal to consider claims tendered in an unresponsive amendment to an application (*Chessin v. Robertson*, 63 F. (2) 267 (App. D. C.) certiorari denied, 289 U. S. 725), or claims first advanced in an untimely petition for reconsideration of the rejection of other claims (*Cherry-Burrell Corp. v. Coe*, 143 F. (2d) 372 (App. D. C.)). The bill in equity under Rev. Stat. 4915 has been held unavailable to challenge the denial of a petition to revive an abandoned application, the courts taking the view that the appellant "has no pending application in the Pat-

ent Office" (*Chessin v. Robertson*, 63 F. (2d) 267 (App. D. C.)) or that the matter is "entirely within the discretion" of the Commissioner, and is not "equivalent to the refusal to grant a patent" as required by Rev. Stat. 4915 (*Cregier v. Coe*, 67 F. (2d) 692 (App. D. C.) certiorari denied, 291 U. S. 683). Jurisdiction under Rev. Stat. 4915 has also been held lacking to review the granting of a motion to dissolve an interference or the denial of a motion to add counts to an interference under Rule 109 of the Rules of Practice in the Patent Office, such rulings being characterized as "interlocutory" and "not the same as a refusal of a patent" (*Synthetic Plastics Co. v. Ellis-Foster Co.*, 78 F. (2d) 847 (C. C. A. 3); *American Cable Co. v. John A. Roebling's Sons Co.*, 65 F. (2d) 801 (App. D. C.)).¹⁸

Many of the rulings held unreviewable under Rev. Stat. 4915 have likewise been held unreviewable by the Court of Customs and Patent Appeals under Rev. Stat. 4911. *Spatafora v. Zaiger*, 69 F. (2d) 118 (C. C. P. A.) (ruling amounting to dissolution of an interference); *Carlin v. Goldberg*, 45 App. D. C. 540 (granting of motion to dissolve interference); *In Re Stern*, 40 F. (2d) 1000 (C. C. P. A.) (refusal to consider claims presented after decision by Board of Appeals on the merits of other claims); *In Re Slate*, 108 F. (2d) 268 (C. C. P. A.) (same); *In Re Marrogenis*, 57 F. (2d) 361 (C. C. P. A.) (refusal to revive an

¹⁸ Cf. *Pitman v. Coe*, discussed *supra*, p. 29.

abandoned application). It is doubtful that review by mandamus would be available in these cases.¹⁹

D. THE NATURE OF THE PATENT OFFICE RULING IN THIS CASE

Apparently relying upon the cases refusing to review the dissolution of interference proceedings, the court below characterized the rejection of the copied claims in the case at bar, as a "preliminary step" or an "intermediate proceeding," inappropriate for the intervention of equity. This view, we believe disregards the final character of the ruling in question. Unlike the dissolution of an interference proceeding or the refusal to expand it, which allows the applicant to continue the

¹⁹ Cf. *Steinmetz v. Allen*, 192 U. S. 543 (permitting mandamus to review requirement of division under rule prohibiting joinder of process and structure claims in the same application); *Coe v. United States ex rel. Remington Rand Inc.*, 84 F. (2d) 240 (App. D. C. 1936) (allowing mandamus to compel consideration of an amendment offered in part to meet the objections noted by the Primary Examiner in the first rejection of certain claims in an application); *Minnesota Mining & Manufacturing Co. v. Coe*, 143 F. (2d) 12 (App. D. C.) (refusing mandamus to compel Commissioner to enter an amendment to an application which had been finally rejected by the Primary Examiner, including claims copied from another application to provoke an interference); *Scenson v. Coe*, 101 F. (2d) 684 (App. D. C.) (refusing mandamus to compel Commissioner to hold public use proceedings); *United States ex rel. American Gas Accumulator Co. v. Coe*, 84 F. (2d) 398 (App. D. C.) (refusing mandamus to compel Commissioner to enter judgment in conformity with ruling of interference examiner on motion to dissolve interference).

prosecution of his claims *ex parte* and permits a later Rev. Stat. 4915 suit in the event that the claims are finally rejected by the Patent Office (cf. *American Cable Co. v. John A. Roebling's Sons Co.*, 65 F. (2d) 801 (App. D. C.); *Synthetic Plastics Co. v. Ellis-Foster Co.*, 78 F. (2d) 847 (C. C. A. 3)), the rejection of claims *ex parte* for want of support in the applicant's disclosure definitively eliminates those claims insofar as the administrative processes of the Patent Office are concerned, so that at no later stage in the prosecution of the application will there be an opportunity to test the rejection of the copied claims by a Rev. Stat. 4915 suit.²⁰ Inasmuch as this finally disposes of petitioner's claim, it cannot be regarded as a mere procedural ruling. The condition upon which the court below indicated it would take jurisdiction—i. e., where the ques-

²⁰ Although the alternative procedure under Rev. Stat. 4911 would normally be available, this would not afford the applicant a judicial remedy, since the Court of Customs and Patent Appeals in such cases acts in an administrative capacity on the Patent Office record, and its decision cannot be reviewed in this or any other court. *Postum Cereal Co. v. California Fig Nut Co.*, 272 U. S. 693, 699; *Frasch v. Moore*, 211 U. S. 1; *Butterworth v. Hoe*, 112 U. S. 50. It is well established that a proceeding under Rev. Stat. 4915 is judicial. *Butterworth v. Hoe*, 112 U. S., at 61; *Gandy v. Marble*, 122 U. S. 432; *Hill v. Wooster*, 132 U. S. 693; *Morgan v. Daniels*, 153 U. S. 120; *Victor Talking Machine Company v. Brunswick-Balke-Collender Company*, 273 U. S. 670; *Westinghouse Electric & Mfg. Co. v. De Forest Radio, Telephone & Telegraph Co.*, 278 U. S. 562; *Cleveland Trust Co. v. Berry*, 99 F. (2d) 517 (C. C. A. 6); *Cleveland Trust Co. v. Nelson*, 51 F. (2d) 276 (D. Mich.).

tion of priority as well as invention could be decided on the record—can never be met here, since with the rejection of the instant claims petitioner is denied any opportunity to make a record in the Patent Office as to his priority with respect to the like claims in the interference. Thus, the ruling by the Patent Office is just as final as an order by a trial court sustaining a demurrer to a complaint or dismissing a complaint for want of jurisdiction. That the tribunal, if reversed, may upon further consideration of the case, again decide against the complainant on another ground does not detract from the finality of the earlier ruling.

The fact that the Patent Office did not refuse the entire reissue application (having allowed sixteen claims therein) is likewise no bar to the applicability of Rev. Stat. 4915. That provision authorizes the court to adjudicate that the applicant is entitled to receive a patent for his invention "as specified in his claim *or for any part thereof*" (italics supplied)—an indication that the controversy presented may be the validity of only a part of the subject matter of the patent applied for. Moreover, the legislative materials show that the italicized words now refer to one or more claims of an application. As noted earlier, (pp. 16-17), the words "as specified in his claim, or for any part thereof" originated in Section 16 of the Patent Act of 1836. Under the practice then pre-

vailing, there was only one claiming paragraph, sometimes called the "claim" or the "claiming part," and when more than one claim was made in an application, they were included in the claim paragraph separated only by a phrase such as "I also claim." Thereafter, the current practice evolved of inserting separate claims in separately numbered paragraphs. See Lutz, *Evolution of the Claims of United States Patents*, 20 Journ. Pat. Off. Soc., 457, 469. Hence "any part" of an applicant's "claim" would cover what is now referred to as a "claim." Furthermore, unless the final rejection of any claim is a refusal of a "patent" under Rev. Stat. 4915, the remedy by bill in equity would not be available even if all but the least important claim in an application were rejected—an intention not to be imputed to Congress.²¹

While the rejected claims here involved were copied from another patent, that fact should not affect the jurisdictional question in this case. The copying by an applicant of another's claims thought to fall within the disclosure of the applicant is the approved method of crystallizing the

²¹ As we have developed more fully (*supra*, pp. 16-26), the suit in equity under Rev. Stat. 4915 and the appeal to the Court of Customs and Patent Appeals under Rev. Stat. 4911 were intended to be coextensive, and the latter plainly permits review of a decision of the Patent Office rejecting "any of the claims" in an application (Rev. Stat. 4909, 4911; see Appendix A, *infra*, pp. 55-56).

issue of relative priority in time, for substantial identity of competing claims is an essential to the administrative consideration of priority. Rules 93 and 94 of Patent Office; Rev. Stat. 4904; see Appendix A, *infra*, pp. 55, 59-62.

The court below considered this method of provoking interference proceedings to be "artificial" and subject to criticism (R. 146). Whether or not such criticism is deserved, it does not appear to have any bearing on the reviewability under Rev. Stat. 4915 of the rejection of copied claims. Regardless of the origin of the claims, their inclusion within the issued patent would constitute a valuable right by placing the petitioner in the position to assert a *prima facie* title to the subject matter. Conversely, denial of the claim limits the scope of the patent to that extent, and in a subsequent infringement suit, the patent will be treated as inoperative with respect to the subject matter covered by the rejected claims. Walker, *Patents* (Deller's Ed., 1937) p. 1366. If the allowed claims covered the same subject matter as the rejected claims, the rejection would merely deprive petitioner of a decision by the Patent Office on the priority issue, but nothing in the record shows that this is the case here.

CONCLUSION

For the foregoing reasons, we believe that the judgment below should be reversed, and the cause

remanded for consideration of petitioner's case
on the merits. *

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APPENDIX A

STATUTES AND REGULATIONS

I. STATUTES

1. The Act of July 4, 1836 (5 Stat. 117, 119-120, 123-124) provided, in part, as follows:

SEC. 7. * * * That, on the filing of any such application, description, and specification, and the payment of the duty herein-after provided, the Commissioner shall make or cause to be made, an examination of the alleged new invention or discovery; and if, on any such examination, it shall not appear to the Commissioner that the same had been invented or discovered by any other person in this country prior to the alleged invention or discovery thereof by the applicant, or that it had been patented or described in any printed publication in this or any foreign country, or had been in public use or on sale with the applicant's consent or allowance prior to the application, if the Commissioner shall deem it to be sufficiently useful and important, it shall be his duty to issue a patent therefor. But whenever, on such examination, it shall appear to the Commissioner that the applicant was not the original and first inventor or discoverer thereof, or that any part of that which is claimed as new had before been invented or discovered, or patented, or described in any printed publication in this or any foreign country, as aforesaid, or that the description is defective and insuffi-

cient, he shall notify the applicant thereof, giving him, briefly, such information and references as may be useful in judging of the propriety of renewing his application, or of altering his specification to embrace only that part of the invention or discovery which is new. In every such case, if the applicant shall elect to withdraw his application, relinquishing his claim to the model, he shall be entitled to receive back twenty dollars, part of the duty required by this act, on filing a notice in writing of such election in the Patent Office, a copy of which, certified by the Commissioner, shall be a sufficient warrant to the Treasurer for paying back to the said applicant the said sum of twenty dollars. But if the applicant in such case shall persist in his claim for a patent, with or without any alteration of his specification, he shall be required to make oath or affirmation anew, in manner as aforesaid. And if the specification and claim shall not have been so modified as, in the opinion of the Commissioner, shall entitle the applicant to a patent, he may, on appeal, and upon request in writing, have the decision of a board of examiners, to be composed of three disinterested persons, who shall be appointed for that purpose by the Secretary of State, one of whom at least, to be selected, if practicable and convenient, for his knowledge and skill in the particular art, manufacture, or branch of science to which the alleged invention appertains; who shall be under oath or affirmation for the faithful and impartial performance of the duty imposed upon them by said appointment. Said board shall be furnished with a certificate in writing, of the opinion

and decision of the Commissioner, stating the particular grounds of his objection, and the part or parts of the invention which he considers as not entitled to be patented. And the said board shall give reasonable notice to the applicant, as well as to the Commissioner, of the time and place of their meeting, that they may have an opportunity of furnishing them with such facts and evidence as they may deem necessary to a just decision; and it shall be the duty of the Commissioner to furnish to the board of examiners such information as he may possess relative to the matter under their consideration. And on an examination and consideration of the matter by such board, it shall be in their power, or of a majority of them, to reverse the decision of the Commissioner, either in whole or in part, and their opinion being certified to the Commissioner, he shall be governed thereby in the further proceedings to be had on such application: *Provided, however;* That before a board shall be instituted in any such case, the applicant shall pay to the credit of the Treasury, as provided in the ninth section of this act, the sum of twenty-five dollars, and each of said persons so appointed shall be entitled to receive for his services in each case a sum not exceeding ten dollars, to be determined and paid by the Commissioner out of any moneys in his hands, which shall be in full compensation to the persons who may be so appointed, for their examination and certificate as aforesaid.

SEC. 16. * * * That whenever there shall be two interfering patents, or whenever a patent on application shall have been refused on an adverse decision of a board of

examiners, on the ground that the patent applied for would interfere with an unexpired patent previously granted, any person interested in any such patent, either by assignment or otherwise, in the one case, and any such applicant in the other case, may have remedy by bill in equity; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge and declare either the patents void in the whole or in part, or inoperative and invalid in any particular part or portion of the United States, according to the interest which the parties to such suit may possess in the patent or the inventions patented, and may also adjudge that such applicant is entitled, according to the principles and provisions of this act, to have and receive a patent for his invention, as specified in his claim, or for any part thereof, as the fact of priority of right or invention shall in any such case be made to appear. And such adjudication, if it be in favor of the right of such applicant, shall authorize the Commissioner to issue such patent, on his filing a copy of the adjudication, and otherwise complying with the requisitions of this act. *Provided, however,* That no such judgment or adjudication shall affect the rights of any person except the parties to the action and those deriving title from or under them subsequent to the rendition of such judgment.

2. The Act of March 3, 1837 (5-Stat. 191, 193) provided, in part, as follows:

SEC. 8. * * * That, whenever application shall be made to the Commissioner for any addition of a newly-discovered improve-

ment to be made to an existing patent; or whenever a patent shall be returned for correction and re-issue, the specification of claim annexed to every such patent shall be subject to revision and restriction, in the same manner as are original applications for patents; the Commissioner shall not add any such improvement to the patent in the one case, nor grant the re-issue in the other case, until the applicant shall have entered a disclaimer, or altered his specification of claim in accordance with the decision of the Commissioner; and in all such cases, the applicant, if dissatisfied with such decision, shall have the same remedy and be entitled to the benefit of the same privileges and proceedings as are provided by law in the case of original applications for patents.

3. The Act of March 3, 1839 (5 Stat. 353, 354-355) provided, in part, as follows:

SEC. 10. * * * That the provisions of the sixteenth section of the before recited act shall extend to all cases where patents are refused for any reason whatever, either by the Commissioner of Patents or by the chief justice of the District of Columbia, upon appeals from the decision of said Commissioner; as well as where the same shall have been refused on account of, or by reason of, interference with a previously existing patent; and in all cases where there is no opposing party, a copy of the bill shall be served upon the Commissioner of Patents, when the whole of the expenses of the proceeding shall be paid by the applicant, whether the final decision shall be in his favor or otherwise.

SEC. 11. * * * That in all cases where an appeal is now allowed by law from the deci-

sion of the Commissioner of Patents to a board of examiners provided for in the seventh section of the act to which this is additional, the party, instead thereof, shall have a right to appeal to the chief justice of the district court of the United States for the District of Columbia, by giving notice thereof to the Commissioner, and filing in the Patent Office, within such time as the Commissioner shall appoint, his reasons of appeal, specifically set forth in writing, and also paying into the Patent Office, to the credit of the patent fund, the sum of twenty-five dollars. And it shall be the duty of said chief justice, on petition, to hear and determine all such appeals, and to revise such decisions in a summary way, on the evidence produced before the Commissioner, at such early and convenient time as he may appoint, first notifying the Commissioner of the time and place of hearing, whose duty it shall be to give notice thereof to all parties who appear to be interested therein, in such manner as said judge shall prescribe. The Commissioner shall also lay before the said judge all the original papers and evidence in the case, together with the grounds of his decision, fully set forth in writing, touching all the points involved by the reasons of appeal, to which the revision shall be confined. And at the request of any party interested, or at the desire of the judge, the Commissioner and the examiners in the Patent Office, may be examined under oath, in explanation of the principles of the machine or other thing for which a patent, in such case, is prayed for. And it shall be the duty of said judge, after a hearing of any such case, to return all the papers to the Commissioner, with a certificate of

his proceedings and decision, which shall be entered of record in the Patent Office; and such decision, so certified, shall govern the further proceedings of the Commissioner in such case: *Provided, however,* That no opinion or decision of the judge in any such case, shall preclude any person interested in favor or against the validity of any patent which has been or may hereafter, be granted, from the right to contest the same in any judicial court, in any action in which its validity may come in question.

4. The Act of August 30, 1852 (10 Stat. 75) provided, in part, as follows:

That appeals provided for in the eleventh section of the act entitled An Act in addition to an act to promote the progress of the useful arts, approved March the third, eighteen hundred and thirty-nine, may also be made to either of the assistant judges of the Circuit Court of the District of Columbia, and all the powers, duties, and responsibilities imposed by the aforesaid act, and conferred upon the chief judge, are hereby imposed and conferred upon each of the said assistant judges.

5. The Act of July 8, 1870 (16 Stat. 198, 204-206) provided, in part, as follows:

SEC. 46. * * * That every applicant for a patent or the reissue of a patent, any of the claims of which have been twice rejected, and every party to an interference, may appeal from the decision of the primary examiner, or of the examiner in charge of interference[s], in such case to the board of examiners-in-chief, having once paid the fee for such appeal provided by law.

SEC. 47. * * * That if such party is dissatisfied with the decision of the examiners-in-chief, he may, on payment of the duty required by law, appeal to the commissioner in person.

SEC. 48. * * * That if such party, except a party to an interference, is dissatisfied with the decision of the commissioner, he may appeal to the supreme court of the District of Columbia, sitting in banc.

SEC. 49. * * * That when an appeal is taken to the supreme court of the District of Columbia, the appellant shall give notice thereof to the commissioner, and file in the patent office, within such time as the commissioner shall appoint, his reasons of appeal, specifically set forth in writing.

SEC. 50. * * * That it shall be the duty of said court, on petition, to hear and determine such appeal, and to revise the decision appealed from in a summary way, on the evidence produced before the commissioner, at such early and convenient time as the court may appoint, notifying the commissioner of the time and place of hearing; and the revision shall be confined to the points set forth in the reasons of appeal. And after hearing the case, the court shall return to the commissioner a certificate of its proceedings and decision, which shall be entered of record in the patent office, and govern the further proceedings in the case. But no opinion or decision of the court in any such case shall preclude any person interested from the right to contest the validity of such patent in any court wherein the same may be called in question.

SEC. 52. * * * That whenever a patent on application is refused, for any reason

whatever, either by the commissioner or by the supreme court of the District of Columbia upon appeal from the commissioner, the applicant may have remedy by bill in equity; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim, or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent, on the applicant filing in the patent office a copy of the adjudication, and otherwise complying with the requisitions of law. And in all cases where there is no opposing party a copy of the bill shall be served on the commissioner, and all the expenses of the proceeding shall be paid by the applicant, whether the final decision is in his favor or not.

6. The Revised Statutes of 1873 (at p. 958) provided, in part, as follows:

SEC. 4911. If such party, except a party to an interference, is dissatisfied with the decision of the Commissioner, he may appeal to the supreme court of the District of Columbia, sitting in banc.

SEC. 4915. Whenever a patent on application is refused, either by the Commissioner of Patents or by the supreme court of the District of Columbia upon appeal from the Commissioner, the applicant may have remedy by bill in equity; and the court having cognizance thereof, on notice to adverse parties and other due proceedings

had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim, or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the Commissioner to issue such patent on the applicant filing in the Patent-Office a copy of the adjudication, and otherwise complying with the requirements of law. In all cases, where there is no opposing party, a copy of the bill shall be served on the Commissioner; and all the expenses of the proceeding shall be paid by the applicant, whether the final decision is in his favor or not.

7. The Act of February 9, 1893 (27 Stat. 434, 436) provided, in part, as follows:

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That there shall be, and there is hereby, established in the District of Columbia a court, to be known as the court of appeals of the District of Columbia, which shall consist of one chief justice and two associate justices, who shall be appointed by the President, by and with the advice and consent of the Senate, and shall hold office during good behavior.

SEC. 9. That the determination of appeals from the decision of the Commissioner of Patents, now vested in the general term of the supreme court of the District of Columbia, in pursuance of the provisions of section seven hundred and eighty of the Revised Statutes of the United States, relating to the District of Columbia, shall

hereafter be and the same is hereby vested in the court of appeals created by this act; and in addition, any party aggrieved by a decision of the Commissioner of Patents in any interference case may appeal therefrom to said court of appeals.

8. The Act of March 2, 1927 (44 Stat. 1335, 1336-1337) provided, in part, as follows:

SEC. 7. That section 9 of the Act of February 9, 1893, entitled "An Act to establish a court of appeals for the District of Columbia, and for other purposes" (Twenty-seventh Statutes at Large, page 434), be, and the same is hereby, repealed.

SEC. 8. That section 4911 of the Revised Statutes of the United States be amended to read as follows:

"SEC. 4911. If any applicant is dissatisfied with the decision of the board of appeals, he may appeal to the Court of Appeals of the District of Columbia, in which case he waives his right to proceed under section 4915 of the Revised Statutes. If any party to an interference is dissatisfied with the decision of the board of appeals, he may appeal to the Court of Appeals of the District of Columbia, provided that such appeal shall be dismissed if any adverse party to such interference shall, within twenty days after the appellant shall have filed notice of appeal according to section 4912 of the Revised Statutes, file notice with the Commissioner of Patents that he elects to have all further proceedings conducted as provided in section 4915 of the Revised Statutes. Thereupon the appellant shall have thirty days thereafter within which to file a bill in equity under said section 4915, in default

of which the decisions appealed from shall govern the further proceedings in the case. If the appellant shall file such bill within said thirty days and shall file due proof thereof with the Commissioner of Patents, the issue of a patent to the party awarded priority by said board of appeals shall be withheld pending the final determination of said proceeding under said section 4915."

SEC. 9. That section 4912 of the Revised Statutes of the United States be amended by striking out the words "Supreme Court of the District of Columbia" and substituting therefor the words "Court of Appeals of the District of Columbia."

* * * * *

SEC. 11. That section 4915 of the Revised Statutes of the United States be amended to read as follows:

"SEC. 4915. Whenever a patent on application is refused by the Commissioner of Patents, the applicant, unless appeal has been taken from the decision of the board of appeals to the Court of Appeals of the District of Columbia, and such appeal is pending or has been decided, in which case no action may be brought under this section, may have remedy by bill in equity, if filed within six months after such refusal; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim, or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner

to issue such patent on the applicant filing in the Patent Office a copy of the adjudication and otherwise complying with the requirements of law. In all cases where there is no opposing party a copy of the bill shall be served on the commissioner; and all the expenses of the proceedings shall be paid by the applicant, whether the final decision is in his favor or not. In all suits brought hereunder where there are adverse parties the record in the Patent Office shall be admitted in whole or in part, on motion of either party, subject to such terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court may impose, without prejudice, however, to the right of the parties to take further testimony. The testimony and exhibits, or parts thereof, of the record in the Patent Office when admitted shall have the same force and effect as if originally taken and produced in the suit."

9. The Act of March 2, 1929 (45 Stat. 1475, 1476) provides, in part, as follows:

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That the title of the United States Court of Customs Appeals, created by the Act approved August 5, 1909, is hereby changed to the United States Court of Customs and Patent Appeals.

SEC. 2 (a) The jurisdiction now vested in the Court of Appeals of the District of Columbia in respect of appeals from the Patent Office in patent and trade-mark cases is vested in the United States Court of Customs and Patent Appeals.

(b) Sections 4911 (Forty-fourth Statutes, page 1336), 4912 (section 60, title 35, United States Code), and 4915 (section 63, title 35, United States Code) of the Revised Statutes, as amended, and section 9 of the Act entitled "An Act to authorize the registration of trade-marks used in commerce with foreign nations or among the several States or with Indian tribes, and to protect the same," approved February 20, 1905 (United States Code, title 15, section 89), are amended by striking out the words "Court of Appeals of the District of Columbia" wherever they occur therein and inserting in lieu thereof the words "United States Court of Customs and Patent Appeals" in each instance.

* * * * *

(d) Nothing contained in this Act shall be construed as affecting in any way the jurisdiction of the Court of Appeals of the District of Columbia in equity cases.

10. The Act of August 5, 1939 (53 Stat. 1212-1213) provides, in part, as follows:

Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That section 4904 of the Revised Statutes (U. S. C., title 35, sec. 52) be amended to read as follows:

"Whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be, and shall direct a board of three examiners of interferences to proceed to determine the question of priority of invention. And the Commissioner may issue

a patent to the party who is adjudged the prior inventor."

SEC. 2. That section 4909 of the Revised Statutes (U. S. C., title 35, sec. 57) be amended to read as follows:

"Every applicant for a patent or for the reissue of a patent; any of the claims of which have been twice rejected, may appeal from the decision of the primary examiner to the Board of Appeals, having once paid the fee for such appeal."

SEC. 3. That section 4911 of the Revised Statutes (U. S. C., title 35, sec. 59a) be amended by changing the words "Board of Appeals" in the second sentence to read "board of interference examiners", and by canceling the last sentence of said section.

SEC. 4. That section 4915 of the Revised Statutes (U. S. C., title 35, sec. 63) be amended, by changing the first sentence thereof to read:

"Whenever a patent on application is refused by the Board of Appeals or whenever any applicant is dissatisfied with the decision of the board of interference examiners, the applicant, unless appeal has been taken to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided, in which case no action may be brought under this section, may have remedy by bill in equity, if filed within six months after such refusal or decision; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim or for any part thereof, as the facts in the case may appear."

11. Sections 4904, 4909, 4911, 4912, 4914-4916 R. S., as amended (35 U. S. C. 52 *et seq.*), provide as follows:

SEC. 4904. Whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be, and shall direct a board of three examiners of interferences to proceed to determine the question of priority of invention. And the Commissioner may issue a patent to the party who is adjudged the prior inventor.

SEC. 4909. Every applicant for a patent or for the reissue of a patent, any of the claims of which have been twice rejected, may appeal from the decision of the primary examiner to the Board of Appeals, having once paid the fee for such appeal.

SEC. 4911. If any applicant is dissatisfied with the decision of the board of appeals, he may appeal to the United States Court of Customs and Patent Appeals, in which case he waives his right to proceed under section 4915 of the Revised Statutes. [U. S. C., title 35, sec. 63.] If any party to an interference is dissatisfied with the decision of the board of interference examiners, he may appeal to the United States Court of Customs and Patent Appeals, provided that such appeal shall be dismissed if any adverse party to such interference shall within twenty days after the appellant shall have filed notice of appeal according to section 4912 of the Revised Statutes [U. S. C., title 35, sec. 60].

file notice with the Commissioner of Patents that he elects to have all further proceedings conducted as provided in section 4915 of the Revised Statutes. Thereupon the appellant shall have thirty days thereafter within which to file a bill in equity under said section 4915, in default of which the decisions appealed from shall govern the further proceedings in the case.

SEC. 4912. When an appeal is taken to the United States Court of Customs and Patent Appeals, the applicant shall give notice thereof to the commissioner, and file in the Patent Office, within such time as the commissioner shall appoint, his reasons of appeal, specifically set forth in writing.

SEC. 4914. The court, on petition, shall hear and determine such appeal, and revise the decision appealed from in a summary way, on the evidence produced before the commissioner, at such early and convenient time as the court may appoint; and the revision shall be confined to the points set forth in the reasons of appeal. After hearing the case the court shall return to the commissioner a certificate of its proceedings and decision, which shall be entered of record in the Patent Office, and shall govern the further proceedings in the case. But no opinion or decision of the court in any such case shall preclude any person interested from the right to contest the validity of such patent in any court wherein the same may be called in question.

SEC. 4915. Whenever a patent on application is refused by the Board of Appeals or whenever any applicant is dissatisfied with the decision of the board of interference examiners, the applicant, unless appeal has been taken to the United States Court of

Customs and Patent Appeals, and such appeal is pending or has been decided, in which case no action may be brought under this section, may have remedy by bill in equity, if filed within six months after such refusal or decision; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication and otherwise complying with the requirements of law. In all cases where there is no opposing party a copy of the bill shall be served on the commissioner; and all the expenses of the proceedings shall be paid by the applicant, whether the final decision is in his favor or not. In all suits brought hereunder where there are adverse parties, the record in the Patent Office shall be admitted in whole or in part, on motion of either party, subject to such terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court may impose, without prejudice, however, to the right of the parties to take further testimony. The testimony and exhibits, or parts thereof, of the record in the Patent Office when admitted shall have the same force and effect as if originally taken and produced in the suit.

SEC. 4916. Whenever any patent is wholly or partly inoperative or invalid, by reason

of a defective or insufficient specification, or by reason of the patentee claiming as his own invention or discovery more than he had a right to claim as new, if the error has arisen by inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, the commissioner shall, on the surrender of such patent and the payment of the duty required by law, cause a patent for the same invention, and in accordance with the corrected specification, to be reissued to the patentee or to his assigns or legal representatives, for the unexpired part of the term of the original patent. Such surrender shall take effect upon the issue of the reissued patent, but in so far as the claims of the original and reissued patents are identical, such surrender shall not affect any action then pending nor abate any cause of action then existing, and the reissued patent to the extent that its claims are identical with the original patent shall constitute a continuation thereof and have effect continuously from the date of the original patent. The commissioner may, in his discretion, cause several patents to be issued for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for a reissue for each of such reissued letters patent. The specifications and claims in every such case shall be subject to revision and restriction in the same manner as original applications are. Every patent so reissued, together with the corrected specifications, shall have the same effect and operation in law, on the trial of all actions for causes thereafter arising, as if the same had been originally filed in such corrected form; but no new

matter shall be introduced into the specification, nor in the case of a machine patent shall the model or drawings be amended, except each by the other; but when there is neither model nor drawing, amendments may be made upon proof satisfactory to the commissioner that such new matter or amendment was a part of the original invention, and was omitted from the specification by inadvertence, accident, or mistake, as aforesaid.

II. REGULATIONS

The Rules of Practice in the United States Patent Office (Reprint September 1, 1943) provide, in part, as follows:

Rule 76. When an application is rejected on reference to an expired or unexpired domestic patent which shows or describes but does not claim the invention, or on reference to a foreign patent, or to a printed publication, or to facts within the personal knowledge of an employee of the office, set forth in an affidavit (when requested) of such employee (rule 66), or when rejected on the ground of public use or sale, or upon a mode or capability of operation attributed to a reference, or because the alleged invention is held to be inoperative or frivolous or injurious to public health or morals, affidavits or depositions supporting or traversing these references or objections may be received, but affidavits will not be received in other cases without special permission of the Commissioner. (See rule 138.)

Rule 93. An interference is a proceeding instituted for the purpose of determining

the question of priority of invention between two or more parties claiming substantially the same patentable invention and may be instituted as soon as it is determined that common patentable subject matter is claimed in a plurality of applications or in an application and a patent. In order to ascertain whether any question of priority arises the Commissioner may call upon any junior applicant to state in writing under oath the date and the character of the earliest fact or act, susceptible of proof, which will be relied upon to establish conception of the invention under consideration. The sworn statement filed in compliance with this rule will be retained by the Patent Office separate from the application file and if an interference is declared will be opened simultaneously with the preliminary statement of the party filing the same. In case the junior applicant makes no reply within the time specified, not less than twenty days, the Commissioner will proceed upon the assumption that the said date is the date of the oath attached to the application. The fact that one of the parties has already obtained a patent will not prevent an interference, for, although the Commissioner has no power to cancel a patent, he may grant another patent for the same invention to a person who proves to be the prior inventor.

Rule 94. Interferences will be declared between applications by different parties for patent or for reissue when such applications contain claims for substantially the same invention which are allowable in the application of each party, and interferences will also be declared between applications for patent, or for reissue, and

unexpired original or reissued patents, of different parties, when such applications and patents contain claims for substantially the same invention which are allowable in all of the applications involved: *Provided*, That where the filing date of any applicant is subsequent to the filing date of any patentee, the applicant shall file an affidavit that he made the invention in controversy, in this country, before the filing date of the patentee; and, when required, the applicant shall file an affidavit setting forth facts showing that he completed the invention in controversy, in this country, before the filing date of the patentee.

Where claims are copied from a patent and the examiner is of the opinion that the applicant can make only some of the claims so copied, he shall notify the applicant to that effect, state why he is of the opinion he cannot make the other claims and state further that the interference will be promptly declared and that the applicant may proceed under rule 109, if he further desires to contest his right to make the claims not included in the declaration of the interference.

Where an applicant presents a claim copied or substantially copied from a patent, he must, at the time he presents the claim, identify the patent, give the number of the patented claim, and specifically apply the terms of the copied claim to his own disclosure.

No amendment for the first time presenting or asserting a claim which is the same as, or for substantially the same subject matter as, a claim of an issued patent may be made in any application un-

less such amendment is filed within one year from the date on which said patent was granted.

Parties owning applications or patents which contain conflicting claims will be required to show cause why these claims shall not be eliminated from all but one of the applications or patents of common ownership.

Rule 109. An applicant involved in an interference may, within a time fixed by the examiner of interferences not less than thirty days after the preliminary statements (referred to in rule 110) of the parties have been received and approved, or if a motion to dissolve the interference has been brought by another party, within thirty days from the filing thereof, on motion duly made as provided by rule 153, file an amendment to his application containing any claims which in his opinion should be made the basis of interference between himself and any of the other parties.

Such motion must be accompanied by the proposed amendment, and when in proper form will be set by the examiner of interferences for hearing before the primary examiner. Where a party opposes the admission of such an amendment in view of prior patents or publications, full notice of such patents or publications, applying them to the proposed counts, must be given to all parties at least twenty days prior to the date of hearing. On the admission of such amendment and the adoption of the claims by the other parties within a time specified the primary examiner shall redeclare the interference or shall declare such other interferences as may be necessary to include the said claims. New pre-

liminary statements will be received as to the added claims, but motions for dissolution with regard thereto will not be considered where the questions raised could have been disposed of in connection with the admission of the claims. Amendments to the specification will not be received during the pendency of the interference without the consent of the Commissioner, except as provided herein and in rule 106.

Any party to an interference may bring a motion to put in interference any claims already in his application or patent which should be made the basis of interference between himself and any of the other parties. Any party to an interference may bring a motion to add or substitute any other application owned by him, as to the existing issue, or to include an application or a patent owned by him, as to claims which should be made the basis of interference between himself and any of the other parties. Such motions are subject to the same conditions and the procedure in connection therewith is the same, so far as applicable, as hereinabove set forth for motions to amend.

Rule 149. When an appeal is taken to the United States Court of Customs and Patent Appeals, the appellant shall give notice thereof to the Commissioner, and file in the Patent Office, within 40 days, exclusive of Sundays and legal holidays in the District of Columbia but including Saturday half holidays, from the date of the decision appealed from, his reasons of appeal specifically set forth in writing; *Provided, however,* That if a petition for rehearing or reconsideration is filed within 20 calendar days after said decision, the notice

of appeal may be given and the reasons of appeal filed within 15 calendar days after action on the petition. No petition for rehearing on reconsideration filed more than 20 calendar days after such decision, nor any proceedings on such petition, shall operate to extend the period of 40 days hereinabove provided for appeal.

If an applicant in an *ex parte* case appeals to the U. S. Court of Customs and Patent Appeals he waives his right to proceed under section 4915 R. S. (U. S. C., title 35, sec. 62).

If a defeated party to an interference proceeding appeals to the U. S. Court of Customs and Patent Appeals, and any adverse party to the interference shall, within twenty days after the appellant shall have filed notice of the appeal to the court, file notice with the Commissioner that he elects to have all further proceedings conducted as provided in section 4915 R. S., certified copies of the foregoing papers will be transmitted to the U. S. Court of Customs and Patent Appeals for such action as may be necessary. The notice of election must be served as provided in rule 154 (b). [See rule 153 (a).]

From adverse decisions by the board of appeals in *ex parte* cases and from decisions of the board of interference examiners, the appellant, if an applicant, has the option of proceeding under section 4915 R. S. instead of appealing directly to the U. S. Court of Customs and Patent Appeals.

Rule 164. If, on examination, it shall appear that the applicant is justly entitled to a patent under the law, a notice of allowance will be sent him, his attorney or his agent, calling for the payment of the final

fee within six months from the date of such notice of allowance, upon the receipt of which within the time fixed by law the patent will be prepared for issue. (See rules 167, 194.)

Rule 167. Every patent shall issue within a period of three months from the date of the payment of the final fee, which fee shall be paid not later than six months from the time at which the application was passed and allowed and notice thereof was sent to the applicant, his attorney or his agent; and if the final fee be not paid within that period the patent shall be withheld. (See rule 175.) In the absence of request to suspend issue the patent will issue in regular course. The issue closes weekly on Thursday, and the patents bear date as of the fourth Tuesday thereafter.

A patent will not be antedated.

APPENDIX B

Comparison of number of *ex parte* suits under
Rev. Stats. 4911 and 4915 in the last decade.

Year (July 1-June 30):	Court of Customs and Patent Appeals, Cases	District Court Cases
1934-1935	144	24
1935-1936	82	44
1936-1937	87	37
1937-1938	73	72
1938-1939	74	43
1939-1940	78	50
1940-1941	87	53
1941-1942	61	43
1942-1943	71	71
1943-1944	70	57

APPENDIX C

DEPARTMENT OF COMMERCE

UNITED STATES PATENT OFFICE

WASHINGTON, *February 16, 1945.*

Hon. CHARLES FAHY,
Solicitor General,
Department of Justice,
Washington, D. C.

MY DEAR MR. SOLICITOR GENERAL.—This is in reply to your recent inquiry concerning the practice of this Office with respect to its further action on a patent application following an adjudication favorable to the applicant in a proceeding under Rev. Stat. 4915.

As you no doubt know, when claims are finally rejected by the examiner and his action is affirmed by the Board of Appeals, the grounds then stated for such rejection, as well as any other grounds in support thereof, may be set up by this Office in answer to a subsequent suit by the applicant under Rev. Stat. 4915. If the adjudication by the court is favorable to the applicant, it is the practice of this Office to treat that judgment as conclusive with respect to any ground of rejection urged before the court in defense of the refusal to allow the claims in issue. In the usual case, following such adjudication, the application is allowed and, upon payment of the prescribed

fee, the patent is issued. However in rare instances where, after termination of the suit, a new reference is discovered which shows lack of patentability of the claims for a reason not considered by the court, this Office considers itself under a duty to reject the claims on the newly discovered ground, and to refuse a patent on those claims unless the applicant can overcome the new ground of rejection. Similarly, if another applicant or a patentee is claiming substantially the same subject matter as that held patentable in the Rev. Stat. 4915 suit and a question of priority arises, interference proceedings may be necessary under Rev. Stat. 4904 to determine which of the adverse claimants is the first inventor. Examples of this practice are reflected in *Radtke Patents Corp. v. Coe*, 122 F. (2d) 937 (App. D. C.), certiorari denied, 314 U. S. 695, and *Poulsen v. McDowell*, 142 F. (2d) 267 (C. C. P. A.).

The foregoing is believed to have been the consistent practice of this Office for many years.

Sincerely yours,

CONWAY P. COE,
Commissioner.

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OCT 19 1944

CHARLES ELMORE DODLEY
CLERK

IN THE
Supreme Court of the United States

OCTOBER TERM, 1944.

No. **486**

THE HOOVER COMPANY,

Petitioner.

vs.

CONWAY P. COE, COMMISSIONER OF PATENTS,

Respondent.

**BRIEF OF J. BERNHARD THIESS UPON BEHALF OF
PAUL A. STURTEVANT, AS AMICUS CURIAE.**

J. BERNHARD THIESS,
*Counsel for Paul A. Sturtevant as
Amicus Curiae.*

BERTRAM WM. COLTMAN,

SIDNEY NEUMAN,

Of Counsel.

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**BRIEF OF J. BERNARD THIESS UPON BEHALF OF
PAUL A. STURTEVANT, AS AMICUS CURIAE.**

PRELIMINARY STATEMENT.

Paul A. Sturtevant, for whom *amicus curiae* is counsel, is the plaintiff in an action now pending in the District Court of the United States for the District of Columbia entitled "*Paul A. Sturtevant, plaintiff, v. Conway P. Coe, Commissioner of Patents, defendant*, Civil Action No. 22,403." In that action, commenced on December 13, 1943, the plaintiff seeks a decree of the District Court authorizing and directing the defendant to issue to plaintiff a reissue patent embodying certain claims which were refused to plaintiff by the Board of Appeals of the Patent Office on the ground that they were not readable upon the

disclosure of the plaintiff's application. Issue was duly joined and the case was awaiting trial when the decision in the instant case was rendered.

On September 27, 1944, the respondent here—the defendant in the aforesaid action—moved to dismiss the complaint on the ground that “the Court lacks jurisdiction to grant the relief sought,” the sole basis of the motion being the decision in the instant case. The said motion is pending and undetermined, and obviously the decision of this Court in the case at bar affects the case in which *amicus curiae* is interested. He therefore desires to present an argument as an aid to this Court in its consideration of the instant petition and to urge respectfully that this Court should exercise its supervisory authority by granting its writ of certiorari to review the judgment of the Court below.

THE IMPORTANCE OF THE QUESTIONS PRESENTED.

Ever since *Gandy v. Marble*, 122 U. S. 432, it has been accepted practice that a decree entered by a court of equity in an action under § 4915, Revised Statutes,¹ was not so far conclusive upon the Commissioner of Patents that upon filing of a copy of the decree with him he had no alternative but to comply therewith immediately and issue the patent as directed.

The statute merely provides that a successful plaintiff is only entitled to a patent upon "filing in the Patent Office a copy of the adjudication and **otherwise complying with the requirements of law,**" and construing this language in *Gandy v. Marble*, this Court said (p. 440):

" . . . All that the court which takes cognizance of the bill in equity, under § 4915, is authorized to do is to adjudge whether or not 'the applicant is entitled, according to law, to receive a patent,' and, **after an adjudication in his favor to that effect, the Commissioner is not authorized to issue a patent unless the applicant otherwise complies with the requirements of law.**"

In view of the foregoing decision, as well as the clear language of the statute, the right of the Commissioner of Patents to refuse to execute the decree entered in a § 4915 action if the successful plaintiff fails to pay the fees required by law or to meet other conditions required of him by the patent statutes and the rules of the Patent Office cannot be challenged. Similarly the decree for all practical purposes is rendered a nullity where after its filing the Commissioner of Patents, while preparing to issue a patent, discovers the pending application of another claiming the same subject matter and is consequently required

1. Appendix, *post*, pp. 27-28.

4

by law to declare an interference. It clearly appears from the memorandum which was presented by respondent to the Court below,² that the administrative practice of the Patent Office consistently pursued throughout the years was admittedly contrary to the practice now dictated by the instant decision. By way of aiding the Court below in its construction of the statutes involved, respondent informed the Court of the existence of an administrative interpretation of long standing that, upon the filing of an adjudication favorable to an applicant, the Patent Office claimed the right to exercise, and did actually exercise, its prerogative "to proceed in accordance with other sections of the patent statutes." It was pointed out to the Court that while the language of § 4915 might appear to make the adjudication mandatory and immediately effective, it was thought "that it is proper to consider it as a part of the entire patent law, and hence, coordinate with section 4904 R.S., which provides for the declaration of an interference where an application for patent is found to be in conflict with another application or an unexpired patent. It is not until it is found that a claim in an application is patentable to the applicant that such a conflict exists. Therefore, when it is determined by the adjudication of the court that the conflict exists, section 4904 R.S. comes into play and the interference must be declared, notwithstanding the form of the judgment."³

2. For the benefit of the Court this memorandum is printed *in toto* in the Appendix, *post*, pp. 29-33.

3. Respondent called attention to the fact that, under prevailing administrative practice, interferences have been declared by the Patent Office upon the filing of an adjudication that an applicant was entitled to receive a patent. Thus the Court was informed that, after the decree entered in *Tully v. Robertson*, 19 F. (2d) 954, where the right of an applicant to copy claims from an unexpired patent and thus provoke an interference had been upheld, the interference was declared, notwithstanding the adjudication in favor of the plaintiff. Attention was specifically

In the face of this administrative interpretation by the Commissioner of Patents, and despite these unambiguous representations by him that no practical obstacles have been or are presented by a decree adjudging that an applicant is entitled to receive a patent, the Court below nevertheless refused to assume jurisdiction of an action under § 4915 because it considered that its decree could not be immediately carried out, but instead would result in an interference. The Court below, holding that it was powerless to determine petitioner's "right to a patent" because it involved deciding that he is prior to another applicant,—not before the Court—concluded that the "whole controversy" had not been presented and that consequently there was no jurisdiction.

Thus not only is the question decided by the Court below of general importance, but it is one of substance relating to the construction of statutes of the United States which has not been, but should be, settled by this Court. We respectfully submit, moreover, that the Court below has not given proper effect to applicable decisions of this Court and that the instant decision, if erroneous, will produce unfortunate consequences in practice.

In *Butterworth v. Hill*, 114 U. S. 128, it was held by this Court that an action under § 4915 may not be maintained against the Commissioner of Patents without his consent, where he is the sole defendant, save in the district of his official residence, and consequently it is within the power of respondent to require that all actions by applicants to

called to *International Cellucotton Products Co. v. Coe*, 85 F. (2d) 869, and *American Cyanamid Co. v. Coe*, 106 F. (2d) 851. In those cases, after the dissolution of interferences set up by the Patent Office, the applicants on the *ex parte* prosecution of the application were refused certain claims on the ground of estoppel. Actions under § 4915 were successfully prosecuted and upon the filing of the favorable adjudications the interferences were re-declared and prosecuted to decision.

whom patents are refused in *ex parte* cases be brought in the District Court for the District of Columbia. Hence the nature of the questions presented and the improbability that other inferior courts will ever have an opportunity to pass upon these identical questions should move this Court to grant the instant petition (cf. *Paramount Publix Corp. v. American Tri-Ergon Corp.*, 294 U. S. 464; *Schriber-Schroth Co. v. Cleveland Trust Co.*, 305 U. S. 47; *Exhibit Supply Co. v. Ace Patents Corp.*, 315 U. S. 126).

SUMMARY OF ARGUMENT.

I.

The decision below is contrary to the clear and unambiguous language of the statute and is in conflict with a liberal legislative policy calculated to afford applicants for patents ample remedy by a suit in equity in every case where a patent has been refused. A review of the legislation dealing with the subject of a remedy by bill in equity reveals a Congressional purpose, more than a century old, favoring the right of a defeated applicant for a patent to secure a review in a court of equity of the action of the Patent Office in refusing a patent for any reason whatever.

Orderly procedure dictates, contrary to the views of the Court below, that where an applicant for a patent desires to provoke an interference with a previously granted unexpired patent the right to contest priority with the patentee of the existing patent should be first established. Hence, a decision of the Patent Office denying to an applicant the right to conduct an interference with an existing patent is in the very nature of things the type of final refusal of a patent which courts may review in an action under § 4915. The power of Congress to provide for judicial interference with the action of the Patent Office, either upon refusal of a patent or at any stage of an interference proceeding which results in the refusal of a patent, cannot be successfully challenged. (*United States v. Duell*, 172 U. S. 576.)

II.

The decision below misapplies the decisions of this Court in *Hill v. Wooster*, 132 U. S. 693 and *Butterworth v. Hoe*, 112 U. S. 50, and is contrary to the rule of construction

adopted by this Court in *Baldwin Co. v. Robertson*, 265 U. S. 168. Neither of the cases relied upon by the Court below directly or indirectly involved the jurisdictional questions here presented. From the *Baldwin* case it clearly appears that the purpose of § 4915 is to afford to a defeated applicant for a patent a remedy in equity against the Commissioner in every case to the end that the final action of the Commissioner may always be subjected to independent judicial review. The assumption by the Court below that the nature of the relief which may be granted in a § 4915 action is circumscribed by the language of the statute and by principles of equity jurisdiction does not square with the rule of construction adopted in the *Baldwin* case and, moreover, ignores the fundamental power of Congress to provide for remedies, by way of appeal or otherwise, in respect of interlocutory as well as final decisions.

III.

The decision below adopts a rule of construction which nullifies the Congressional purpose to provide alternative remedies to defeated applicants for patents and which is contrary to an interpretation of the same statutes made by the courts of the Second and Third Circuits. §§ 4911 and 4915 have been amended to provide that if an applicant who has been refused a patent appeals to the Court of Customs and Patent Appeals he waives his right to proceed under § 4915. It is not disputed that a direct appeal lies in a case where an applicant has been refused a patent on the ground that he had no right to make the claims requested; *a fortiori* he has the right to secure a review of the Patent Office refusal in a § 4915 action. Any other construction deprives an applicant for patent of rights clearly expressed in the statutes.

ARGUMENT.

I.

THE DECISION BELOW IS CONTRARY TO THE CLEAR AND UN-
AMBIGUOUS LANGUAGE OF THE STATUTE AND IS IN CONFLICT
WITH A LIBERAL LEGISLATIVE POLICY CALCULATED TO AFFORD
APPLICANTS FOR PATENTS AMPLE REMEDY BY A SUIT IN
EQUITY IN EVERY CASE WHERE A PATENT IS REFUSED.

The enactment now found in the Statutes of the United States on the subject of the availability to a defeated applicant for a patent of a remedy by suit in equity is the result of a long course of legislation. A review of this background plainly reveals a liberal legislative policy inconsistent with the narrow and restricted view which was taken by the Court below. However plausible Judge Arnold's arguments may be, the construction imposed by him upon the statute involved does not square with the words actually used in the statute and is in obvious conflict with its general Congressional purpose.

The first legislation dealing with a suit in equity by an applicant who had been refused a patent is found in the Patent Act of 1836. (Act of July 4, 1836, ch. 357, 5 Stat. 117).⁴ By § 7 of that Act the Commissioner of Patents was authorized, on the filing of an application for patent, to make an examination of the alleged new invention or discovery and it was declared to be his duty to issue a patent if he "shall deem it to be sufficiently useful and important"; in case of the Commissioner's refusal to issue a patent, the applicant was secured an appeal from this decision to a board of examiners. The decision of this board being certified to the Commissioner, it was declared that

4. Appendix, *post*, pp. 23-25.

"he shall be governed thereby in the further proceedings to be had on such application." By § 8 it was provided that if in the opinion of the Commissioner an application "would interfere with any other patent for which an application may be pending, or with any unexpired patent which shall have been granted" he was authorized, after notice to the parties, to decide the "question of priority of right or invention." An appeal to the board of examiners as in the case of other refusals was provided in these cases of interference. § 16 of the Act⁵ provided, in part:

"That . . . whenever a patent on application shall have been refused on an adverse decision of a board of examiners, on the ground that the patent applied for would interfere with an unexpired patent previously granted, . . . any such applicant . . . may have remedy by bill in equity, and the court having cognizance thereof . . . may also adjudge that such applicant is entitled, according to the principles and provisions of this act, to have and receive a patent for his invention as specified in his claim, or for any part thereof, as the fact of priority of right or invention shall in any such case be made to appear. . . ."

It will thus be observed that as enacted this section limited the "remedy by bill in equity" to cases of interference. The right of an applicant to appeal to the courts to review the action of the Patent Office was available only when the application had been refused "on an adverse decision of a board of examiners, on the ground that the patent applied for would interfere with an unexpired patent previously granted." In all other cases the decision of the board of examiners was final. No provision had been made for an independent judicial review in those cases.

5. Appendix, *post*, p. 24. It should be mentioned that this section also related to a suit in equity "whenever there shall be two interfering patents." The proceedings were separated by the Act of 1870 (C. 230, 16 Stat. 198, §§ 52, 58). Actions relating to interfering patents are now covered by § 4918 (35 U. S. C., § 66).

By § 10 of the Patent Act of 1839 (Act of March 3, 1839, ch. 88, 5 Stat. 353), the provisions of § 16 of the Act of 1836 were extended to *all cases* where patents were refused "*for any reason whatever*," either by the Commissioner of Patents or by the Chief Justice of the District of Columbia, upon appeals from the decisions of the Commissioner, "as well as where the same shall have been refused on account of, or by reason of, interference with a previously existing patent."

Thus there was evinced by Congress more than a century ago an intention to make available to persons seeking patents the right to secure, by bill in equity, an independent judicial review in all cases where the Patent Office had refused a patent *for any reason whatever*. It would seem that all argument might therefore well close here, for only compelling language could justify a conclusion that Congress intended to abandon its avowed policy and, as will presently appear, no subsequent enactment of Congress has taken away any of the comprehensive power clearly conferred upon the courts at that early date.

By the Consolidated Patent Act of 1870 (Act of July 8, 1870, ch. 230, 16 Stat. 198) the provisions of § 16 of the Act of 1836 and of § 10 of the Act of 1839 were combined into § 52 of that Act, as follows:

"Section 52. *And be it further enacted*, That whenever a patent on application is refused, *for any reason whatever*, either by the commissioner or by the Supreme Court of the District of Columbia upon appeal from the commissioner, the applicant may have remedy by bill in equity; and the court having cognizance

6. By § 11 it was provided that in all cases where an appeal was then allowed by law from the decision of the Commissioner of Patents to a board of examiners, an applicant, instead thereof, should have a right of appeal to the Chief Justice of the District Court of the United States for the District of Columbia. See Appendix, *post*, p. 25.

7. Appendix, *post*, p. 25.

thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim, or for any part thereof, *as the facts in the case may appear.*⁸ And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent, on the applicant filing in the Patent Office a copy of the adjudication, and otherwise complying with the requisitions of law."

In view of the language of the prior enactments and especially in view of the provision in § 52 of the Act of 1870 that the remedy by bill in equity was available in the case of a refusal "for any reason whatever," a Congressional purpose in favor of the applicant in all cases, far from being shown to have receded, is clearly carried forward. The right to a "remedy by bill in equity" in all cases was thus emphasized once more.

When the Statutes were revised in 1874, we find that the words "for any reason whatever" appearing in § 52 of the Act of 1870 were omitted from § 4915 (Act of June 22, 1874; § 4915);⁹ but certainly no one will contend that there is any difference between the words "*refused* for any reason whatever", as was provided in the Act of 1870, and the word "*refused*", as specified in § 4915. It must be conclusively presumed that the revisers of the Statutes recognized the equality of the expressions. It cannot be implied that any detracting of the right to a "remedy by bill in equity" was intended or that any decrease in the jurisdiction of the courts to make an independent judicial review flows from the deletion of the words "for any reason whatever."

8. The italicized words constitute a broadening and significant departure from the limited language of the predecessor statute, i. e., "as the fact of priority of right or invention shall in any such case be made to appear." (See *ante*, p. 10.)

9. Appendix, *post*, p. 27.

If, originally, jurisdiction was conferred upon the courts solely for the purpose of reviewing and correcting refusals based on account of interference with a previously existing patent, and if such jurisdiction was subsequently extended to *all cases* where patents had been refused "for any reason whatever," we can see no justification for now holding that the Federal Courts have no jurisdiction because the issue of priority between an applicant and an existing patent is not also presented for determination. Such an issue was the only one which originally could have invoked the remedy by suit in equity, but the jurisdiction of the courts was subsequently expanded to apply to refusals on other grounds, and it does violence to a clearly expressed legislative policy to hold, as did the Court below, that jurisdiction is wanting merely because the priority issue as between the applicant and a known unexpired patent is not presented.

There is no difference in principle between an action under § 4915 followed by a declaration of an interference between the successful plaintiff and an applicant not previously known or contemplated and an action which is avowedly prosecuted in order to lay the foundation for the declaration of an interference with an existing patent with which the defeated applicant desires to contest priority. In the former case, the courts admittedly have jurisdiction. No decision—prior to that of the Court below—has questioned the right of a person seeking a patent to prosecute a bill in equity in the latter case.

Orderly procedure dictates, contrary to the views of the Court below, that where an interference with an unexpired patent is being provoked, the prior patentee should not be required to litigate until the defeated applicant has established his right to the claims and to an interference. Thus in *Robinson on Patents* (Vol. 2, § 722, p. 463), that eminent patent law authority, commenting upon the separation by

the Act of 1870 of proceedings involving interfering patents and those involving an applicant and a patent, said:

"* * * The grant of a patent raises a strong *prima facie* presumption of its validity. The refusal of a patent by the Patent Office is also *prima facie* evidence that the applicant has no right to a monopoly. To permit a defeated applicant to attack an interfering patent in the face of these two presumptions is inconsistent with a due regard to the rights of the existing patentee. Not until he has overcome the presumption arising from his own defeat by obtaining a reversal of the adverse judgment, and by the allowance of a patent in his favor has put himself on equal ground with the earlier patentee, ought he to be permitted to bring his adversary into court in defense of the prior patent, or compel him to incur the risk of its repeal. The present law thus adequately protects the interests of all parties, and far more accurately than the old preserves a proper order and sequence in its remedies."

The decision of the Court below also seemingly questioned both the power and purpose of Congress to provide for a review by bill in equity of an administrative ruling made in the preliminary stage of an interference and thus imputes a Congressional intent not to affect the principles of equity jurisdiction.

A forcible statement of the principle applicable here was made in *United States v. Duell*, 172 U. S. 576, when Mr. Chief Justice Fuller said (p. 583):

"Since, under the Constitution, Congress has power 'to promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries,' and to make all laws which shall be necessary and proper for carrying that expressed power into execution, it follows that Congress may provide such instrumentalities in respect of securing to inventors the exclusive right to their discoveries as in its judgment will be best calculated to effect that object."

In that case it was held that the competency of Congress to provide for "judicial interference" with the action of the Patent Office cannot be successfully questioned as being an encroachment upon the judicial department. Hence, the view of the Court below that assumption of jurisdiction in a case like the present one, is "contrary to the fundamental concept of equity jurisdiction" is in conflict with the holding in *United States v. Duell*, that:

"* * * The nature of the thing to be done being judicial, Congress had power to provide for judicial interference through a special tribunal, *United States v. Coc*, 155 U. S. 76; and *a fortiori* existing courts of competent jurisdiction might be availed of."

II.

THE DECISION BELOW MISAPPLIES THE DECISIONS OF THIS COURT IN *HILL V. WOOSTER*, 132 U. S. 693, AND *BUTTERWORTH V. HOE*, 112 U. S. 50, AND IS CONTRARY TO THE RULE OF CONSTRUCTION ADOPTED BY THIS COURT IN *BALDWIN CO. V. ROBERTSON*, 265 U. S. 168.

The Court below, asserting that there were no "controlling decisions" applicable to the question which the Court had raised *sua sponte*, proceeded to resolve the question in the light of "considerations of sensible and orderly procedure" and justified its action by the ruling of this Court in *Hill v. Wooster*, 132 U. S. 693, and certain language in this Court's decision in *Butterworth v. Hoe*, 112 U. S. 50. The Court below concluded that unless a court to whom a petition is addressed under § 4915 can determine the whole controversy on its merits, jurisdiction cannot be assumed. The principal reason advanced is that where an interference with another person—not before the court—appears as a possibility, the court cannot adjudge, within the language of § 4915, that the plaintiff "is entitled according to

law to receive a patent." The Court thus not only took an unrealistic view of the practice pursued for many years, but also it ignored a long standing administrative interpretation of the statute. (*ante*, pp. 4-5.)

In *Hill v. Wooster*, it was merely held that in an *inter partes* action under § 4915, the court, in spite of the wishes of the parties, has the power to declare the subject matter of the interference unpatentable. In *Butterworth v. Hoe*, this Court merely defined the nature of the action contemplated by § 4915 and, in emphasizing the *de novo* character of such an action, distinguished it from an appeal under § 4911.¹⁰ Neither case even remotely touched upon the jurisdictional question here presented.

Moreover, the suggestion that jurisdiction cannot be assumed because of the preliminary stage at which the Patent Office ruling was made ignores the fundamental power of Congress to provide for appeals from interlocutory orders in any case or controversy and especially the power of Congress to provide for judicial interference with the administration of the business of the Patent Office.

In circumscribing the nature of the relief which a court in a § 4915 action has the power to grant, the Court below has, however, placed itself squarely in conflict with the decision of this Court in *Baldwin Co. v. Robertson*, 265 U. S. 168.

By way of preface to an explanation of that case, it should be mentioned that in *Atkins & Co. v. Moore*, 212 U. S. 285, 291, *American Steel Foundries v. Robertson*, 262 U. S. 209, and *Baldwin Co. v. Howard Co.*, 256 U. S. 35, 39, this Court held that the assimilation of the practice in re-

¹⁰ See also *Morgan v. Daniels*, 153 U. S. 120, for further emphasis of the datum that a proceeding under § 4915 is not a "mere appeal."

spect of the registration of trade marks to that in securing patents as enjoined by § 9 of the Trade Mark Act (33 Stat. 727, c. 592) made § 4915, providing for a bill in equity to compel the Commissioner of Patents to issue a patent, applicable to a petition for the registration of a trade mark when rejected by the Commissioner.

The case presented in *Baldwin Co. v. Robertson* involved, however, not a bill under § 4915 to review and correct the action of the Commissioner in refusing a trade mark registration, but instead, a bill under that section seeking an *injunction*, to prevent the Commissioner from cancelling certain trade marks which had already been registered by the plaintiff. *Thus the case was not one wherein the court was requested to adjudge that the plaintiff was entitled to receive a trade mark registration.*

Against jurisdiction to entertain such a bill it was expressly argued in *that case* that § 4915 did not authorize the action (p. 169) and that to interpret § 4915 as authorizing the action "requires a rewriting of § 4915, and the incorporation into the section of both words and subject matter entirely foreign to its present plain language" (p. 171). Rejecting these contentions, Mr. Chief Justice Taft said (265 U. S. 179):

"The next inquiry is whether, in addition to such appeal and after it proves futile, the applicant is given a remedy by bill in equity as provided for a defeated applicant for a patent in § 4915, Rev. Stats. We have in the cases cited given the closing words of § 9 a liberal construction in the view that Congress intended by them to give every remedy in respect to trade marks that is afforded in proceedings as to patents, and have held that under them a bill of equity is afforded to a defeated applicant for trade mark registration just as to a defeated applicant for a patent. **It is not an undue expansion of that construction to hold that**

the final words were intended to furnish a remedy in equity against the Commissioner in every case in which by § 9 an appeal first lies to the Court of Appeals. This necessarily would give to one defeated by the Commissioner as a party to an application for the cancellation of the registration of a trade mark, after an unsuccessful appeal to the advisory supervision of the Court of Appeals, a right to resort to an independent bill in equity against the Commissioner to prevent cancellation."

Baldwin Co. v. Robertson clearly reveals that the purpose of § 4915 is to afford a defeated applicant for patent an independent judicial review in every case where the Patent Office has made a final adverse decision. It demonstrates, moreover, the error into which the Court below fell when it assumed that the only power under § 4915 which a court has is that of making a decree authorizing and directing the Commissioner to issue a patent. If a court may enter an injunction in the exercise of its jurisdiction under § 4915, then *a fortiori* it may make a decree "directing the Commissioner to find claims readable on plaintiff's disclosure and allowable to him provided that later he is determined to have priority."

III.

THE DECISION BELOW ADOPTS A RULE OF STATUTORY CONSTRUCTION WHICH NULLIFIES THE LEGISLATIVE PURPOSE TO PROVIDE ALTERNATIVE REMEDIES TO DEFEATED APPLICANTS FOR PATENTS AND WHICH IS CONTRARY TO THE INTERPRETATION OF THE SAME STATUTE MADE BY THE COURTS OF THE SECOND AND THIRD CIRCUITS.

By the Act of March 2, 1927 (Chap. 273, §§ 8, 11, 44, Stat. 1336), §§ 4911 and 4915 were amended to provide that if an applicant for patent appealed to the Court of Ap-

peals of the District of Columbia," he waived his right to proceed under § 4915.

Thus § 4911 provides that an applicant may have a direct appeal to the Court of Customs and Patent Appeals but that, in that case, "he waives his right to proceed under Section 63" (§ 4915) and § 4915 provides that if an appeal is taken or is pending or is decided "no action may be brought under this section" (Appendix, *post*, pp. 26-28).

These amendments have been regarded as providing alternative remedies for an applicant who is dissatisfied with the decision of the Board of Appeals or the Board of Interference Examiners. Thus Rule 149 of the Patent Office provides:

"If an applicant in an *ex parte* case appeals to the U. S. Court of Customs and Patent Appeals he waives his right to proceed under section 4915 R. S. (U. S. C. Title 35, sec. 63).

"From adverse decisions by the board of appeals in *ex parte* cases and from decisions of the board of interference examiners, the appellant, if an applicant, has the option of proceeding under section 4915 R. S. instead of appealing directly to the U. S. Court of Customs and Patent Appeals."

The Court below refused to recognize the 1927 amendments or to sanction the Patent Office rule. Indeed, it was held, in effect, that the petitioner's remedy in the instant circumstances resided solely in an appeal to the United States Court of Customs and Patent Appeals. If it be conceded that an appeal in the instant case lay to that court, then by the clear language of §§ 4911 and 4915,

* 11. In 1929, the jurisdiction of this Court to entertain a direct appeal was transferred to the U. S. Court of Customs and Patent Appeals. Hence, the references in these sections to the Court of Appeals of the District of Columbia were changed to read "United States Court of Customs and Patents Appeals" (Act of March 2, 1929, c. 488, § 2, 45 Stat. 1476).

the remedy by bill in equity is also available. Those sections clearly provide alternative remedies for reviewing a refusal to issue a patent and have been so construed in cases arising in other circuits.

Thus in *Bakelite Corp. v. National Aniline & Chemical Co.* (C. C. A. 2), 83 F. (2d) 176, 177, the court said:

"It cannot be doubted that the statute, as it now reads, **means to give alternative remedies to an applicant to whom a patent has been refused.** He may appeal, 'in which case he waives his right to proceed under section 63 of this title' (35 U. S. C. A. § 59a); or (he may have his remedy by bill in equity, 'unless appeal has been taken from the decision of the board of appeals to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided, in which case no action may be brought under this section.' (35 U. S. C. A. § 63.))"

In *General Talking Pictures Corp. v. American Tri-Ergon Corporation, et al.* (C. C. A. 3), 96 F. (2d) 800, 812, the court referring to the 1927 Amendment said (p. 812):

"In our opinion the amendment has two practical results:

"First, it provides that the losing party in an interference is not entitled to his remedy by suit if an appeal to the United States Court of Customs and Patent Appeals is pending or has been decided."

The logic of the contention that if an applicant is refused a patent on the ground that the claims do not read upon his disclosure he has the right to appeal to the Court of Customs and Patent Appeals, then he also has the right to secure a review of the same type of refusal by way of a suit in equity under § 4915 cannot be disputed. It is based upon the *alternative* and *optional* character of those remedies as provided by Congress. The force of a similar contention was recognized in *Baldwin Co. v. Robertson, supra*, when it was held that it was not an undue expan-

sion of the statute to hold that a remedy in equity against the Commissioner was furnished "in every case in which by § 9 an appeal first lies to the Court of Appeals."

The construction which has been imposed upon §§ 4911 and 4915 by the Court below deprives an applicant whose claims, copied from an unexpired patent, have been refused, from availing himself of the right clearly expressed in § 4915 to file a "bill in equity" instead of taking an appeal to the United States Court of Customs and Patent Appeals.

Conclusion.

The petition for a writ of certiorari should be granted.

Respectfully submitted,

J. BERNHARD THIESS,

*Counsel for Paul A. Sturtevant,
as amicus curiae.*

BERTRAM WM. COLTMAN,

SIDNEY NEUMAN,

Of Counsel.

APPENDIX A.

STATUTES INVOLVED.

Patent Act of 1836 (Act of July 4, 1836, ch. 357, 5 Stat. 117):

"SECTION 7. *And be it further enacted*, That on the filing of any such application, description, and specification, and the payment of the duty hereinafter provided, the Commissioner shall make, or cause to be made, an examination of the alleged new invention or discovery; and if, on any such examination, it shall not appear to the Commissioner that the same had been invented or discovered by any other person in this country prior to the alleged invention or discovery thereof by the applicant, or that it had been patented, or described in any printed publication in this or any foreign country, or had been in public use or on sale with the applicant's consent or allowance prior to the application, if the Commisisoner shall deem it to be sufficiently useful and important, it shall be his duty to issue a patent therefor. . . . if the specification and claim shall not have been so modified as, in the opinion of the Commissioner, shall entitle the applicant to a patent, he may, on appeal, and upon request in writing, have the decision of a board of examiners, to be composed of three disinterested persons, who shall be appointed for that purpose by the Secretary of State, . . . it shall be in their power, or of a majority of them, to reverse the decision of the Commissioner, either in whole or in part, and their opinion being certified to the Commissioner, he shall be governed thereby in the further proceedings to be had on such application. . . ."

"SECTION 8. *And be it further enacted*, That whenever an application shall be made for a patent which, in the opinion of the Commissioner, would interfere

with any other patent for which an application may be pending, or with any unexpired patent which shall have been granted, it shall be the duty of the Commissioner to give notice thereof to such applicants, or patentees, as the case may be; and if either shall be dissatisfied with the decision of the Commissioner on the question of priority of right or invention, on a hearing thereof, he may appeal from such decision, on the like terms and conditions as are provided in the preceding section of this act; and the like proceedings shall be had, to determine which or whether either of the applicants is entitled to receive a patent as prayed for. . . ."

"SECTION 16. *And be it further enacted*, That whenever there shall be two interfering patents, or whenever a patent on application shall have been refused on an adverse decision of a board of examiners, on the ground that the patent applied for would interfere with an unexpired patent previously granted, any person interested in any such patent, either by assignment or otherwise, in the one case, and any such applicant in the other case, may have remedy by bill in equity; and the Court having cognizance thereof, on notice to adverse parties, and other due proceedings had, may adjudge and declare either the patents void in the whole or in part, or inoperative or invalid in any particular part or portion of the United States, according to the interest which the parties to such suit may possess in the patent or the inventions patented, and may also adjudge that such applicant is entitled, according to the principles and provisions of this act, to have and receive a patent for his invention, as specified in his claim, or for any part thereof, as the fact of priority of right or invention shall in any such case be made to appear. And such adjudication, if it be in favor of the right of such applicant, shall authorize the Commissioner to issue such patent, on his filing a copy of the adjudication, and otherwise complying with the requisitions of this act. *Provided however*, That no such judgment or adjudication shall affect the rights of any person except the parties to the action

and those deriving title from or under them subsequent to the rendition of such judgment."

Patent Act of 1839 (Act of March 3, 1839, ch. 88, 5 Stat. 353):

"SECTION 10. *And be it further enacted*, That the provisions of the sixteenth section of the before-recited act shall extend to all cases where patents are refused for any reason whatever, either by the Commissioner of Patents or by the Chief Justice of the District of Columbia, upon appeals from the decision of said Commissioner, as well as where the same shall have been refused on account of, or by reason of, interference with a previously existing patent; and in all cases where there is no opposing party, a copy of the bill shall be served upon the Commissioner of Patents, when the whole of the expenses of the proceeding shall be paid by applicant, whether the final decision shall be in his favor or otherwise."

"SECTION 11. *And be it further enacted*, That in all cases where an appeal is now allowed by law from the decision of the Commissioner of Patents to a board of examiners, provided for in the seventh section of the act to which this is additional, the party, instead thereof, shall have a right to appeal to the Chief Justice of the district court of the United States for the District of Columbia, by giving notice thereof to the Commissioner, and filing in the Patent Office, within such time as the Commissioner shall appoint, his reasons of appeal specifically set forth in writing, and also paying into the Patent Office, to the credit of the patent fund, the sum of twenty-five dollars. And it shall be the duty of said Chief Justice, on petition, to hear and determine all such appeals, and to revise such decisions in a summary way, on the evidence produced before the Commissioner, at such early and convenient time as he may appoint..."

Consolidated Patent Act of 1870 (Act of July 8, 1870, ch. 230, 16 Stat. 198):

"SECTION 52. *And be it further enacted*, That whenever a patent on application is refused, for any reason

whatever, either by the commissioner or by the Supreme Court of the District of Columbia upon appeal from the commissioner, the applicant may have remedy by bill in equity; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim, or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent, on the applicant filing in the Patent Office a copy of the adjudication, and otherwise complying with the requisitions of law. And in all cases where there is no opposing party a copy of the bill shall be served on the commissioner, and all the expenses of the proceeding shall be paid by the applicant, whether the final decision is in his favor or not."

"SECTION 58. *And be it further enacted*, That whenever there shall be interfering patents, any person interested in any one of such interfering patents, or in the working of the invention claimed under either of such patents, may have relief against the interfering patentee, and all parties interested under him, by suit in equity against the owners of the interfering patent; and the court having cognizance thereof, as hereinbefore provided, on notice to adverse parties, and other due proceedings had according to the course of equity, may adjudge and declare either of the patents void in whole or in part, or inoperative, or invalid in any particular part of the United States, according to the interest of the parties in the patent or the invention patented. But no such judgment or adjudication shall affect the rights of any person except the parties to the suit and those deriving title under them subsequent to the rendition of such judgment."

Revised Statutes of 1874. § 4911 (35 U. S. C. 59a).

"If any applicant is dissatisfied with the decision of the board of appeals, he may appeal to the United States Court of Customs and Patent Appeals, in which

case he waives his right to proceed under section 63 of this title.* If any party to an interference is dissatisfied with the decision of the board of interference examiners, he may appeal to the United States Court of Customs and Patent Appeals, provided that such appeal shall be dismissed if any adverse party to such interference shall, within twenty days after the appellant shall have filed notice of appeal according to section 60 of this title, file notice with the Commissioner of Patents that he elects to have all further proceedings conducted as provided in section 63. Thereupon the appellant shall have thirty days thereafter within which to file a bill in equity under said section 63, in default of which the decisions appealed from shall govern the further proceedings in the case. R. S. § 4911; March 2, 1927, c. 273, § 8, 44 Stat. 1336; March 2, 1929, c. 488, § 2, 45 Stat. 1476; Aug. 5, 1939, c. 451, § 3, 53 Stat. 1212."

§ 4915 (35 U. S. C. § 63).

"Whenever a patent on application is refused by the Board of Appeals or whenever any applicant is dissatisfied with the decision of the board of interference examiners, the applicant, *unless appeal has been taken to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided, in which case no action may be brought under this section,*** may have remedy by bill in equity, if filed within six months after such refusal or decision; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent on the applicant filing in

* Italicized matter added by amendment by Act of March 2, 1927, c. 273, § 8, 44 Stat. 1336.

** Italicized matter added by amendment by Act of March 2, 1927, c. 273, § 11, 44 Stat. 1336.

the Patent Office a copy of the adjudication and otherwise complying with the requirements of law. In all cases where there is no opposing party a copy of the bill shall be served on the commissioner; and all the expenses of the proceedings shall be paid by the applicant, whether the final decision is in his favor or not. In all suits brought hereunder where there are adverse parties the record in the Patent Office shall be admitted in whole or in part, on motion of either party, subject to such terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court may impose, without prejudice, however, to the right of the parties to take further testimony. The testimony and exhibits, or parts thereof, of the record in the Patent Office when admitted shall have the same force and effect as if originally taken and produced in the suit. R. S. § 4915; February 9, 1893, c. 74, § 9, 27 Stat. 436; March 2, 1927, c. 273, § 11, 44 Stat. 1336; March 2, 1929, c. 488, § 2(b), 45 Stat. 1476; August 5, 1939, c. 451, § 4, 53 Stat. 1212."

APPENDIX B.

IN THE UNITED STATES COURT OF APPEALS FOR THE
DISTRICT OF COLUMBIA.

The Hoover Company,
Appellant,

vs.

Conway P. Coe, Commissioner of
Patents,
Assignee.

No. 8602.

MEMORANDUM.

This suit is stated to have been brought under the provisions of Section 4915 R. S. (U. S. C., title 35, sec. 63) which provides that whenever a patent on application is refused by the Board of Appeals, the applicant may, under certain specified conditions, have remedy by a bill in equity, if filed within the period specified.

The statute provides:

• • • and the court having cognizance thereof • • • may adjudge that the applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim or for any part thereof, as the facts in the case may appear • • • • • And such adjudication, if it be in favor of the right of the applicant, shall authorize the Commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication and otherwise complying with the requirements of law.

Counsel have been asked to furnish a memorandum on the following question:

Has the Court under Section 4915 R. S., the power to hand down a decree which does not determine the right of an applicant to receive a patent but which only determines that claims which may subsequently be held to be unpatentable by the Patent Office are supported by the application?

It is thought that the proper answer to the question can be better determined if a brief summary is made of the patent laws as they were from time to time enacted to define so far as they specify the procedure leading up to the grant of a patent.

In the first patent act of 1790, it was provided that upon petition of any person to the Secretary of State, Secretary of the Department of War, and the Attorney General, setting forth that the petitioner had invented, or discovered, any useful art, manufacture, etc. not known or used before the filing of the petition and praying that a patent may be granted therefor, it will be lawful for the Secretary of State, Secretary of the Department of War, and the Attorney General, or any two of them, to cause the Letters Patent to be made out in the name of the United States and for a term of not to exceed 14 years, if it should be deemed the invention or discovery is sufficiently useful or important. There was no requirement that any such examination on the part of the Government, as was specifically required in later acts, should be made.

It is to be noted that, while there was no such requirement in the statute, it is a tradition that Thomas Jefferson, who was then Secretary of State, gave careful consideration to every patent application to determine whether, in his judgment, the invention was, as stated in the act, sufficiently useful and important.

The next act, of 1793, provided in effect that a patent should be granted upon a proper application being made therefor. It also provided (Sec. 3) that every inventor before he can receive a patent shall make oath that he "does verily believe that he is the true inventor or discoverer of the art, machine, or manufacture for which he solicits a patent." This act remained in force with some slight amendments, which are not material to the question here involved, until the act of 1836.

That later act created the Patent Office and provided for the appointment of a Commissioner of Patents. It was this act that created the examination system.

Section 6 of the act provided that any person who had discovered or invented any new and useful art, machine, manufacture, or improvement thereon and which was not known or used by others before his invention or discovery and not, at the time of his application for patent, in public use or on sale with his consent or allowance, may make application in writing to the Commissioner of Patents and the Commissioner, "on due proceedings had, may grant a patent therefor."

The act further provided (Sec. 7) that when such an application is filed, "the commissioner shall make or cause to be made an examination of the alleged new invention or discovery and if on any such examination it shall not appear to the Commissioner that the same had been invented or discovered by any other person in this country prior to the alleged invention or discovery thereof by the applicant or that it had not been patented or described in any printed publication in this or any foreign country or had not been in public use or on sale with the applicant's consent or allowance prior to the application, if the Commissioner shall deem it to be sufficiently useful and important, it shall be his duty to issue a patent therefor."

That section further provided that if, upon examination, "it shall appear to the Commissioner that the applicant was not the original and first inventor or discoverer thereof or any part of that which is claimed as new had before been invented, discovered, or patented, or described in any printed publication in this or any foreign country, as aforesaid, . . . he shall notify the applicant thereof, giving him briefly such information and references as may be useful in judging of the propriety of renewing his application, or altering his specification, to embrace only that part of his invention or discovery which is new."

The act did not provide for an appeal to any court, but did provide (Sec. 7) for an appeal from the Commissioner to a board of examiners to be composed of three disinterested persons who should be appointed for that purpose by the Secretary of State and that it should be in the power of that board to reverse the decision of the Commissioner, who should in the further proceedings be governed by the decision of the board.

There was, however, a provision (Sec. 16) somewhat analogous to present Section 4915 R. S., which provided that whenever a patent on an application had been refused on an adverse decision of the Board of Examiners on the ground that the patent applied for would interfere with an unexpired patent, previously granted, the applicant might have a remedy by a bill in equity and that the court may "adjudge that such applicant is entitled according to the principles and provisions of this act to have and receive a patent for his invention, as specified in his claims or any part thereof."

By the act of 1839 (Sec. 10) it was provided that the provisions of Section 16 of the Act of 1836 is extended to all cases where patents are refused for any reason whatever either by the Commissioner of the Patent Office of the

Chief Justice of the District Court, (Section 11 of the act providing for such an appeal).

This practice was continued without interruption until the passage of what is known as the "consolidated act" of 1870.

The latter act continued the requirement that an examination be made by the Commissioner, or made under his direction, and contains the provision (Sec. 31), that when an application is filed and the fee is paid, "The Commissioner shall cause an examination to be made of the alleged invention or discovery and if, on such an examination, it shall appear that the claimant is justly entitled to a patent under the law and the same is sufficiently useful and important, the Commissioner shall issue a patent therefor." (See present section 4893 R. S., U. S. C., title 35, sec. 36.) Section 52 of the act of 1870 is substantially the same as section 4915 R. S. as in force up to the time of amendment of 1927, which latter has no bearing on the question here involved.

It would seem that, since the Commissioner is required to have an examination made and on that examination, if any ground therefor should appear, to refuse to grant the patent, it must be presumed that he had found no other grounds.

The rules of the Patent Office have for many years expressly provided (Rule 66) that the Examiner upon taking up the application for examination shall make a thorough investigation of the prior art with respect to the invention sought to be protected in the application and that the Examiner must cite the best references at his command. When therefore, after the Board of Appeals affirms the action of an examiner refusing a patent, it would seem that, if in the suit under Section 4915 R. S. the court is of the opinion that the Board of Appeals was in error in

refusing the patent on the grounds stated, it would be proper for it to make a finding as specified in said section.

It is true that an action under that section has been held to be an action *de novo* and that the Commissioner of Patents may bring forward, with proper notice, other grounds for rejection than those stated by the Examiner and the Board of Appeals, but again, the presumption would seem to be that the Patent Office has brought before the court the best evidence that was available and therefore, if that evidence is not deemed sufficient to justify dismissing the bill, the applicant is entitled to the finding as specified in Section 4915 R. S.

In so far as the authority of the court to make the finding, when it is known that further action would be required in the Patent Office even though that finding was favorable to the plaintiff, is concerned, it would seem that such a proceeding is contemplated by the statute for it is provided that the patent may be granted upon the applicant "filing in the Patent Office a copy of the adjudication and otherwise complying with the law."

While the language of the section might appear to make the finding mandatory and immediately effective, it is thought that it is proper to consider it as a part of the entire patent law and hence coordinate with section 4904 R. S., which provides for the declaration of an interference where an application for patent is found to be in conflict with another application, or an unexpired patent. It is not until it is found that a claim in an application is patentable to the applicant, that such a conflict exists. Therefore when it is determined by the adjudication of the court that the conflict exists, Section 4904 R. S. comes into play and the interference must be declared, notwithstanding the form of the judgment. Any other construction would exclude an applicant whose claims copied from a patent

had been rejected, and a patent containing those claims "refused," from availing himself of the right, clearly stated in Section 4915 R. S., of filing a bill in equity instead of filing an appeal to the United States Court of Customs and Patent Appeals, as provided in Section 4911 R. S.

So far as can be ascertained, no question has ever been raised as to the right of the Patent Office to proceed in accordance with other sections of the patent statutes, if an adjudication is made favorable to the plaintiff in a 4915 R. S. suit.

In the case of *Tully v. Robertson*, 19 F. (2d) 954, the District Court of Maryland, Soper, Judge, held specifically that the applicant was entitled to make certain claims copied from a patent and the subsequent record of the application shows that after a copy of that adjudication was filed an interference was declared.

Furthermore, in the case of *Pitman v. Ellis-Foster Co. v. Coe*, 62 App. D. C. 365, 68 F. (2d) 412, 1934 C. D. 34, it appears that in an application division had been required by the Patent Office, that is to say, that the patent had been refused because, in the opinion of the Patent Office, there was a misjoinder of inventions, and it appears further that in the suit brought under Section 4915 R. S. the Solicitor of the Patent Office moved in the District Court to dismiss the complaint on the ground that the refusal to issue the patent was based only on the ground that it would not be examined until the requirement for division had been complied with. That motion was granted but, on appeal to this Court, it was specifically held that the suit was improperly dismissed and the decision was reversed.

This Court, speaking through Chief Justice Martin, Associate Justices Robb and Groner concurring, after stating

the facts and that the lower court had sustained the defendant's motion to dismiss, said:

"We think the ruling was erroneous."

The Court discussed at some length the two remedies provided by an appeal under Section 4911 R. S. and a suit under Section 4915 R. S., and noted that instead of the applicant having a right to take the appeal first and then file a bill in equity, if the decision on the appeal was adverse to him, the law had been amended in 1927 to limit the applicant to only one of these provisions as he should elect, and then said:

"* * * These two remedies lie to different courts. They differ in procedure, the one is an appeal upon the record of the Patent Office, and the other is an original suit in a court of equity. The latter proceeding calls for a trial *de novo* with all the customary power of an equity court to hear the evidence fully and to make its own findings. Although these two methods of procedure are alternatives, they are nevertheless analogous and are designed to secure essentially the same legal remedy."

The Court noted that it had been definitely decided that an appeal may be taken from a refusal of a patent based on a requirement for division made by the Patent Office (citing *Steinmetz v. Allen*, 192 U. S. 543, and *In re Frasch*, 27 App. D. C. 25, and *In re Wellman*, 18 C. C. P. A. 1214, 48 F. (2d) 926) and then said:

"* * * We can see no reason for holding that such a remedy is confined to a review by the appellate court of the decisions of the Patent Office, and is denied in proceedings brought by the applicant for review in a court of equity. It is true that the remedies are diverse; nevertheless the substantive rights of the applicants, which are the basis alike of the appeal and bill in equity, are identical. There is no reason to believe that Congress intended that any remedy which might be obtained by appeal should be more extensive

or complete than that allowed by bill in equity. It follows that a refusal to grant a patent based upon a controversy arising from an order of division is reviewable by either proceeding. The difference between the two is a difference of procedure rather than a difference of interest. In this view of the case we think that the lower court possessed jurisdiction to hear and decide the question notwithstanding that the refusal of the patent was based upon an order of division of claims made in the Patent Office."

It would seem therefore that, at least tacitly, this Court has construed the language of Section 4915 R. S. as not prohibiting an applicant, who has been refused a patent, the right to proceed thereunder, even though it appears from the pleadings that further action by the Patent Office will be required, if the adjudication of the court is in favor of the plaintiff.

Furthermore there have been several appeals to this court in suits brought under Section 4915 R. S., in which it appeared from the pleadings that the refusal of the Patent Office to grant the patent was based on the ground of an estoppel arising from the failure to proceed under the provisions of Rule 109 of the Patent Office. It would clearly appear in these cases that a decree for the plaintiff would determine only that the refusal of the claims was in error and these claims "might be subsequently held to be unpatentable" to the plaintiff.

Attention is specifically called to *International Cellulose Products Co. v. Coe*, 66 App. D. C. 248, 85 F. (2d) 69, which was heard by the full Bench of five judges, and *American Cyanamid Co., et al. v. Coe*, 70 App. D. C. 330, 86 F. (2d) 851, which was heard by Chief Justice Groner, and Associate Justice Stephens and Edgerton, both opinions being written by Justice Stephens.

In these cases also it was, at least tacitly, held that the suits were properly brought.

The files of these cases show that the interferences, which had been dissolved, were reinstated and prosecuted to a final decision.

The present Hoover case is of the same character as that of the two foregoing cases, since in each of the three a judgment in favor of the plaintiff puts the involved application within the requirement of Section 4904 for the declaration of an interference.

It has been suggested that a suit under Section 4915 R. S. may be likened to a suit for a declaratory judgment and that the adjudication authorized by that section is such a judgment. Professor Borchard, in his book on Declaratory Judgments (2nd Edition, page 802), with reference to Section 4915 R. S., says:

"The equity suit of an unsuccessful applicant for a patent authorized by section 4915 of the Revised Statutes is an adjudication of his right or no-right, as the case may be, as against adverse claimants or the Commissioner of Patents. It seems preferable to consider a favorable judgment as declaratory rather than investitive, for while it adjudicates the applicant's rights to a new status, it in effect declares a pre-existing right that the Commissioner should have recognized and merely enables him, on compliance with further legal requirements, to obtain his patent administratively."

This statement seems to fully support the conclusion that the answer to the question propounded is that the Court, under the circumstances stated, has the authority to hand down a judgment in the form stated in Section 4915 R. S.

Respectfully,

R. F. WHITEHEAD,
*Of Counsel, for the Commissioner of
Patents.*

April 18, 1944.

SUPREME COURT OF THE UNITED STATES.

No. 486.—OCTOBER TERM, 1944.

The Hoover Company, Petitioner, } On Writ of Certiorari to the
vs. } United States Court of
Conway P. Coe, Commissioner of } Appeals for the District
of Patents. } of Columbia.

[April 30, 1945.]

Mr. Justice ROBERTS delivered the opinion of the Court.

The question presented is whether a District Court has jurisdiction of a suit under R. S. 4915¹ to review the refusal of a claim for patent as not reading on the application. The court below answered in the negative.

The respondent confesses error. The language of the Act, its legislative history, administrative practice, and judicial construction, constrain us to hold that the District Court had jurisdiction of the suit and that the Court of Appeals should have reviewed its decision upon the merits.

January 10, 1941, the petitioner's assignor filed application for reissue of a patent granted November 7, 1939, on an original application of August 8, 1936. The alleged invention is for improvements in a refrigerating system. A number of claims included in the application for reissue were copied, or substantially copied, from several later patents, in order to provoke interferences therewith and a contest as to priority of invention.

The Primary Examiner finally rejected four of the claims, stating that they were rejected "as not reading on applicant's disclosure". . . . The Board of Appeals of the Patent Office affirmed the Examiner's decision. The petitioner then brought suit against the Commissioner of Patents under R. S. 4915 in the United States District Court for the District of Columbia, to compel him to allow the four claims, to the end that interference proceedings might be instituted. The case was heard on the Patent Office record and additional evidence. The court entered findings of fact and conclusions of law and dismissed the complaint on the ground that the claims did not read on, that is, did not accurately describe, the disclosure in the application.

On appeal the court below on its own motion raised the question whether [R. S. 4915] confers jurisdiction on the District Court

to enter a decree which does not determine the right of the applicant to receive a patent but which instead directs the examiner to allow claims for the purpose of provoking subsequent interference proceedings". The parties were heard upon this question and the court decided that the District Court lacked jurisdiction of the suit, and on that ground affirmed its judgment of dismissal.²

R. S. 4915 is in part:

"Whenever a patent on application is refused by the Board of Appeals or whenever any applicant is dissatisfied with the decision of the board of interference examiners, the applicant, unless appeal has been taken to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided, in which case no action may be brought under this section, may have remedy by bill in equity, if filed within six months after such refusal or decision; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication and otherwise complying with the requirements of law. In all cases where there is no opposing party a copy of the bill shall be served on the commissioner; and all the expenses of the proceedings shall be paid by the applicant, whether the final decision is in his favor or not."

The court below held that in conformity to the general rule, a court of equity ought not to afford piecemeal relief pending completion of the administrative process, and consequently ought not to entertain a suit under the statute unless its adjudication would conclude all possible questions as to the right to a patent.

1. On its face the statute confers the right to sue "Whenever a patent on application is refused by the Board of Appeals". The patent applied for (that is, the claims in question) was finally refused by the Board of Appeals. No appeal was taken to the United States Court of Customs and Patent Appeals, and petitioner filed its bill within the time limited in the section.

Two matters may be noted respecting R. S. 4915. These are the denial of jurisdiction if appeal has been taken to the United States Court of Customs and Patent Appeals and the statement that adjudication in favor of the applicant shall authorize the Commissioner to issue a patent. These provisions require reference to R. S. 4911, as amended. That section provides:

"If any applicant is dissatisfied with the decision of the board of appeals, he may appeal to the United States Court of Customs and Patent Appeals, in which case he waives his right to proceed under section 63 [R. S. 4915] of this title. If any party to an interference is dissatisfied with the decision of the board of interference examiners, he may appeal to the United States Court of Customs and Patent Appeals: *Provided*, That such appeal shall be dismissed if any adverse party to such interference shall, within twenty days after the appellant shall have filed notice of appeal according to section 60 of this title, file notice with the Commissioner of Patents that he elects to have all further proceedings conducted as provided in Section 63 [R. S. 4915]. Thereupon the appellant shall have thirty days thereafter within which to file a bill in equity under said section 63 [R. S. 4915], in default of which the decisions appealed from shall govern the further proceedings in the case."

It is evident that alternative rights of review are accorded an applicant,—one by appeal to the United States Court of Customs and Patent Appeals, the other by bill in equity filed in one of the federal district courts. In the first the hearing is summary and solely on the record made in the Patent Office³; in the other a formal trial is afforded on proof which may include evidence not presented in the Patent Office.⁴ Every party adversely affected by a ruling on the merits may, if he so elect, proceed by bill rather than by appeal. In the one case the adjudication in equity authorizes issue of a patent on the applicant's "otherwise complying with the requirements of law". In the other the decision "shall govern the further proceedings in the case" in the Patent Office.⁵

The question is whether the differences in the character of the proceedings and the statutory effect of decision or adjudication require a holding that as to all decisions on the merits adverse to the applicant, other than the final action as to the issue of a patent, the applicant must obtain review by appeal to the Court of Customs and Patent Appeals, and can proceed by bill under R. S. 4915⁶ only when every step requisite to issue has been taken. If so, the language of R. S. 4915 is ill chosen. "Whenever a patent on application is refused" states precisely this case. "The petitioner's application was refused." "Whenever any applicant is dissatisfied with the decision of the board of interference examiners" states a case where the examiner's decision may be only one of a series of rulings in the Patent Office prior to issue of a patent. It can hardly be that these phrases have no effect and

³ See R. S. 4914, 35 U. S. C. § 62.

⁴ *Butterworth v. Hoe*, 112 U. S. 50, 61.

⁵ R. S. 4911, *supra*.

are to be read as "Whenever, after all administrative steps are complete and a patent is about to issue, any person aggrieved may have remedy by bill in equity". If that be the correct construction, one finally denied a patent could not resort to the specified remedy, since, even if his contention were sustained, he might thereafter have to leap the hurdles in the Patent Office of interferences, later references, and other obstacles to patentability.

On the face of the statutes the applicant is given alternative remedies resulting in the same sort of relief so far as concerns the further prosecution of the application in the Patent Office.

2. The legislative history confirms the view that Congress so intended.

That history cannot be stated briefly. It has its origin in the Patent Act of 1836⁶ which afforded an applicant aggrieved by a ruling of the Commissioner an appeal to a board of examiners.⁷ By a later section it was provided that "whenever a patent on application shall have been refused on an adverse decision of a board of examiners, on the ground that the patent applied for would interfere with an unexpired patent", the applicant might have remedy by bill in equity; and the court might adjudge the applicant entitled to a patent, according to his claim or any part of it. Adjudication favorable to the applicant was to "authorize the Commissioner to issue such patent" on the applicant's filing a copy of the adjudication "and otherwise complying with the requisitions of this act."⁸ It will be noted that a bill might be filed under this statute only where the rejection of a claim was for interference with an outstanding patent. By the Act of March 3, 1837,⁹ the same remedy was afforded an applicant for patent for an improvement or for "correction and re-issue."

By the Act of March 3, 1839,¹⁰ the same remedy was extended "to all cases where patents are refused for any reason whatever, either by the Commissioner of Patents, or by the chief justice of the District of Columbia, upon appeals from the decision of said Commissioner", as well as where the refusal was based on asserted interference. The reason for adding the phrase concerning the decision of the Chief Justice was that, by Sec. 11¹¹ of the same Act, a summary appeal on the Patent Office record to

⁶ 5 Stat. 117.

⁷ Sec. 7, 5 Stat. 119-120.

⁸ Sec. 16, 5 Stat. 123.

⁹ 5 Stat. 191.

¹⁰ Sec. 10, 5 Stat. 354.

¹¹ 5 Stat. 354.

this judicial officer, was substituted for the former appeal to a board of examiners given by the Act of 1836.¹²

Thus a District Court might set aside, on bill filed, any ruling refusing a patent, either on interference or otherwise, whether the ruling were that of the Patent Office or of a judge of the Circuit Court of the District of Columbia on appeal from the Patent Office decision.

The Act of July 8, 1870,¹³ amended, revised, and consolidated existing law. In Sec. 48¹⁴ it enacted that in *ex parte* cases an applicant for patent or reissue whose claims had been twice rejected might appeal to the Supreme Court of the District of Columbia. The hearing was to be summary, to be on the office record, and the decision was "to govern the further proceedings in the case."¹⁵ In Sec. 52 it provided that whenever a patent on application "is refused, for any reason whatever", either by the Commissioner or by the Supreme Court of the District upon appeal, the remedy by bill in equity should be available. The adjudication was to authorize the issue of a patent on the applicant's filing a copy in the patent office "and otherwise complying with the requisitions of law." This statute was construed to require an appeal to the District Supreme Court as a condition precedent to the maintenance of a bill in equity.¹⁶

The provisions of the Act of 1870 were codified in the Revised Statutes of 1873.¹⁷ In the process the words "for any reason whatever" were deleted from Sec. 52, which became R. S. 4915. The omission was evidently because the words were surplusage, since the purpose of the revisers was not "to attempt any change whatever in the existing law" except "mere changes of phraseology, not affecting the meaning of the law."¹⁸

By the Act of February 9, 1893¹⁹ the Court of Appeals for the District of Columbia was created and jurisdiction of summary appeals from Patent Office rulings was transferred to that court. Thus the remedy by bill in equity was now to be pursued in a District court only after an appeal to the Court of Appeals of

¹² By the Act of August 30, 1852, 10 Stat. 75, such summary appeal might be heard by any judge of the Circuit Court of the District of Columbia.

¹³ 16 Stat. 198.

¹⁴ 16 Stat. 205.

¹⁵ Sec. 50, 16 Stat. 205.

¹⁶ *Kirk v. Commissioner of Patents*, C. D. 440; *Fekete v. Robertson*, 17 F. 2d 335; *Cooper v. Robertson*, 38 F. 2d 852.

¹⁷ The relevant sections are 4911-15 inclusive.

¹⁸ 2 Cong. Rec. 646.

¹⁹ 27 Stat. 434, 436.

the District had resulted adversely to the applicant; and an adjudication in the equity suit was subject to review on appeal.

So matters stood until the passage of the Act of March 2, 1927.²⁰ In the hearings on the bill which became the statute, it was proposed that Congress eliminate either the appeal or the bill in equity, some interested parties suggesting abolition of the one remedy, others advocating dropping the other. Congress decided not to do away with either, but to allow an applicant to have the decision of the Patent Office reviewed either by the court of appeals or by filing a bill in equity, but not both.²¹ It is evident that no alteration in respect of the rulings which could be reviewed was intended; but the number of possible appeals was to be reduced, while saving to litigants the option of producing new evidence in a court, by retaining the equity procedure.²²

Finally, the Act of March 2, 1929²³ transferred from the Court of Appeals of the District to the Court of Customs and Patent Appeals jurisdiction of appeals from the Patent Office, but *ex industria* provided "Nothing contained in this Act shall be construed as affecting in any way the jurisdiction of the Court of Appeals of the District of Columbia in equity cases." This was of course to make it plain that suits in the District Court of the District of Columbia should be appealable as are suits under R. S. 4915 instituted in district courts in circuits outside the District.

Thus it is clear that throughout more than a century Congress has for correction of erroneous adverse rulings, which if unreviewed would end the proceedings in the Patent Office, preserved the remedy by bill in a district court either as additional to or alternative to that by summary appeal and has made the effect of adjudication in equity the same as that of decision on appeal.

3. The Commissioner of Patents states that "when claims are finally rejected by the examiner and his action is affirmed by the Board of Appeals, the grounds then stated for such rejection, as well as any other grounds in support thereof, may be set up by

²⁰ 44 Stat. 1335.

²¹ H. R. No. 1889, pp. 2-3; S. R. No. 1313, p. 4, 69th Cong., 2d Sess.

²² See H. R. 1889, *supra*, p. 3; Hearings, House Committee on Patents, on H. R. 6252 and H. R. 7087, 69th Cong., 1st Sess., pp. 21-22; Hearings, House Committee on Patents, on H. R. 7563 and H. R. 13487, 69th Cong., 2d Sess., p. 11; Hearings, Senate Committee on Patents, on S. 4812, 69th Cong., 2d Sess., p. 35; Hearings, House Committee on the Judiciary, on H. R. 6687, 70th Cong., 1st Sess., *passim*; cf. Hearings, House Committee on Patents, on H. R. 7563 and H. R. 13487, 69th Cong., 2d Sess., p. 31; Hearings, House Committee on Patents on H. R. 6252 and H. R. 7087, 69th Cong., 1st Sess., p. 79.

²³ 45 Stat. 1475.

this Office in answer to a subsequent suit by the applicant under Rev. Stat. 4915. If the adjudication by the court is favorable to the applicant, it is the practice of this Office to treat that judgment as conclusive with respect to any ground of rejection urged before the court in defense of the refusal to allow the claims in issue. In the usual case, following such adjudication, the application is allowed and, upon payment of the prescribed fee, the patent is issued. However in rare instances where, after termination of the suit, new reference is discovered which shows lack of patentability of the claims for a reason not considered by the court, this Office considers itself under a duty to reject the claims on the newly discovered ground, and to refuse a patent on those claims unless the applicant can overcome the new ground of rejection. Similarly, if another applicant or a patentee is claiming substantially the same subject matter as that held patentable in the Rev. Stat. 4915 suit and a question of priority arises, interference proceedings may be necessary under Rev. Stat. 4904 to determine which of the adverse claimants is the first inventor. The foregoing is believed to have been the consistent practice of this Office for many years.

4. This court has repeatedly indicated a view of the meaning of R. S. 4915 which is inconsistent with the decision below,²⁴ although the exact question here presented was not involved in the cases under adjudication. The lower federal courts have consistently construed the section as conferring jurisdiction in cases which are indistinguishable from that at bar.²⁵ They have so held in cases where it affirmatively appeared that further proceedings in the Patent Office would be necessary following adjudication in favor of the applicant,²⁶ and where though it did not appear of record that further proceedings would be required in the Patent Office, it was evident that they might ensue adjudication, as where a patent was denied for want of invention.²⁷

²⁴ *Gandy v. Marble*, 122 U. S. 432, 439; *In re Hien*, 166 U. S. 433, 439; *Asch v. Moore*, 211 U. S. 1, 8-9; *American Foundries Co. v. Robertson*, 262 U. S. 209, 212-213; *United States ex rel. The Baldwin Co. v. Robertson*, 265 U. S. 168, 180-181.

²⁵ *Dilig v. Moore*, 34 App. D. C. 106; *E. I. du Pont de Nemours & Co. v. ...*, 89 F. 2d 679; *Pitman v. Coe*, 68 F. 2d 412; *Power Patents Co. v. Coe*, 10 F. 2d 550; *Tully v. Robertson*, 19 F. 2d 954; *Monopower Corp. v. Coe*, 10 F. Supp. 934; *Booth Fisheries Corp. v. Coe*, 114 F. 2d 462; *Forward ... Co. v. Coe*, 116 F. 2d 946.

²⁶ *Pitman v. Coe*, *supra*, *International Cellucotton Co. v. Coe*, 85 F. 2d ...; *American Cyanamid Co. v. Coe*, 106 F. 2d 851.

²⁷ *American Steel & Wire Co. v. Coe*, 105 F. 2d 17; *Abercrombie v. Coe*, 10 F. 2d 458; *General Motors Corp. v. Coe*, 120 F. 2d 736; *Radtke Patents*

And, where an applicant has succeeded in a bill filed under R. S. 4915, the courts have not questioned the power of the Patent Office subsequently to disallow the claims for want of invention over a newly discovered reference to the prior art.²⁸

The court below relied upon *Hill v. Wooster*, 132 U. S. 693, for its holding that a suit under R. S. 4915 cannot select a single issue which affects the applicant's right to a patent, without determining all the other issues on which that right depends. That case was one in which the Commissioner had decided an interference between the claims of two applicants in favor of one of them, and ordered that a patent issue. In an *inter partes* suit by the unsuccessful applicant against the successful one, this court held that if it appeared that neither application disclosed invention (a matter which should have moved the Commissioner not to declare an interference) the bill should be dismissed.²⁹ The court did not purport to decide what Patent Office rulings are reviewable under R. S. 4915.³⁰

The ruling of the Board of Appeals in the instant case was neither a procedural ruling³¹ nor an interlocutory one³² as to which the District Court should not entertain a suit under R. S. 4915. On the contrary, it finally denied a patent on the claims presented. In this respect it was like a dismissal of a suit in a court. Unless the applicant could sue to correct error in that dismissal, he could never sue under R. S. 4915. That he was accorded a right of suit in this case the language of the statute, its history, the administrative construction and judicial decision unite in affirming.

The judgment is reversed and the cause remanded for further proceedings in conformity to this opinion.

Corp. v. Coe, 122 F. 2d 937; *Hydraulic Press Corp. v. Coe*, 124 F. 2d 521; *Minnesota Mining & Mfg. Co. v. Coe*, 125 F. 2d 198; *Poulson v. McDowell*, 142 F. 2d 267.

²⁸ *Gold v. Newton*, 254 Fed. 824.

²⁹ Section 16 of the Act of 1836 (5 Stat. 123) *supra* expressly provided that upon a bill filed as a result of Patent Office decision on an interference the court might adjudge either of the patents void in whole or in part. This language was evidently omitted in later acts as surplusage, for obviously if either patent was void for lack of invention or other cause, the question of interference disappeared.

³⁰ This is equally true of *Radtke Patents Corp. v. Coe*, 122 F. 2d 937, on which the court below relied.

³¹ *Butterworth v. Bee*, 112 U. S. 50; *Shoemaker v. Robertson*, 54 F. 2d 456; *Chessin v. Robertson*, 63 F. 2d 267; *Cherry-Burrell Corp. v. Coe*, 143 F. 2d 372.

³² *American Cable Co. v. John A. Roebling's Sons Co.*, 65 F. 2d 801; *Synthetic Plastics Co. v. Ellis-Foster Co.*, 78 F. 2d 847.

